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Les documents de travail sont aussi disponibles sur le site Internet de l'OMPI (voir <http://www.wipo.int/pct/fr/meetings>).

Le 7 mai 2003

Pièces jointes : documents PCT/R/WG/4/2, 4, 4 Add.1, 4 Add.2 et 10
documents PCT/R/WG/4/4 Add.3, 4 Add.4, 8 Add.1, 11, 12 et 13
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ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE
GENÈVE

UNION INTERNATIONALE DE COOPÉRATION EN MATIÈRE DE BREVETS
(UNION DU PCT)

GRUPEDETRAVAIL SUR LA RÉFORME DU TRAITÉ DE
COOPÉRATION EN MATIÈRE DE BREVETS (PCT)

Quatrième session
Genève, 19 – 23 mai 2003

CHANGEMENTS EN RAPPORT AVEC LE TRAITÉ SUR
LE DROIT DES BREVETS (PLT):

EXIGENCES RELATIVES AUX PARTIES MANQUANTES

Document établi par le Bureau international

RAPPEL

1. À sa première session, le Groupe de travail sur la réforme du Traité de coopération en matière de brevets (PCT) a étudié des propositions destinées à aligner le PCT avec les exigences du Traité sur le droit des brevets (PLT); les délibérations sont eulieu sur la base du document PCT/R/WG/1/5.

2. Parmi les propositions de modification en rapport avec le PLT contenues dans le document PCT/R/WG/1/5 figuraient des propositions tendant à faire concorder les exigences du PCT relatives aux parties manquantes avec celles du PLT (voir l'annexe I du document PCT/R/WG/1/5). Cependant, faute de temps, le groupe de travail a dû renoncer à examiner pendant sa première session plusieurs des propositions contenues dans le document PCT/R/WG/1/5, dont celles qui concernaient les exigences relatives aux parties manquantes. Il a souhaité donner plutôt la priorité aux questions "susceptibles d'apporter le plus de bénéfice concret immédiat aux utilisateurs, en tenant compte aussi du degré de complexité en jeu et des incidences du point de vue de la charge de travail pour les offices et les administrations", en particulier aux propositions concernant la restauration du droit de priorité

et les uris en cas d'observation d'un délai, notamment du délai impart pour l'ouverture de la phase nationale (voir le résumé de la première session établi par la présidence, paragraphe 21.v) du document PCT/R/WG/1/9).

3. Pour la deuxième session du groupe de travail, le Bureau international avait établi un document exposant d'autres modifications en rapport avec le PLT qu'il pourrait être souhaitable d'apporter au PCT, en indiquant, d'une manière générale, qu'il n'y avait pas lieu de traiter de manière prioritaire les propositions contenues dans le document PCT/R/WG/1/5 qui n'avaient pas été examinées durant la première session du groupe de travail. En ce qui concerne la proposition visant à faire concorder les exigences du PCT relatives aux parties manquantes avec celles du PLT qui figurait dans l'annexe I du document PCT/R/WG/1/5, il était indiqué que, compte tenu des discussions qui avaient eu lieu lors de la première session du groupe de travail, cette proposition était considérée comme bénéficiant d'un rang de priorité relative ment peu élevé et ne serait soumise de nouveau au groupe de travail qu'à une date ultérieure (voir le paragraphe 9 du document PCT/R/WG/2/6); à la deuxième session, le groupe de travail n'apas pu, faute de temps, examiner le document PCT/R/WG/2/6 – voir le paragraphe 59 du document PCT/R/WG/2/12.

4. À la troisième session, le groupe de travail a passé en revue les propositions de réforme qui avaient déjà été soumises au Comité sur la réforme du PCT ou au groupe de travail mais n'avaient pas encore été étudiées de manière approfondie et il est convenu de la priorité à leur accorder, en vue de les inclure dans son programme de travail. Parmi les propositions examinées figurait la proposition tendant à aligner les exigences du PCT relatives aux parties manquantes sur celles du PLT, telle qu'elle avait été initialement soumise au groupe de travail dans le document PCT/R/WG/1/5. Le groupe de travail est convenu que le Bureau international devrait lui soumettre de nouvelles propositions pour examen (voir les paragraphes 35 à 40, en particulier le paragraphe 38, du document PCT/R/WG/3/5, Résumé de la session établi par la présidence).

ALIGNER LES EXIGENCES DU PCT RELATIVES AUX PARTIES MANQUANTES SUR CELLES DU PLT

5. Le présent document contient une nouvelle version révisée des propositions concernant les exigences relatives aux parties manquantes qui figuraient initialement dans l'annexe I du document PCT/R/WG/1/5. Ces propositions ont fait l'objet d'un nouvel examen pour tenir compte du fait que, comme il est indiqué dans le document PCT/R/WG/2/6, l'examen de certaines autres propositions en rapport avec le PLT qui figuraient aussi dans l'annexe I du document PCT/R/WG/1/5 a été remis à une session ultérieure du groupe de travail : ils'agit de propositions tendant à faire concorder avec la procédure PLT les conditions d'attribution de la date de dépôt prescrites par le PCT en ce qui concerne les revendications, l'acceptation d'un dessin tant que de description et le remplacement de la description ou du dessin par un renvoi à une demande déposée antérieurement.

Structure de la règle 20

6. En ce qui concerne les exigences relatives aux parties manquantes, il est proposé de réviser la règle 20 de manière à déplacer, pour les incorporer dans les instructions administratives, les précisions relatives, par exemple, à l'apposition de la date, etc. qui sont actuellement données aux paragraphes 1 à 3 de la règle 20, et de consacrer cette règle à la question plus importante de l'attribution de la date de dépôt international. Les dispositions existantes de la règle seraient renumérotées en conséquence. Une nouvelle disposition traitant du cas où les conditions énoncées à l'article 11.1) sont remplies ultérieurement ferait l'objet

desalinéas c) et d) de la règle 20.3. La règle 20.5 modifiée traiterait des parties manquantes, notamment du cas où la partie manquante est contenue en totalité dans une demande antérieure dont la priorité est revendiquée (voir ci-dessous). Les modifications proposées auraient pour effet que les dispositions traitant de l'attribution de la date de dépôt internationale se présenteraient dans l'ordre (logique) dans lequel l'office récepteur décide s'il attribue une date de dépôt internationale et détermine la date à retenir pour celle-ci.

Datede dépôt lorsqu'une partie manquante est déposée

7. Aux termes de l'article 5.6 a) du PLT, le dépôt ultérieur (dans un certain délai) d'une partie manquante de la description ou d'un dessin manquant a pour effet qu'il est attribué comme date de dépôt soit la date à laquelle l'office a reçu cette partie de la description ou ce dessin manquant, soit la date à laquelle toutes les conditions d'attribution d'un dépôt sont remplies, selon celle de ces deux dates qui est postérieure. Le même principe est appliqué en vertu du PCT lorsque des feuilles (description, revendications, dessins) se rapportant à un même demandeur ne sont pas reçues le même jour. Toutefois, si le traité prévoit expressément le cas des dessins manquants (article 14.2 du PCT), ni le traité ni le règlement d'exécution ne traitent de l'attribution (ou de la correction) d'une date de dépôt internationale dans le cas où des feuilles ou des dessins manquants sont reçus à une date postérieure à la date de réception initiale des documents. Cette question n'est traitée expressément que dans les instructions administratives (voir l'instruction 309) et dans les directives à l'usage des offices récepteurs (voir les paragraphes 200 à 207 de ces directives). Afin de clarifier la procédure, il est proposé de traiter de cette question importante dans le règlement d'exécution (plutôt que dans les instructions administratives et les directives à l'usage des offices récepteurs) et de modifier la règle 20 en conséquence (voir la proposition de modification de la règle 20.5).

Datede dépôt international lorsque la partie manquante figure en totalité dans une demande antérieure

8. La principale différence entre les exigences du PLT et celles du PCT en matière de parties manquantes est que, en vertu du PLT, le déposant peut remédier à l'omission, lors du dépôt, d'une partie de la description ou d'un dessin sans perte de la date de dépôt si la demande revendiquant la priorité d'une demande antérieure et que la partie manquante de la description ou le dessin manquant figure en totalité dans cette demande antérieure (voir l'article 5.6 du PLT et les règles 2.3 et 4 du PLT). Il n'y a pas de disposition équivalente dans le PCT. Il est proposé de modifier le règlement d'exécution du PCT par l'adjonction d'une nouvelle règle 20.5.e) afin d'aligner les exigences du PCT sur celles du PLT.

Alignement de certaines exigences connexes du PCT avec celles du PLT

9. Dans l'alignement de ce qui est prévu concernant les parties manquantes, il est également proposé d'aligner certaines exigences connexes du PCT avec celles du PLT, en particulier pour ce qui est des délais impartis pour satisfaire à des exigences non liées à la date de dépôt (voir la proposition de modification de la règle 26).

10. Le groupe de travail est invité à examiner les propositions figurant dans l'annexe du présent document.

[L'annexe suit]

ANNEXE

PROPOSITIONS DEMODIFICATION DURÈGLEMENT D'EXÉCUTION DU PCT :
EXIGENCES RELATIVES AUX "PARTIES MANQUANTES"

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Règle 20

Datededépôtinternational

~~Réceptiondelademandeinternationale~~

[COMMENTAIRE : il est proposé de réviser la règle 20 de manière à déplacer, pour les incorporer dans les instructions administratives, les précisions relatives à l'apposition de la date, etc. qui sont actuellement données dans les règles 20.1 à 20.3 et de consacrer exclusivement cette règle au traitement de la question plus importante de l'attribution de la date de dépôt international. Les dispositions existantes seraient renumérotées en conséquence. Une nouvelle disposition traitant du cas où les conditions énoncées à l'article 11.1) sont remplies ultérieurement ferait l'objet des alinéas c) et d) de la règle 20.3 et une nouvelle règle 20.5 traiterait des parties manquantes et des dessins manquants.]

~~20.1 Date et numéro~~

- ~~a) À la réception des documents supposés constituer une demande internationale, l'officier récepteur appose, d'une manière indélébile, sur la requête de chaque exemplaire reçu et de chaque copie reçue, la date de réception effective et, sur chaque feuille de chaque exemplaire reçu et de chaque copie reçue, le numéro de la demande internationale.~~
- ~~b) Là place où, sur chaque feuille, la date ou le numéro doivent être apposés, ainsi que d'autres détails, sont spécifiés dans les instructions administratives.~~

[COMMENTAIRE : il est proposé de supprimer l'actuelle règle 20.1 et d'incorporer le contenu dans les instructions administratives. L'actuelle règle 20.4 deviendrait la règle 20.1 dans la nouvelle numérotation.]

~~20.2 Réception à des jours différents~~

~~a) Dans le cas où toutes les feuilles appartenant à ce qui est supposé constituer une même demande internationale ne sont pas reçues le même jour par l'officier récepteur, ce dernier corrige la date apposée sur la requête (en laissant toutefois lisibles la ou les dates antérieures déjà apposées) en indiquant la date de réception des documents complétant la demande internationale, à condition que~~

~~i) lorsqu'aucune invitation à corriger selon l'article 11.2.a) n'a été envoyée au déposant, lesdits documents soient reçus dans les trente jours à compter de la date à laquelle des feuilles ont été reçues pour la première fois;~~

~~ii) lorsqu'une invitation à corriger selon l'article 11.2.a) a été envoyée au déposant, lesdits documents soient reçus dans le délai applicable selon la règle 20.6;~~

~~iii) dans le cas de l'article 14.2), les dessins manquants soient reçus dans les trente jours à compter de la date à laquelle les documents incomplets ont été déposés;~~

~~iv) le fait qu'une feuille contenant l'abrégé ou une partie de l'abrégé manque, ou qu'elle est reçue en retard, n'exige pas la correction de la date indiquée sur la requête.~~

~~b) L'officier récepteur appose, sur toute feuille reçue à une date postérieure à celle où des feuilles ont été reçues pour la première fois, la date de la réception de ladite feuille.~~

[COMMENTAIRE : il est proposé de supprimer l'actuelle règle 20.2 et d'en incorporer dans les instructions administratives l'essentiel du contenu de l'actuelle ligne a) ("ce dernier corrige la date apposée sur la requête (en laissant toutefois lisibles la ou les dates antérieures déjà apposées) en indiquant la date de réception des documents complétant la demande internationale") et le contenu de l'actuelle ligne b). L'actuelle règle 20.5 deviendrait règle 20.2 dans la nouvelle numérotation.]

~~20.3 Demande internationale corrigée~~

~~Dans le cas visé à l'article 11.2)b), l'officier récepteur corrigé la date apposée sur la
requête (en laissant toutefois lisibles la ou les dates antérieures déjà apposées) en indiquant la
date de réception de la dernière correction exigée.~~

[COMMENTAIRE : il est proposé de supprimer l'actuel règle 20.3 et d'incorporer le
contenu dans les instructions administratives. L'actuel règle 20.6 deviendrait règle 20.3
dans la nouvelle numérotation. Le cas où les conditions énoncées à l'article 11.1) sont
remplies ultérieurement ("le cas visé à l'article 11.2)b") serait traité dans les alinéas c) et d)
de la nouvelle règle 20.3 (voir ci -après).]

20.1 ~~20.4~~ *Constatationausensdel'article11.1)*

[COMMENTAIRE :endehorsdelanouvelenumérotation,iln'estproposéaucune modificationàlarègleactuelle,maisletexteenestreprésentéci-dessousparsouci de commodité.Unedécisiondel'assembléeserapeut-êtrenécessairepourquelesréserves provisoiresquiontétéfaitesenvertudel'actuelle règle 20.4.d)restentvalablesenvertude cettedispositiondevenuerègle 20.1.d).]

a) [Pasdemodification] Àbrefdélaiaprèsréceptiondesdocumentssupposés constituerunedemandeinternationale,l'officérecepteurconstatesicesdocuments remplissentlesconditionsénoncéesà l'article 11.1).

b) [Pasdemodification] Auxfinsde l'article 11.1)iii)c),ilsuffitd'indiquerlenomdu déposantdemanièreaupermettred'enétablirl'identité,mêmesicenomestmalorthographié, silesprénomsnesontpascompletsou,danslecasd'unepersonnemorale,sil'indicationdu nomestabrégéouincomplète.

c) [Pasdemodification] Auxfinsde l'article 11.1)ii),ilsuffitquelapartiequisemble constituerunedescription(àl'exceptiondelapartiedecelle -ciréservéeaulistagedes séquences)etlapartiequisembleconstitueruneoudesrevendicationssoientrédigéesdans unelangueacceptéeparl'officérecepteur envertudela règle 12.1.a).

d) [Pasdemodification] Si,le1^{er} octobre 1997, l'alinéa c)n'estpascompatibleavecla législationnationaleappliquée parl'officérecepteur,ilnes'appliquepasàcelui -citantqu'il reste incompatibleavecladitelégislation,àconditionqueleditofficeeninforme le 31 décembre 1997auplustardleBureauinternational.Celui -cipublicàbrefdélai dans la gazettelesrenseignementsreçus.

20.2 ~~20.5~~ *Constatation positive selon l'article 11.1)*

[COMMENTAIRE : nouvelle numérotation et clarification uniquement. Aucune autre modification n'est proposée mais le texte de la règle actuelle est reproduit ci-après pour souci de commodité.]

a) [Pas de modification] Si la constatation au sens de l'article 11.1) est positive, l'officier récepteur appose sur la requête son timbre et les mots "demande internationale PCT" ou "PCT International Application". Si la langue officielle de l'officier récepteur n'est ni le français ni l'anglais, les mots "demande internationale" ou "International Application" peuvent être accompagnés de leur traduction dans la langue officielle de cet office.

b) [Pas de modification] L'exemplaire sur la requête duquel ce timbre a été apposé constitue l'exemplaire original de la demande internationale.

c) [Pas de modification] L'officier récepteur notifie à bref délai au déposant le numéro de la demande internationale et la date du dépôt international. En même temps, il envoie au Bureau international une copie de la notification envoyée au déposant, sauf s'il a déjà envoyé ou envoie en même temps l'exemplaire original au Bureau international selon la règle 22.1.a).

20.3 ~~20.6~~ Correction en vertu de l'article 11.2) ~~Invitation à corriger~~

a) L'invitation à corriger selon l'article 11.2) a) doit préciser quelle condition figurant à l'article 11.1) n'est pas, de l'avis de l'officier récepteur, été remplie.

[COMMENTAIRE : nouvelle numérotation et clarification uniquement.]

b) L'officier récepteur envoie à bref délai l'invitation visée à l'alinéa a). Dans cette invitation, l'officier récepteur invite l'adresse à bref délai l'invitation au déposant — le déposant à remettre la correction demandée, ou à présenter des observations, dans le délai indiqué à l'alinéa d) i) et fixe un délai, raisonnable en l'espèce, pour le dépôt de la correction. — ~~Ce délai ne doit pas être inférieur à dix jours, ni supérieur à un mois, à compter de la date de l'invitation.~~ Si ce délai expire plus d'une année après la date du dépôt de toute demande dont la priorité est revendiquée, l'officier récepteur ~~peut porter~~ porte cette circonstance à l'attention du déposant.

[COMMENTAIRE : en ce qui concerne la prescription selon laquelle le déposant doit avoir la possibilité de présenter des observations, voir l'article 5.3) du PLT. Il est en outre proposé de faire obligation aux offices récepteurs de porter à l'attention du déposant le fait que le délai fixé pour la correction expire après l'expiration du délai de priorité.]

c) Lorsqu'une ou plusieurs des conditions énoncées à l'article 11.1) ne sont pas remplies au moment de la réception de ce qui est supposé constituer une demande internationale mais qu'elles sont remplies à une date ultérieure, avant l'expiration du délai applicable en vertu de l'alinéa d), la date de dépôt internationale est, sous réserve de la règle 20.5, cette date ultérieure et l'officier récepteur prend les dispositions prévues à la règle 20.2.

[Règle 20.3.c), suite]

[COMMENTAIRE : voir l'article 5.4) du PLT. Il est proposé d'ajouter les nouveaux alinéas c) et d) afin de préciser la procédure concernant l'attribution de la date de dépôt international dans le cas où les conditions énoncées à l'article 11.1) sont remplies ultérieurement, en particulier compte tenu de la proposition de nouvelle règle 20.5 (attribution de la date de dépôt international lorsqu'une partie manquante ou un dessin manquant est déposé, notamment dans le cas où cette partie ou ce dessin figurait en totalité dans la demande antérieure dont la priorité est revendiquée : voir ci-dessous.]

d) Le délai visé aux alinéas b) et c) est

i) lorsqu'une invitation selon l'alinéa a) a été envoyée au déposant, de [un mois]

[deux mois] à compter de la date de l'invitation;

[COMMENTAIRE : voir l'article 5.3) du PLT et la règle 2.1 de son règlement d'exécution. Le délai a été mis entre crochets parce qu'il apparaît intrinsèquement problématique de prévoir dans le règlement d'exécution du PCT des délais plus généraux ("style PLT") qu'actuellement, sachant que le bon fonctionnement du système du PCT repose dans une large mesure sur l'enchaînement, en un laps de temps très limité, d'actes qui doivent être accomplis dans des délais stricts.]

ii) lorsqu'il n'a pas été envoyé au déposant d'invitation selon l'alinéa a), de

[un mois] [deux mois] à compter de la date à laquelle l'officier receveur a reçu initialement

l'un au moins des éléments indiqués à l'article 11.1)iii).

[COMMENTAIRE : voir l'article 5.4) du PLT et la règle 2.2 de son règlement d'exécution. Alors que le PLT ne prévoit le délai indiqué à l'alinéa ii) que pour le cas où il n'a pas été envoyé au déposant d'invitation à corriger "parce que les indications permettant à l'office d'entrer en relation avec le déposant n'ont pas été fournies", il est proposé d'appliquer ce délai à tous les cas où il n'y a pas eu envoi d'une invitation au déposant. Les délais ont été mis entre crochets parce qu'il apparaît intrinsèquement problématique de prévoir dans le règlement d'exécution du PCT des délais plus généraux ("de type PLT") qu'actuellement, sachant que le bon fonctionnement du système du PCT repose dans une large mesure sur l'enchaînement, en un laps de temps très limité, d'actes accomplis dans des délais stricts.]

20.4 ~~20.7~~ *Constatation négative* selon l'article 11.1)

Sil'office ne reçoit pas de ~~la~~ correction en vertu de l'article 11.2) dans le délai applicable en vertu de la règle 20.3.d) ~~prescrit, de réponse à son invitation à corriger,~~ ou si ~~la correction présentée par~~ le déposant remet une correction mais que celle-ci ne remplit toujours pas les conditions énoncées à l'article 11.1),

[COMMENTAIRE : découle des modifications proposées concernant l'actuelle règle 20.6 (règle 20.3 dans la nouvelle numérotation et adjonction proposée de deux alinéas nouveaux c) et d).]

i) il n'est pas notifié au déposant que ~~la~~ sa demande est réputée en passe de savoir être déposée ~~n'est pas et n'est pas traitée comme une demande internationale~~ et lui en indique les raisons;

[COMMENTAIRE : il est proposé de modifier le point i) de façon à aligner les termes utilisés sur ceux de l'article 5.4)b) du PLT. Les points ii) à iv) resteraient inchangés mais ils sont reproduits ci-après pour souci de commodité.]

ii) [Pas de modification] il notifie au Bureau international que le numéro qu'il a apposé sur les documents n'est pas utilisé en tant que numéro de demande internationale;

iii) [Pas de modification] il conserve les documents constituant ce qui est supposé constituer une demande internationale et toute correspondance y relative conformément à la règle 93.1 ;

iv) [Pas de modification] il adresse une copie de ces documents au Bureau international si, en raison d'une requête du déposant selon l'article 25.1), ce bureau a besoin d'une telle copie et en demande expressément une.

20.5 *Parti manquant de la description, des revendications ou des dessins*

a) Lorsque l'office récepteur remarque qu'une partie de la description, de la ou des revendications ou des dessins (le cas échéant) ne semble pas figurer dans la demande ("partie manquante"), notamment lorsque celle-ci renvoie à un dessin qui n'y est pas effectivement inclus, l'office invite à bref délai le déposant à remettre la partie manquante (le cas échéant) ou après enter des observations dans le délai prescrit à l'alinéa c) i). Si ce délai expire plus d'une année après la date du dépôt de toute demande dont la priorité est revendiquée, l'office récepteur porte cette circonstance à l'attention du déposant.

[COMMENTAIRE : selon les exigences actuelles du PCT en matière de parties manquantes, l'office récepteur est tenu d'envoyer notification au déposant seulement lorsqu'il manque un dessin (voir l'article 14.2) du PCT) mais non lorsqu'il manque une partie de la description ou une partie de la ou des revendications. Conformément à l'article 5.5) du PLT, il est proposé d'étendre le concept (favorable au déposant) de notification de partie manquante au cas où il manque une partie de la description et, sachant que la présence d'une revendication est une condition d'attribution de la date de dépôt en vertu du PCT, au cas où il manque une partie de la ou des revendications. Lorsque l'office récepteur adresse au déposant une invitation à corriger en vertu de l'article 11.2) a) ou de l'article 14.1) b), cette invitation devrait comporter la notification de partie manquante; les instructions administratives seraient à modifier en conséquence. En harmonie avec les notes relatives au PLT, il est en outre proposé de modifier les instructions administratives et les directives à l'usage des offices récepteurs de manière à préciser que l'office récepteur n'est pas tenu de vérifier si il manque une partie (de la description ou des revendications) ou si il manque un dessin : il a seulement l'obligation de vérifier que le nombre de feuilles de description effectivement déposées correspond au nombre indiqué dans le cadre^o IX de la requête (voir le paragraphe 149 des directives à l'usage des offices récepteurs) et l'obligation d'examiner le bordereau figurant dans la requête et le texte de la demande internationale pour y trouver d'éventuelles références à des dessins, auquel cas il doit vérifier si les dessins sont bien inclus dans la demande internationale (voir les paragraphes 193 et 194 des directives à l'usage des offices récepteurs). On notera que la dernière phrase d'un nouvel alinéa a) proposé devrait encore être modifiée dans l'hypothèse où une disposition concernant la restauration du droit de priorité serait ajoutée au règlement d'exécution du PCT (voir le document PCT/R/WG/4/1), étant donné que, dans ce cas, la date du dépôt international pourrait être postérieure de plus de 14 mois à la date de dépôt de la demande antérieure dont la priorité est revendiquée.]

[Règle 20.5, suite]

b) Lorsque le déposant remet une partie manquante à l'office récepteur dans le délai applicable en vertu de l'alinéa c), cette partie est incorporée à la demande internationale et, sous réserve des alinéas e) et f), la date de dépôt internationale est soit la date à laquelle l'office récepteur a reçu cette partie, soit la date à laquelle toutes les conditions énoncées à l'article 11.1) sont remplies, selon celle de ces deux dates qui est postérieure.

[COMMENTAIRE : voir l'article 5.6) du PLT. Il est proposé d'ajouter un nouvel alinéa b) de manière à préciser clairement, dans le règlement d'exécution, la procédure en matière d'attribution (ou de correction) de la date de dépôt internationale lorsque des feuilles destinées à compléter la demande internationale sont remises postérieurement à la date de réception initiale de documents. Actuellement, si l'article 14.2) expose la procédure en cas de dessins manquants, ni le traité ni le règlement d'exécution n'ont expressément la procédure concernant l'attribution (ou la correction) de la date de dépôt internationale lorsque des feuilles autres que des dessins manquants sont reçus postérieurement à la date de réception initiale de documents; cette question n'est expressément traitée que dans les instructions administratives (voir l'instruction 309) et dans les directives à l'usage des offices récepteurs (voir les paragraphes 200 à 207).]

c) Le délai visé aux alinéas a) et b) est

i) lorsqu'une invitation selon l'alinéa a) a été envoyée au déposant, de [un mois] [deux mois] à compter de la date de l'invitation;

ii) lorsqu'il n'a pas été envoyé au déposant d'invitation selon l'alinéa a), de [un mois] [deux mois] à compter de la date à laquelle l'office récepteur a reçu initialement l'un au moins des éléments indiqués à l'article 11.1).

[COMMENTAIRE : en ce qui concerne le délai applicable, voir l'article 5.6) du PLT et la règle 2.3.i) et ii) de son règlement d'exécution. Les délais ont été mis entre crochets parce qu'il apparaît intrinsèquement problématique de prévoir dans le règlement d'exécution du PCT des délais plus généraux ("de type PLT") qu'actuellement, sachant que le bon fonctionnement du système du PCT repose dans un large mesure sur l'enchaînement, en un laps de temps très limité, d'actes qui doivent être accomplis dans des délais stricts.]

[Règle 20.5, suite]

d) Le déposant peut, dans une communication adressée à l'office récepteur dans le délai applicable en vertu de l'alinéa c), demander qu'il nesoit pastenucompté d'une partie manquante mise en vertu de l'alinéa b), auquel cas la date de dépôt internationale est la date à laquelle toutes les conditions énoncées à l'article 11.1) sont remplies.

[COMMENTAIRE : voir l'article 5.6)c) du PLT. Le libellé proposé ("demander qu'il nesoit pastenucompté ") diffère de celui qui est employé dans le PLT ("retirer") afin d'éviter toute confusion avec un retrait en vertu de la règle 90bis.]

e) Lorsque la demande internationale revendique la priorité d'une demande antérieure et que la demande internationale, à la date à laquelle l'office récepteur initialement reçu l'au moins des éléments indiqués à l'article 11.1)iii), comporte une indication selon laquelle le contenu de la demande antérieure y est incorporé par renvoi, [et que le déposant remet une partie manquante, en vertu de l'alinéa b), dont le contenu figurait en totalité dans la demande antérieure, la date de dépôt internationale est la date à laquelle toutes les conditions énoncées à l'article 11.1) sont remplies, sous réserve que, dans le délai applicable en vertu de l'alinéa c),

[COMMENTAIRE : la principale différence entre les exigences du PLT et celles du PCT en matière de parties manquantes est celle -ci : en vertu du PLT, le déposant peut remédier à l'omission, au moment du dépôt, d'une partie de la description ou d'un dessin sans perte de la date de dépôt si la demande revendique la priorité d'une demande antérieure et que la partie manquante de la description ou le dessin manquant figurait en totalité dans cette demande antérieure (voir l'article 5.6) du PLT et la règle 2.3 et 4 du PLT). Il n'y a pas de disposition équivalente dans le PCT. En vue d'aligner les exigences du PCT sur celles du PLT, il est proposé d'ajouter une disposition de cette nature à l'annexe 2 d'exécution du PCT. La règle 2.4 du PLT laisse toute Partie contractante libre de choisir si elle souhaite exiger que la demande ait contenu, à la date de réception initiale des documents, une indication selon laquelle le contenu de la demande antérieure y était incorporé par renvoi (voir la règle 2.4.v) du PLT). Les délégations souhaiteront peut-être débattre de l'opportunité d'inclure ou non cette condition dans le règlement d'exécution du PCT, c'est pourquoi le texte correspondant a été placé entre crochets. En outre, il est proposé de ne pas prévoir à l'alinéa b) qu'il puisse

[Règle 20.5.e), suite]

être exigé, comme le permet la règle 2.4.ii) du règlement d'exécution du PLT, que le déposant, à l'invitation de l'office, remette une copie certifiée de la demande antérieure (le "document de priorité"), en plus de la "simple" copie de la demande antérieure qu'il est déjà tenu de fournir en vertu du point ii) de l'alinéa b) (voir ci-dessous). La remise d'une simple copie de la demande antérieure devrait suffire aux fins de la phase internationale; les conséquences en cas de non-concordance entre la simple copie et la copie certifiée de la demande antérieure seraient à traiter dans la phase nationale.]

i) le déposant présente une requête à cet effet à l'office récepteur;

ii) une copie de la demande antérieure soit remise à l'office récepteur;

[COMMENTAIRE : voir la règle 2.4.i) du règlement d'exécution du PLT.]

iii) lorsqu'une demande antérieure n'est pas rédigée dans la même langue

– acceptée par l'office récepteur en vertu de la règle 12.1.a) – d'une demande internationale,

une traduction de la demande antérieure dans cette langue soit remise à l'office récepteur; et

[COMMENTAIRE : voir la règle 2.4.iii) du règlement d'exécution du PLT.]

iv) le déposant fournisse à l'office récepteur une indication de l'endroit, dans la

demande antérieure ou dans la traduction visée au point iii), où figure la partie manquante.

[COMMENTAIRE : voir la règle 2.4.vi). Le PLT ne comporte aucune disposition qui exigerait du déposant qu'il remette une déclaration selon laquelle la partie manquante (ou le dessin manquant) fournie ultérieurement est identique à la "partie manquante" telle qu'elle figurait dans la demande antérieure; il semblerait donc qu'il faille faire obligation à l'office récepteur de comparer la partie manquante remise ultérieurement avec la partie correspondante contenue dans la demande antérieure.]

Règle 26

Contrôle et correction de certains éléments de la demande internationale auprès de l'officier récepteur

26.1 Invitation à corriger selon l'article 14.1)b) Délai pour le contrôle

a) L'officier récepteur ~~adresse l'invitation à corriger, prévue à l'article 14.1)b),~~ dès que possible et de préférence dans un délai d'un mois à compter de la réception de la demande internationale, invite le déposant, en vertu de l'article 14.1)b), à remettre la correction requise, ou à formuler des observations, dans le délai prescrit à la règle 26.2.

[COMMENTAIRE: il est proposé de modifier le titre de façon à ce qu'il reflète l'objet de l'alinéa a). En ce qui concerne la prescription visant à donner au déposant la possibilité de présenter des observations, voir l'article 6.7) du PLT.]

b) ~~[Supprimé] Si l'officier récepteur adresse une invitation à corriger l'irrégularité visée à l'article 14.1)a)iii) ou iv) (titre manquant ou abrégé manquant), il en notifie à l'administration chargée de la recherche internationale.~~

[COMMENTAIRE: il est proposé de déplacer le contenu de l'actuel alinéa b) pour l'incorporer dans les instructions administratives.]

26.2 *Délai pour la correction*

Le délai prévu à la règle 26.1 l'article 14.1)b) doit être raisonnable en l'espèce et est de [un mois][deux mois] fixé, dans chaque cas, par l'officier récepteur. Il est d'un mois au moins à compter de la date de l'invitation à corriger. Il peut être prorogé par l'officier récepteur à tout moment avant qu'une décision ait été prise.

[Règle 26.2, suite]

[COMMENTAIRE : voir l'article 6.7) du PLT et la règle 6.1) de son règlement d'exécution. Les délais ont été mis entre crochets parce qu'il apparaît intrinsèquement problématique de prévoir dans le règlement d'exécution du PCT des délais plus généreux ("de type PLT") qu'actuellement, sachant que le bon fonctionnement du système du PCT repose dans une large mesure sur l'enchaînement, dans un laps de temps très limité, d'actes qui doivent être accomplis dans des délais stricts.]

26.3 à 26.4 [Pas de modification]

26.5 *Décision de l'officier récepteur*

a) L'officier récepteur décide s'il est déposé et présente la correction dans le délai indiqué à l'alinéa b) de la règle 26.2 et, au cas où la correction a été présentée dans le délai applicable, si la demande internationale ainsi corrigée doit ou non être considérée comme retirée, étant entendu qu'aucune demande internationale ne doit être considérée comme retirée pour non-observation des conditions matérielles mentionnées à la règle 11 si elle remplit ces conditions dans la mesure nécessaire aux fins d'une publication internationale raisonnablement uniforme.

b) Le délai visé à l'alinéa a) est

i) lorsqu'une invitation selon la règle 26.2 a été envoyée au déposant, de [un mois] [deux mois] à compter de la date de l'invitation;

ii) lorsqu'il n'a pas été envoyé au déposant d'invitation selon la règle 26.2, de [un mois] [deux mois] [trois mois] à compter de la date à laquelle l'officier récepteur a reçu initialement l'un au moins des éléments indiqués à l'article 11.1 iii).

[Règle 26.5.b), suite]

[COMMENTAIRE : voir l'article 6.7) du PLT et la règle 6.1 et 2 de son règlement d'exécution. Les délais ont été mis entre crochets parce qu'il apparaît intrinsèquement problématique de prévoir dans le règlement d'exécution du PCT des délais plus généreux ("de type PLT") qu'actuellement, sachant que le bon fonctionnement du système du PCT repose dans une large mesure sur l'enchaînement, dans un laps de temps très limité, d'actes qui doivent être accomplis dans des délais stricts. Alors que le PLT ne prévoit le délai indiqué au point ii) que pour les cas où il n'a pas été envoyé au déposant d'invitation à corriger "parce que les indications permettant à l'office d'entrer en relation avec le déposant n'ont pas été fournies", il est proposé d'appliquer ce délai à tous les cas où il n'y a pas eu d'envoi d'une invitation au déposant.]

~~26.6 Dessins manquants~~

~~a) Si, conformément à l'article 14.2), la demande internationale se réfère à des dessins qui ne sont pas effectivement compris dans la demande, l'officier récepteur indique ce fait dans la dite demande.~~

[COMMENTAIRE : il est proposé de déplacer le contenu de l'alinéa a) pour l'incorporer dans les instructions administratives.]

~~b) La date de réception, par le déposant, de la notification prévue à l'article 14.2) n'a pas d'effet sur le délai fixé à la règle 20.2.a)iii).~~

[COMMENTAIRE : la suppression proposée de l'actuel alinéa b) découle de la proposition de modification de la règle 20 (voir ci-dessus).]

[Fin de l'annexe et du document]

WIPO



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INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Fourth Session
Geneva, May 19 to 23, 2003

FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS;
SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION;
PUBLICATION OF TRANSLATION FURNISHED BY THE APPLICANT ;
INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY;
CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

Document prepared by the International Bureau

BACKGROUND

1. At its third session, the Working Group reviewed proposals for reform of the PCT which had already been submitted to the Committee on Reform of the PCT or the Working Group but not yet considered in detail and agreed on the priority of those proposals, with a view to their inclusion in the work program of the Working Group. Among the proposals reviewed by the Working Group were certain proposals aimed at further streamlining and simplifying the PCT procedure.

2. The Working Group agreed that specific proposals for amendment of the Regulations would be prepared by the Secretariat, taking into account the discussion and conclusions reflected in the summary of the third session of the Working Group by the Chair and other points of detail noted by the International Bureau, for further consideration by the Working Group, where possible at its next session. Proposals for consideration in the short term would primarily be dealt with by way of amending the Regulations, but longer term proposals

involving revision of the Treaty should also be identified and draft provisions prepared (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 112).

3. The Annexes to this document contain a number of proposed amendments of the PCT Regulations aimed at further streamlining and simplifying the PCT procedure:¹

(i) Annex I contains proposals concerning the payment of a late furnishing fee following the issuance of an invitation to furnish a sequence listing under Rule 13ter.1 (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraphs 53 to 57, in particular, paragraph 57; and paragraphs 5 to 7, below);

(ii) Annex II contains proposals to simplify the protest procedure before both the International Searching Authority ("ISA") and the International Preliminary Examining Authority ("IPEA") in case of non-unity of invention (see document PCT/R/WG/3/1, Annex I, items 4 and 10; the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraphs 95 to 97; and paragraphs 8 to 10, below);

(iii) Annex III contains proposals to permit, upon request of the applicant, the publication of a translation furnished by the applicant, or of the international application as filed in a non-publication language, together with the international application (see the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 82; and paragraphs 11 and 12, below);

(iv) Annex IV contains a proposal to allow for the use of, and to introduce, a standardized international form for entry into the national phase (see document PCT/R/WG/3/5, paragraphs 67 and 68; the summary of the third session by the Chair, document PCT/R/WG/3/5, paragraph 67 and 68; and paragraphs 13 and 14, below);

(v) Annex V contains proposals to further amend Rules 4.11(a)(iv), 43 bis.1(b) and 94.2 as 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); it also contains a proposal to amend Rule 17.2, consequential on the amendment of Rule 17.1 as adopted by the PCT Assembly on October 1, 2002, and due to enter into force on January 1, 2004. See also paragraph 15, below.

4. The proposals are further outlined in the following paragraphs.

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

5. At its third session, the Working Group reviewed a proposal to amend Rule 13ter and to provide that International Searching Authorities and International Preliminary Examining Authorities would no longer be obliged to issue invitations to furnish sequence listings in computer readable form complying with the prescribed standard or to carry out an international search and international preliminary examination in case where a sequence listing complying with that standard had not been filed (see document PCT/R/WG/3/1, Annex I, item 5).

¹ Proposed additions and deletions are indicated, respectively, by underlining and striking through the text concerned. Certain provisions that are not proposed to be amended are included for ease of reference.

6. The Working Group agreed not to proceed with the proposal. However, recognizing that it was desirable that sequence listings complying with the prescribed standards should be furnished together with the international application so as not to delay the start of the international search, it was agreed that the International Bureau should prepare a proposal which would permit Authorities to require the payment of a late furnishing fee where an invitation had to be issued under Rule 13ter.1(a)(ii) or (e) (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 53 to 57, in particular, paragraph 57).

7. Annex I contains a proposal to amend Rule 13ter.1 accordingly.

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

8. With regard to the protest procedure before both the International Searching Authority ("ISA") and the International Preliminary Examining Authority ("IPEA") in case of non-unity of invention, the Working Group during its third session agreed that the International Bureau should prepare a proposal for simplifying the protest procedure under Rules 40 and 68 (see the summary of the session by the Chair, document PCT/R/WG/3/5, paragraphs 95 to 97, in particular, paragraph 97).

9. It was also agreed (see document PCT/R/WG/3/5, paragraph 97) 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."

10. Annex II contains a proposal to amend Rules 40 and 68 accordingly. An overview of the replies received in response to the questionnaire sent out by the International Bureau to all International Searching and Preliminary Examining Authorities (Circular C.PCT/896) is contained in document PCT/R/WG/4/4 Add.1.

PUBLICATION OF TRANSLATION FURNISHED BY THE APPLICANT

11. During its third session, the Working Group discussed proposals for a possible deletion of Article 64(4), based on document PCT/R/WG/3/1, Annex II, item 28. The Working Group agreed that further consideration of this matter, while it would be within the competence of the Working Group, should be deferred until progress had been made in discussions of prior art issues by the Standing Committee for the Law of Patents (SCP). As a related matter, the Working Group agreed, however, that the International Bureau should look into the possibility of amending Rule 48 so as to provide for the electronic publication by the International Bureau of translations, furnished by the applicant, of the international application (see the summary of the Chair of the third session of the Working Group, document PCT/R/WG/3/5, paragraphs 78 to 82).

12. Annex III contains proposals to amend Rule 48 so as to require the International Bureau, on request of the applicant, to publish, together with the international application, any translation of the international application furnished by the applicant or, where the international application was filed in a language which is not a language of publication, the international application in the language in which it was filed.

INTERNATIONAL FORM FOR NATIONAL PHASE ENTRY

13. At the third session of the Working Group, several delegations and representatives of users supported the proposed introduction of a standardized international form for entry into the national phase (see document PCT/R/WG/3/1, Annex I, item 11 (introduce international forms for national phase entry)), including standard texts of declarations similar to those provided for in the case of the request form under Rule 4.17, on the understanding that the use of such a form by applicants would be optional and not a requirement for a valid national phase entry. The Working Group agreed that the International Bureau should prepare such a proposal (see document PCT/R/WG/3/5, paragraphs 67 and 68).

14. Annex IV contains a proposal to amend Rule 49.4 accordingly. As regards the draft of a standardized international form for entry into the national phase, the International Bureau is studying the possible content of such a form, taking into account the various national requirements of designated and elected Offices allowed under Rule 51bis.

CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

15. Annex V contains proposals to further amend Rules 4.11(a)(iv), 43bis.1(b) and 94.2 as 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), and to amend Rule 17.2. These proposed amendments are in the nature of corrigenda or consequential amendments based on the amendments already adopted. Explanations are set out in Annex VI in Comments relating to the provisions concerned.

16. The Working Group is invited to consider the proposals contained in the Annexes to this document.

[Annex I follows]

ANNEXI

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

LATE FURNISHING FEE FOR LATE SUBMISSION OF SEQUENCE LISTINGS

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Rule 13ter

Nucleotide and/or Amino Acid Sequence Listings

13ter.1 Sequence Listing for International Authorities

(a) Where the International Searching Authority finds that the international application contains disclosure of one or more nucleotide and/or amino acid sequences but:

(i) [No change]

(ii) the applicant has not already furnished a sequence listing in computer readable form complying with the standard provided for in the Administrative Instructions, that Authority may invite the applicant to furnish to it [and to pay, where applicable, the late furnishing fee referred to in paragraph \(a-bis\)](#), within a time limit fixed in the invitation, a sequence listing in such a form complying with that standard.

[COMMENT: Text modeled after Rule 12.3(c)(ii). Further amendments of Rule 13ter are proposed in document [PCT/R/WG/4/6 \(Deposit of Sequence Listings\)](#).]

[\(a-bis\) The furnishing of a sequence listing in response to an invitation under paragraph \(a\)\(ii\) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a late furnishing fee. The amount of the late furnishing fee shall be determined by the International Searching Authority and shall be specified in the invitation under paragraph \(a\)\(ii\).](#)

[COMMENT: Text modeled after Rules 12.3(e) and 40.2(a).]

[Rule 13ter.1, continued]

(b) [Remains deleted]

(c) If the applicant ~~has~~ does not within the time limit fixed in the invitation, furnished
the required sequence listing and paid any required late furnishing fee ~~comply with an~~
~~invitation under paragraph (a) within the time limit fixed in the invitation~~, the International
Searching Authority shall not be required to search the international application ~~to the extent~~
~~that such non-compliance has the result that a meaningful search cannot be carried out~~.

[COMMENT: The proposed amendment to paragraph (c) is consequential on the proposed introduction (at the option of the International Searching Authority) of the late furnishing fee under paragraph (a) *-bis*): where the applicant does not pay any required late furnishing fee, the International Searching Authority would not be required to carry out international search, even if the applicant has furnished the required sequence listing.]

(d) [No change]

(e) [No change] Paragraphs (a) and (c) shall apply *mutatis mutandis* to the procedure before the International Preliminary Examining Authority.

[COMMENT: No change is proposed to paragraph (e) which is included in this document only for ease of reference. The effect of the proposed change to paragraph (a) would be that the International Preliminary Examining Authority would be permitted, under paragraph (e), to require the payment of a late furnishing fee where it had issued an invitation to furnish a sequence listing complying with the prescribed standard.]

13ter.2 [No change]

[Annex I follows]

ANNEXII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

SIMPLIFIED PROTEST PROCEDURE IN CASE OF NON-UNITY OF INVENTION

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68.4 and 68.5 [No change]	8

Rule 40

Lack of Unity of Invention (International Search)

40.1 *Invitation to Pay Additional Fees; Time Limit*

[COMMENT: Clarification only.]

The invitation to pay additional fees provided for in Article 17(3)(a) shall:

(i) specify the reasons for which the international application is not considered as complying with the requirement of unity of invention; ~~and shall~~

(ii) invite the applicant to pay the additional fees within [one month] [two months] from the date of the invitation, and indicate the amount of those fees to be paid ; and

(iii) invite the applicant to pay, where applicable, the protest fee referred to in Rule 40.2(e) within [one month] [two months] from the date of the invitation, and indicate the amount to be paid.

[COMMENT: It is proposed to amend Rule 40.1 so as to deal with all matters to be included in the invitation to the applicant (reasons, time limit for payment of additional fees and amount of those fees; where applicable, time limit for payment of protest fee and amount of that fee) for in just one Rule. See also Rule 40.3, below, which is proposed to be deleted. For the time limit for compliance with the invitation under items (ii) and (iii), two months would be consistent with the PLT but one month may be more appropriate to the tight time frame under which the PCT procedure operates.]

40.2 *Additional Fees*

(a) and (b) [No change]

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protests shall be examined by a ~~three-member~~ board of appeal or other review body constituted in the framework ~~special instance~~ of the International Searching Authority ~~or any competent higher authority~~, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the designated Offices together with the international search report. The applicant shall submit any translation thereof with the furnishing of the translation of the international application required under Article 22.

[COMMENT: To simplify the procedure, it is proposed to leave the form of the review body and its composition to the ISA. The expression “board of appeal or other review body constituted in the framework of...” is modeled after the terminology in paragraph 1.11 of the Explanatory Notes on the Patent Law Treaty. Furthermore, it does not appear necessary to provide for a protest in respect of unity of invention to be considered, in the first instance, by a higher authority than a board of appeal or other review body constituted in the framework of the ISA. This would, of course, not prevent a higher authority from hearing an appeal against a decision of that board of appeal or other review body.]

(d) ~~[Deleted] The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person whom made the decision which is the subject of the protest.~~

[COMMENT: It is proposed that the form of the review body and its composition should be left to the ISA.]

[Rule 40.2, continued]

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Searching Authority to the payment to it, for its own benefit, of a protest fee.
~~Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Searching Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fees shall be paid within one month from the date of the notification to the applicant of the result of the review.~~ Where the applicant has not, within the time limit under Rule 40.1(iii), paid any required ~~If the protest fee is not so paid,~~ the protest shall be considered withdrawn and the International Searching Authority shall so declare. The protest fees shall be refunded to the applicant where the ~~three member~~ board of appeal or other review body, ~~special instance or higher authority~~ referred to in paragraph (c) find that the protest was entirely justified.

[COMMENT: The amendment to the first sentence is proposed for the purpose of simplification – it does not appear necessary to oblige an ISA which wishes to require the payment of a protest fee for the examination of the protest to apply at a two-stage review process. The proposed amendment to the last sentence is consequential on the proposed amendment of paragraph (c).]

40.3 [Deleted] *Time Limit*

~~The time limit provided for in Article 17(3)(a) shall be fixed, in each case, according to the circumstances of the case, by the International Searching Authority; it shall not be shorter than 15 or 30 days, respectively, depending on whether the applicant’s address is in the same country as or in a different country from that in which the International Searching Authority is located, and it shall not be longer than 45 days, from the date of the invitation.~~

[COMMENT: See Comment on Rule 40.1 as proposed to be amended, above.]

Rule 68

Lack of Unity of Invention

(International Preliminary Examination)

68.1 [No change]

[PRODOMO: Rule 68 could be further simplified by deleting Rule 68.1 and amending Rule 68.2 to provide an invitation in all cases (subject to Rule 66.1(e)), in line with the Chapter I procedure under Rule 40.1. However, this is not proposed since it would take away the present applicant-friendly “no invitation” procedure under Rule 68.1.]

68.2 *Invitation to Restrict or Pay*

Where the International Preliminary Examining Authority finds that the requirement of unity of invention is not complied with and chooses to invite the applicant, at his option, to restrict the claims or to pay additional fees, [the invitation](#) shall:

(i) specify at least one possibility of restriction which, in the opinion of the International Preliminary Examining Authority, would be in compliance with the applicable requirement; ~~and shall~~

(ii) specify ~~the amount of the additional fees and~~ the reasons for which the international application is not considered as complying with the requirement of unity of invention; ~~It shall, at the same time,~~

[Rule 68.2, continued]

(iii) invite the applicant to comply with the invitation within [one month] [two months] from the date of the invitation; ~~fix a time limit, with regard to the circumstances of the case, for complying with the invitation; such time limits shall not be shorter than one month, and it shall not be longer than two months, from the date of the invitation~~

(iv) indicate the amount of the required additional fees to be paid in case the applicant so chooses; and

(v) invite the applicant to pay, where applicable, the protest fee referred to in Rule 68.3(c) within [one month] [two months] from the date of the invitation, and indicate the amount to be paid .

[COMMENT: The amendments proposed to Rule 68.2 correspond to those proposed to Rule 40.1.]

68.3 *Additional Fees*

(a) and (b) [No change]

[Rule 68.3, continued]

(c) Any applicant may pay the additional fee under protest, that is, accompanied by a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive. Such protests shall be examined by a ~~three-member~~ board of appeal or other review body constituted in the framework ~~special instance~~ of the International Preliminary Examining Authority, ~~or any competent higher authority~~, which, to the extent that it finds the protest justified, shall order the total or partial reimbursement to the applicant of the additional fee. On the request of the applicant, the text of both the protest and the decision thereon shall be notified to the elected Offices as an annex to the international preliminary examination report.

[COMMENT: The amendments proposed to paragraph (c) correspond to those proposed to Rule 40.2(c).]

(d) ~~[Deleted] The three-member board, special instance or competent higher authority, referred to in paragraph (c), shall not comprise any person whom the decision which is the subject of the protest.~~

[COMMENT: The proposed deletion of paragraph (d) corresponds to the proposed deletion of Rule 40.2(d).]

[Rule 68.3, continued]

(e) The examination of a protest referred to in paragraph (c) may be subjected by the International Preliminary Examining Authority to the payment to it, for its own benefit, of a protest fee. ~~Where the applicant has, under paragraph (c), paid an additional fee under protest, the International Preliminary Examining Authority may, after a prior review of the justification for the invitation to pay an additional fee, require that the applicant pay a fee for the examination of the protest (“protest fee”). The protest fees shall be paid within one month from the date of the notification to the applicant of the result of the review.~~ Where the applicant has not, within the time limit under Rule 68.2(iii), paid any required ~~If the~~ protest fee is not paid, the protest shall be considered ~~withdrawn~~ and the International Preliminary Examining Authority shall so declare. The protest fees shall be refunded to the applicant where the ~~three-member~~ board of appeal or other review body, ~~special instance or higher authority~~ referred to in paragraph (c) finds that the protest was entirely justified.

[COMMENT: The amendments proposed to paragraph (e) correspond to those proposed to Rule 40.2(e).]

68.4 and 68.5 [No change]

[Annex III follows]

ANNEXIII

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

PUBLICATION OF TRANSLATIONS IN ADDITION TO
INTERNATIONAL PUBLICATION OF THE INTERNATIONAL APPLICATION

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Rule 47

Communication to Designated Offices

47.1 and 47.1 [No change]

47.3 *Languages; Translations*

(a) The international application communicated under Article 20 shall be in the language in which it is published.

(b) Where the language in which the international application is published is different from the language in which it was filed, the International Bureau shall furnish to any designated Office, upon the request of that Office, a copy of that application in the language in which it was filed or of any translation furnished under Rule 48.3(d)(ii).

47.4 [No change]

Rule 48

International Publication

48.1 and 48.2 [No change]

48.3 Languages of Publication

(a) [No change] If the international application is filed in Chinese, English, French, German, Japanese, Russian or Spanish (“languages of publication”), that application shall be published in the language in which it was filed.

(b) [No change] If the international application is not filed in a language of publication and a translation into a language of publication has been furnished under Rule 12.3 or 12.4, that application shall be published in the language of that translation.

(c) If the international application is published under paragraph (a) or (b) in a language other than English, the international search report to the extent that it is published under Rule 48.2(a)(v), or the declaration referred to in Article 17(2)(a), the title of the invention, the abstract and any text matter pertaining to the figure or figures accompanying the abstract shall be published both in that language and in English. The translations shall be prepared under the responsibility of the International Bureau.

[Rule 48.3, continued]

(d) Upon request by the applicant received by the International Bureau prior to the expiration of 16 months from the priority date, and subject to the payment of a special fee whose amount shall be fixed in the Administrative Instructions, the International Bureau shall publish, together with the international application as published under paragraph (a) or (b):

(i) in the case referred to in paragraph (b), the international application in the language in which it was filed;

(ii) any translation of the international application furnished by the applicant within the time limit under paragraph (e).

[COMMENT: The proposed publication of the international application in the language in which it was filed (if filed in a non-publication language) and of any translation of the international application furnished by the applicant would take place in addition to, but would not form part of, the international publication of the international application under Article 21. Publication and communication to designated Offices of the international application in a language different from the language in which international publication takes place would be beneficial for the protection of rights of the applicant under the national law of certain designated States, for example, designated States which make provisional protection after the international publication of an international application conditional on the furnishing of a translation, or States where the prior art effect of an international application is, in accordance with Article 64(4), dependent on the publication of a translation into a language accepted by the Office of the designated State concerned.]

48.4 to 48.6 [No change]

[Annex IV follows]

ANNEXIV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:
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Rule 49

Copy, Translation and Filing Under Article 22

49.1 to 49.3 [No change]

49.4 *Use of National or International Form*

(a) No applicant shall be required to use a ~~national~~ form when performing the acts referred to in Article 22.

(b) The designated Office shall accept the use by the applicant, when performing the acts referred to in Article 22, of the form prescribed by the Administrative Instructions for the purposes of this paragraph, provided that the Office may require that the form shall be filed in a language of publication which it accepts for the purposes of this paragraph.

[COMMENT: The provision and use of any form for national phase entry (be it a national form made available by the designated Office concerned or the new international form) would remain optional, as at present. In addition, it is proposed to require any designated Office to accept the prescribed international form where the applicant chooses to use that form. By virtue of Rule 76.5, the same would apply to any elected Office. As is the case for all forms under the PCT which are to be used by the applicant, the form would be made available by the International Bureau in all seven languages of publication. As regards the draft of a standardized international form for entry into the national phase, the International Bureau is studying the possible content of such form, taking into account the various national requirements of designated and elected Offices allowed under Rule 51bis.]

49.5 to 49.6 [No change]

[Annex V follows]

ANNEXV

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:
 CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

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Rule 4

The Request (Contents)

4.1 to 4.10 [No change]

4.11 *ReferencetoEarlierSearch,ContinuationorContinuation -in-Part,orParent
Application orGrant*

(a) If:

(i) to (iii) [No change]

(iv) the applicant intends to make an indication under Rule 49 *bis.1(d)* ~~(e)~~ of the
wish that the international application be treated, in any designated State, as an
application for a continuation or a continuation-in-part of an earlier application;

the request shall so indicate and shall, as the case may be, identify the application in respect of
which the earlier search was made or otherwise identify the search, or indicate the relevant
parent application or parent patent or other parent grant.

[COMMENT: With regard to Rule 4.11 as adopted by the Assembly on October 1, 2002,
with effect from January 1, 2004 (see document PCT/A/31/10), it is proposed to further
amend Rule 4.11(a)(iv) so as to replace the erroneous reference to Rule 49 *bis.1(c)* with a
reference to Rule 49 *bis.1(d)*.]

(b) [No change]

4.12 to 4.14 [*Remain deleted*]

4.14 *bis* to 4.18 [No change]

Rule 17

The Priority Document

17.1 [No change]

17.2 *Availability of Copies*

(a) Where the applicant has complied with Rule 17.1(a) ~~or~~ (b) or (b -bis), the International Bureau shall, at the specific request of the designated Office, subject to paragraph (a-bis), promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. No such Office shall ask the applicant himself to furnish it with a copy. The applicant shall not be required to furnish a translation to the designated Office before the expiration of the applicable time limit under Article 22. Where the applicant makes an express request to the designated Office under Article 23(2) prior to the international publication of the international application, the International Bureau shall, at the specific request of the designated Office, furnish a copy of the priority document to that Office promptly after receiving it.

(a-bis) No designated Office shall request a copy of the priority document from the International Bureau under paragraph (a) if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library.

[COMMENT: It is proposed to amend Rule 17.2 so as to take into account the fact that, in the future, priority documents may be available to designated Offices from digital libraries; in the future, no designated Office shall request the International Bureau to furnish a copy of the priority document if the priority document is, in accordance with the Administrative Instructions, available to it from a digital library. See Rule 17.1 as amended by the Assembly on October 1, 2002, with effect from January 1, 2004 (see document PCT/A/31/10).]

(b) and (c) [No change]

Rule 43 bis

Written Opinion of the International Searching Authority

43bis.1 *Written Opinion*

(a) [No change]

(b) For the purposes of establishing the written opinion, Articles 33(2) to (6), 35(2) and 35(3) and Rules 43.4, 64, 65, 66.1(e), ~~66.2(a), (b) and (e)~~, 66.7, 67, 70.2(b) and (d), 70.3, 70.4(ii), 70.5(a), 70.6 to 70.10, 70.12, 70.14 and 70.15(a) shall apply *mutatis mutandis*.

[COMMENT: With regard to Rule 43 bis as adopted by the Assembly on October 1, 2002, with effect from January 1, 2004 (see document PCT/A/31/10), it is proposed to further amend Rule 43 bis.1(b) so as to delete the reference to Rule 66.2(a), (b) and (e). Rule 66.2(a) and (b) concern the content of the written opinion of the International Preliminary Examining Authority (IPEA) and should not be referred to as applying *mutatis mutandis* to the written opinion by the International Searching Authority (ISA). The references in Rule 43 bis.1(b) to the various paragraphs of Rule 70 are correct and sufficient: all issues covered in Rule 66.2(a) and (b) are also covered in Rule 70 (Rule 70.12(iii) correspond to Rule 66.2(a)(i); Rule 70.6 correspond to Rule 66.2(a)(ii); Rule 70.12(i) correspond to Rule 66.2(a)(iii); Rule 66.2(iv) is not applicable to the written opinion by the ISA; Rule 70.12(ii) correspond to Rule 66.2(a)(v); Rule 70.2(d) correspond to Rule 66.2(a)(vi); Rule 70.12(iv) correspond to Rule 66.2(a)(vii); Article 35(2) and Rules 70.6(a), 70.8 and 70.12 correspond to Rule 66.2(b); Rule 66.2(e) is not applicable to the written opinion by the ISA) (see also the Comment on proposed new Rule 43bis.1 in document PCT/R/2/7).]

(c) [No change]

Rule 94

Access to Files

94.1 [No change]

94.2 *Access to the File Held by the International Preliminary Examining Authority*

At the request of the applicant or any person authorized by the applicant, or of an
elected Office, once the international preliminary examination report has been ~~established~~
communicated to that Office in accordance with Rule 73.2(a) or (b)(i), ~~of any elected Office,~~
the International Preliminary Examining Authority shall furnish, subject to reimbursement of
the cost of the service, copies of any document contained in its file.

[COMMENT: The proposed amendment of Rule 94.2 is consequential on the amendment of Rule 73.2 as adopted by the Assembly on October 1, 2002 with effect from January 1, 2004 (see document PCT/A/31/10), so as to ensure that copies of any document contained in the file of the International Preliminary Examining Authority are not furnished to any elected Office before the international preliminary examination report has been communicated to that Office, that is, usually, not before the expiration of 30 months from the priority date (see Rule 73.2 as in force from January 1, 2004).]

94.3 [No change]]

[End of Annex V and of document]

OMPI



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

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ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE
GENÈVE

UNION INTERNATIONALE DE COOPÉRATION EN MATIÈRE DE BREVETS
(UNION DU PCT)

GRUPE DE TRAVAIL SUR LA RÉFORME DU TRAITÉ DE
COOPÉRATION EN MATIÈRE DE BREVETS (PCT)

Quatrième session
Genève, 19 – 23 mai 2003

PROCÉDURE DE RÉSERVE SIMPLIFIÉE EN CAS DE DÉFAUT D'UNITÉ DE
L'INVENTION : RÉPONSES REÇUES AU QUESTIONNAIRE

Document établi par le Bureau international

RAPPEL

1. À sa troisième session, tenue à Genève du 18 au 22 novembre 2002, le groupe de travail a examiné des propositions de modification du Règlement d'exécution du PCT relatives aux changements nécessaires ou souhaitables pour simplifier les procédures au sein des administrations chargées de la recherche internationale et de l'examen préliminaire international en cas de défaut d'unité de l'invention. Les délibérations du groupe de travail sont récapitulées dans le résumé de la session établi par la présidence, aux paragraphes 95 à 97 du document PCT/R/WG/3/5 :

“Unité de l'invention

“95. Les délibérations ont eu lieu sur la base des points 4 (Simplifier la procédure au sein de l'administration chargée de la recherche internationale en cas de défaut d'unité de l'invention) et 10 (Simplifier la procédure au sein de l'administration chargée de l'examen préliminaire international en cas de défaut d'unité de l'invention) de l'annexe I du document PCT/R/WG/3/1 et des points 10 et 18 (Supprimer la procédure relative à l'unité de l'invention) de l'annexe II du document PCT/R/WG/3/1.

“96. Certaines délégations ont proposé la suppression du système de réserve au sein des administrations chargées de la recherche internationale prévue à la règle 40 et du

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système de réserve au sein des administrations chargées de l'examen préliminaire international prévu à la règle 68, afin de réduire la charge de travail des administrations. La majorité des délégations et des représentants des utilisateurs, tout en reconnaissant que les procédures prévues dans les règles 40 et 68 sont lourdes, se sont déclarées opposées à la proposition visant à supprimer purement et simplement la procédure de réserve, au motif que cela priverait le déposant du droit de contester la décision d'une administration concluant au défaut d'unité de l'invention, ce qui accroîtrait la charge pesant sur les déposants et les offices désignés au cours de la phase nationale et se traduirait par des recherches et des examens incomplets pour un plus grand nombre de demandes internationales. Il a été suggéré que le problème de défaut d'unité de l'invention dans les demandes excessivement complexes ou dans les "méga-demandes" soit traité par d'autres moyens, tels que l'adoption d'une taxe additionnelle basée sur le nombre de revendications contenues dans la demande.

"97. Le groupe de travail est convenu que le Bureau international établira une proposition visant à simplifier la procédure de réserve prévue dans les règles 40 et 68. Il a également été convenu que, pour obtenir davantage d'informations sur l'expérience des administrations concernant cette question, le Bureau international devrait envoyer un questionnaire leur demandant d'indiquer combien d'invitations elles adressent annuellement en vertu des règles 40 et 68, combien de taxes additionnelles sont payées sous réserve et la proportion d'invitations portant sur des demandes contenant des revendications relatives à plus de dix inventions, par exemple."

2. Les propositions de modification du règlement d'exécution en ce qui concerne la procédure de réserve en cas de défaut d'unité de l'invention figurent dans l'annexe III du document PCT/R/WG/4/4.
3. Sous couvert de la circulaire C. PCT 896 datée du 19 décembre 2002, le Bureau international a adressé à toutes les administrations chargées de la recherche internationale et de l'examen préliminaire international un questionnaire sur la procédure de réserve en cas de défaut d'unité de l'invention. L'annexe du présent document contient les réponses reçues à la date de la publication du présent document.

4. *Le groupe de travail est invité à prendre note du contenu de l'annexe.*

[L'annexe suit]

ANNEXE

PROCÉDURE DE RÉSERVE SIMPLIFIÉE EN CAS DE DÉFAUT D'UNITÉ DE
L'INVENTION :

RÉPONSES REÇUES AU QUESTIONNAIRE

DÉFAUT D'UNITÉ DE L'INVENTION RELEVÉ PAR L'ADMINISTRATION CHARGÉE
DE LA RECHERCHE INTERNATIONALE

Question n° 1 : Combien d'invitations à payer des taxes additionnelles prévues à l'article 17.3.a) votre office a-t-il émises en sa qualité d'administration chargée de la recherche internationale en 2000 et 2001? Pour chacune de ces deux années, veuillez aussi indiquer le nombre de recherches internationales effectuées par votre office en sa qualité d'administration chargée de la recherche internationale.

Réponse de l'Australie : "2000 : 1779 recherches effectuées (au total) et 152 invitations émises (pour 267 recherches). 2001 : 1996 recherches effectuées (au total) et 178 invitations émises (pour 244 recherches)."

Réponse de l'Autriche : "L'Office autrichien des brevets, en sa qualité d'administration chargée de la recherche internationale, a émis quatre invitations à payer des taxes additionnelles en 2000 et une en 2001. 706 recherches internationales ont été effectuées en 2000 et 352 en 2001."

Réponse du Canada : "Étant donné que l'Assemblée de l'Union du PCT n'a approuvé que récemment la nomination de l'OPIC en qualité d'administration chargée de la recherche internationale et d'administration chargée de l'examen préliminaire international, et que l'OPIC ne commencera pas ses activités dans ces domaines avant juillet 2004, il n'est pas en mesure pour l'instant de répondre aux questions figurant dans le questionnaire."

Réponse de la Chine : "Notre office a reçu en sa qualité d'administration chargée de la recherche internationale 746 demandes internationales en 2000 et a émis 8 invitations à payer des taxes additionnelles à cet égard. En sa qualité d'administration chargée de la recherche internationale, notre office a reçu 1656 demandes internationales en 2001 et a émis 5 invitations à payer des taxes additionnelles à cet égard."

Réponse de l'Office européen des brevets : "2000 : 51 465 recherches internationales, 2722 invitations; 2001 : 53 353 recherches internationales, 3134 invitations."

Réponse du Japon : "2000 : 8468 recherches internationales, 247 invitations; 2001 : 10 716 recherches internationales, 495 invitations; 2002 : 12 646 recherches internationales, 762 invitations."

Réponse de l'Espagne : "2000 : 557 recherches internationales, 4 cas de défaut d'unité, 1 invitation; 2001 : 611 recherches internationales, 6 cas de défaut d'unité, 1 invitation."

Réponse de la Suède : "2000 : 114; 2001 : 97."

Question n° 2 : Parmi les invitations visées à la question 1, combien ont-elles été émises à l'égard de demandes internationales qui portaient sur 10 inventions ou plus?

Réponse de l'Australie : "2000 : 2; 2001 : 4"

Réponse de l'Autriche : "Aucune"

Réponse de la Chine : "1"

Réponse de l'Office européen des brevets : "Aucune donnée"

Réponse du Japon : "Données non disponibles"

Réponse de l'Espagne : "2000 : aucune; 2001 : aucune"

Réponse de la Suède : "Aucune donnée enregistrée"

Question n° 3 : En réponse aux invitations visées à la question n° 1, i) combien de taxes additionnelles ont-elles été payées à votre office, en moyenne, par demande internationale ayant donné lieu à une telle invitation et ii) combien de taxes additionnelles ont-elles ainsi été payées, en moyenne, par demande internationale portant sur 10 inventions ou plus (voir la question n° 2)?

Réponse de l'Australie : "i) 2000 : 36%; 2001 : 38%. ii) 2000 : 50% (1/2); 2001 : 50% (2/4) (bien que l'une d'entre elles ait donné lieu au paiement de taxes partielles seulement)."

Réponse de l'Autriche : "i) 4. ii) Aucune."

Réponse de la Chine : "i) $3 \times 800 = 2400$ (yuan)"

Réponse de l'Office européen des brevets : "i) Pas de données précises, mais des données empiriques suggèrent que des taxes additionnelles ne sont généralement pas payées.
ii) Aucune donnée."

Réponse du Japon : "i) Données non disponibles. ii) Données non disponibles"

Réponse de l'Espagne : i) 2000 : 1 invitation; 0 taxe additionnelle payée; 2001 : 1 invitation; 0 taxe additionnelle payée. ii) 2000 : 0 demande portant sur 10 inventions ou plus, 0 taxe additionnelle payée; 2001 : 0 demande portant sur 10 inventions ou plus, 0 taxe additionnelle payée."

Réponse de la Suède : "i) 2000 : 63.2 %; 2001 : 56.7%. ii) 2000 : 0%; 2001 : 0%"

Question n° 4 : En réponse aux invitations visées à la question n° 1, dans combien de cas le déposant a-t-il payé les taxes additionnelles à votre office sous réserve?

Réponse de l'Australie : "2000 : 4; 2001 : 6"

Réponse de l'Autriche : “Aucun”

Réponse de la Chine : “1”

Réponse de l'Office européen des brevets : “2000 : 144. 2001 : 167”

Réponse du Japon : “Données non disponibles”

Réponse de l'Espagne : “2000 : 1 invitation à payer des taxes additionnelles, 0 payée sous réserve. 2001 : 1 invitation à payer des taxes additionnelles, 0 payée sous réserve.

Réponse de la Suède : “i) 2000 : 18, ii) 2001 : 14”

Question n° 5 : Dans combien des cas visés à la question n° 4 votre office a-t-il ordonné i) le remboursement total ou ii) le remboursement partiel des taxes additionnelles au déposant parce que la réserve a été jugée justifiée (voir la règle 40.2.c))?

Réponse de l'Australie : “i) 2000 : 0/4; 2001 : 3/6. ii) 2000 : 1/4; 2001 : 0/6”

Réponse de l'Autriche : “Aucun”

Réponse de la Chine : “Aucun”

Réponse de l'Office européen des brevets : “i) 2000 : 31; 2001 : 47. ii) 2000 : 17; 2001 : 16”

Réponse du Japon : “i) Données non disponibles. ii) Données non disponibles.”

Réponse de l'Espagne : “Il n'y a aucun cas.”

Question n° 6 (ne concerne que les administrations chargées de la recherche internationale qui exigent du déposant le paiement d'une taxe d'examen de la réserve (“taxe de réserve”); voir la règle 40.2.e)) : Dans combien des cas visés à la question n° 4 votre office a-t-il remboursé la taxe de réserve au déposant parce que la réserve a été jugée entièrement justifiée (voir la règle 40.2.e))?

Réponse de l'Australie : “Sans objet; l'Office australien des brevets n'exige pas de taxe de réserve.”

Réponse de l'Autriche : “Aucun”

Réponse de la Chine : “Aucun”

Réponse de l'Office européen des brevets : “2000 (après examen préalable de la justification de l'invitation à payer des taxes additionnelles (règle 40.2.e)), non de la réserve elle-même) : 6.”

Réponse du Japon : “Données non disponibles”

Réponse de l'Espagne : “Pas de taxe de réserve”

Réponse de la Suède : “Sans objet”

DÉFAUT D'UNITÉ DE L'INVENTION RELEVÉ PAR L'ADMINISTRATION CHARGÉE DE L'EXAMEN PRÉLIMINAIRE INTERNATIONAL

Question n° 7 : Combien d'invitations à limiter les revendications ou à payer les taxes additionnelles prévues à l'article 34.3.a) votre office a-t-il émises en sa qualité d'administration chargée de l'examen préliminaire international en 2000 et 2001? Pour chacune de ces deux années, veuillez aussi indiquer le nombre d'examens préliminaires internationaux effectués par votre office en sa qualité d'administration chargée de l'examen préliminaire international.

Réponse de l'Australie : “2000 : 1393 examens préliminaires internationaux effectués (au total) et 2 invitations émises. 2001 : 1853 examens préliminaires internationaux effectués (au total) et 6 invitations émises.”

Réponse de l'Autriche : “Dans les années 2000 et 2001, l'Office autrichien des brevets a émis, en sa qualité d'administration chargée de l'examen préliminaire international, 2 invitations, une par année. En 2000, 199 examens préliminaires internationaux ont été effectués.”

Réponse de l'Office européen des brevets : “2000 : 1591 invitations à limiter les revendications; 33 609 examens préliminaires internationaux effectués.
2001 : 1447 invitations à limiter les revendications; 39 388 examens préliminaires internationaux effectués.”

Réponse du Japon : “2000 : 106 invitations à payer des taxes additionnelles; 4162 rapports d'examen préliminaire international. 2001 : 236 invitations à payer des taxes additionnelles; 5163 rapports d'examen préliminaire international. 2002 : 292 invitations à payer des taxes additionnelles; 6577 rapports d'examen préliminaire international.”

Réponse de l'Espagne : “L'Office espagnol des brevets et des marques n'était pas une administration chargée de l'examen préliminaire international à cette époque.”

Réponse de la Suède : “Pas de données enregistrées”

Question n° 8 : Pour chacune des deux années 2000 et 2001, est-il arrivé à votre office, et dans combien de cas, de constater qu'une demande ne satisfait pas l'exigence d'unité de l'invention mais de choisir de ne pas inviter le déposant à limiter les revendications ou à payer des taxes additionnelles ainsi que le prévoit l'article 34.3.a)?

Réponse de l'Australie : “Données non disponibles mais le nombre de cas est supposé être important”

Réponse de l'Autriche : “Trois (3)”

Réponse de l'Office européen des brevets : “En 2000 : environ 2100 (estimation).
En 2001 : environ 2900 (estimation).”

Réponse du Japon : “Données non disponibles”

Réponse de l'Espagne : “L'Office espagnol des brevets et des marques n'était pas une administration chargée de l'examen préliminaire international à cette époque.”

Réponse de la Suède : “Pas de données enregistrées”

Question n° 9 : Parmi les invitations visées à la question n° 7, combien ont-elles été émises à l'égard de demandes internationales qui portaient sur 10 inventions ou plus?

Réponse de l'Australie : “Aucune (pour les deux années)”

Réponse de l'Autriche : “Aucune”

Réponse de l'Office européen des brevets : “Aucune donnée enregistrée; il est probable que ce nombre soit faible compte tenu de la position de l'Office européen des brevets à l'égard de l'article 17.2.a)ii) du PCT et de la règle 66.1.e) de son règlement d'exécution”

Réponse du Japon : “Données non disponibles”

Réponse de l'Espagne : “L'Office espagnol des brevets et des marques n'était pas une administration chargée de l'examen préliminaire international à cette époque.”

Réponse de la Suède : “Aucune donnée enregistrée”

Question n° 10 : En réponse aux invitations visées à la question n° 7, dans combien de cas le déposant a-t-il choisi de limiter les revendications plutôt que de payer les taxes additionnelles?

Réponse de l'Australie : “2000 : 0; 2001 : 1”

Réponse de l'Autriche : “Aucun”

Réponse de l'Office européen des brevets : “Aucune donnée enregistrée”

Réponse du Japon : “Données non disponibles”

Réponse de l'Espagne : “L'Office espagnol des brevets et des marques n'était pas une administration chargée de l'examen préliminaire international à cette époque”

Réponse de la Suède : “Aucune donnée enregistrée”

Question n° 11 : En réponse aux invitations visées à la question n° 7 : i) combien de taxes additionnelles ont-elles été payées à votre office, en moyenne, par demande internationale ayant donné lieu à une telle invitation et ii) combien de taxes additionnelles ont-elles ainsi été payées, en moyenne, par demande internationale portant sur 10 inventions ou plus (voir la question n° 9)?

Réponse de l'Australie : i) 2000 : 100% (2/2); 2001 : 83% (5/6). ii) Aucune (pas d'invitations émises concernant ces demandes l'une ou l'autre année)"

Réponse de l'Autriche : "i) 4"

Réponse de l'Office européen des brevets : "i) Aucune donnée; ii) Aucune donnée"

Réponse du Japon : "i) Données non disponibles; ii) Données non disponibles"

Réponse de l'Espagne : "L'Office espagnol des brevets et des marques n'était pas une administration chargée de l'examen préliminaire international à cette époque"

Réponse de la Suède : "i) Zéro; ii) Pas de données enregistrées (voir la question n° 9)"

Question n° 12 : En réponse aux invitations visées à la question n° 7, dans combien de cas le déposant a-t-il payé les taxes additionnelles à votre office sous réserve?

Réponse de l'Australie : "Dans aucun cas, ni l'une ni l'autre année"

Réponse de l'Autriche : "Aucun"

Réponse de l'Office européen des brevets : "Environ 10% (estimation)"

Réponse du Japon : "Données non disponibles"

Réponse de l'Espagne : "L'Office espagnol des brevets et des marques n'était pas une administration chargée de l'examen préliminaire international à cette époque"

Réponse de la Suède : "2000 : 0; 2001 : 0"

Question n° 13 : Dans combien des cas visés à la question n° 12 votre office a-t-il ordonné i) le remboursement total ou ii) le remboursement partiel des taxes additionnelles au déposant parce que la réserve a été jugée justifiée (voir la règle 68.3.c))?

Réponse de l'Australie : "i) Aucun (aucune réserve formulée); ii) Aucun (aucune réserve formulée)"

Réponse de l'Autriche : "Aucun"

Réponse de l'Office européen des brevets : “i) et ii) : Aucune donnée pour l'un comme pour l'autre point, mais seul un pourcentage relativement faible de cas dans lesquels des taxes additionnelles ont été payées sous réserve entraînerait un remboursement total ou partiel”

Réponse du Japon : “i) Données non disponibles; ii) Données non disponibles”

Réponse de l'Espagne : “L'Office espagnol des brevets et des marques n'était pas une administration chargée de l'examen préliminaire international à cette époque”

Réponse de la Suède : “i) 2000 : 0; 2001 : 0. ii) 2000 : 0; 2001 : 0”

Question n° 14 (ne concerne que les administrations chargées de l'examen préliminaire international qui exigent du déposant le paiement d'une taxe d'examen de la réserve (“taxe de réserve”); voir la règle 68.3.e) : Dans combien des cas visés à la question n° 12 votre office a-t-il remboursé la taxe de réserve au déposant parce que la réserve a été jugée entièrement justifiée (voir la règle 48.3.e))?

Réponse de l'Australie : “Sans objet – l'Office australien des brevets n'exige pas de taxe de réserve” (veuillez noter que l'Office australien des brevets constate qu'il y a peu de réserves par rapport au nombre d'invitations émises (malgré l'absence de taxe de réserve) et l'expérience laisse à penser que la grande majorité des réserves que nous recevons actuellement sont relativement fondées. Nous sommes donc résolument favorables à la possibilité de formuler une réserve. Nous avons cependant apporté un certain nombre de modifications aux procédures internes pour rationaliser la procédure d'invitation et de réserve, notamment : 1. lorsqu'un grand nombre d'inventions a été recensé, le déposant est contacté par téléphone afin de s'assurer que l'invention principale est définie avant d'entreprendre une recherche ou d'émettre une invitation. Les motifs sont indiqués dans l'invitation lorsque le déposant a été précédemment contacté mais de manière succincte et non détaillée; 2. les réserves sont adressées à un seul vérificateur qui demande l'avis technique indépendant d'un examinateur de haut niveau. Le vérificateur prend une décision sur la base de cet avis et du temps nécessaire pour achever la deuxième recherche mais ne fournira au déposant les motifs détaillés de la décision que si la réserve est rejetée; et 3. indépendamment de la suite donnée à la réserve, un retour d'information interne sur la vérification est fourni à l'examineur qui a émis l'invitation initiale, dans un souci de qualité et de formation).”

Réponse de l'Autriche : “Aucun”

Réponse de l'Office européen des brevets : “Environ 2 ou 3 par an”

Réponse du Japon : “Données non disponibles”

Réponse de l'Espagne : “L'Office espagnol des brevets et des marques n'était pas une administration chargée de l'examen préliminaire international à cette époque”

Réponse de la Suède : “Sans objet”

OMPI



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

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ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE

GENÈVE

UNION INTERNATIONALE DE COOPÉRATION EN MATIÈRE DE BREVETS
(UNION DU PCT)

GRUPEDETRAVAIL SUR LA REFORME DU TRAITE DE
COOPÉRATION EN MATIÈRE DE BREVETS (PCT)

Quatrième session
Genève, 19 – 23 mai 2003

RATIONALISER ET SIMPLIFIER D'AVANTAGE LES PROCÉDURES DU PCT:

RECTIFICATION D'ERREURS ÉVIDENTES

Document établi par le Bureau international

RAPPEL

1. À sa première session, tenue du 12 au 16 novembre 2001, le groupe de travail a examiné une proposition des États-Unis d'Amérique visant à modifier la règle 91¹ en vue de limiter la rectification d'erreurs évidentes aux seules erreurs contenues dans la requête et de supprimer la possibilité de rectifier des erreurs évidentes contenues dans la description, les revendications, les dessins et l'abrégé des demandes internationales (voir les paragraphes 8 à 12 du document PCT/R/WG/1/4). Le résumé de ces discussions, qui figure dans le document PCT/R/WG/1/9, indique ce qui suit :

¹ Dans le présent document, les termes "articles" et "règles" renvoient respectivement aux articles du Traité de coopération en matière de brevets (PCT) et aux règles du règlement d'exécution du PCT (ci-après dénommé "règlement d'exécution"), ou aux dispositions qu'il est proposé de modifier ou d'ajouter, selon le cas (les textes en vigueur peuvent être consultés sur le site Web de l'OMPI, à l'adresse http://www.wipo.int/pct/fr/access/legal_text.htm). Les termes "législation nationale", "demandes nationales", "phase nationale", etc. désignent également la législation, les demandes et la phase régionales. Les termes "articles du PLT" et "règles du règlement d'exécution du PLT" renvoient respectivement au Traité sur le droit des brevets (PLT) et au règlement d'exécution du PLT (voir le document PCT/DC/47 sur le site Web de l'OMPI à l'adresse http://www.wipo.int/eng/document/pt_dc/index.htm).

“*Proposition de modification de la règle 91 (voir le document PCT/R/WG/1/4)*

“34 Les observations formulées et les préoccupations exprimées par diverses délégations sont notamment les suivantes :

“i) lorsque certaines délégations se sont déclarées favorables à la perspective adoptée dans la proposition, d’autres ont estimé que la correction d’erreurs évidentes ne devrait pas être limitée aux erreurs figurant dans la requête mais devrait continuer à être possible en ce qui concerne les erreurs évidentes figurant dans la description, les revendications et les dessins; toute demande de correction d’une erreur de ce type devrait être traitée le plus tôt possible au cours de la phase internationale plutôt qu’au plus tôt que par les différents offices désignés au cours de la phase nationale;

“ii) compte tenu de la charge de travail qu’elle représente pour les offices le traitement des demandes de rectification en vertu de la règle 91 actuelle, il a été estimé qu’il faut trouver une solution équilibrée laissant aux déposants une latitude suffisante pour corriger des erreurs évidentes sans imposer une charge de travail excessive aux offices qui traitent ces demandes;

“iii) compte tenu des discussions en cours dans le cadre du projet de traité sur l’harmonisation du droit matériel des brevets, certaines délégations ont exprimé le souhait que la définition actuelle des termes “erreur évidente” au sens de la règle 91.1.b) soit révisée.

“35. Il a été convenu que la proposition de modification de la règle 91 ne devrait pas figurer parmi les projets révisés à établir par le Bureau international, bien que les délégations puissent souhaiter poursuivre l’examen de la question compte tenu des délibérations qu’on teulieu. ”

2. En vue de la deuxième session du groupe de travail, le Bureau international a établi un document (PCT/WG/2/6) qui recense d’autres possibilités de modification du PCT en rapport avec le PLT. En ce qui concerne la rectification d’erreurs en vertu de la règle 18 du PLT, le paragraphe 14 du document susmentionné indique ce qui suit :

“*Rectification d’erreurs*

“14. Le PLT fixe les exigences qu’une partie contractante est autorisée à appliquer à l’égard des requêtes en rectification par l’office d’une erreur dans une demande (voir la règle 18 du règlement d’exécution du PLT). Il définit en particulier le contenu d’une requête pouvant être exigé par l’office; il impose également à l’office l’obligation de notifier au déposant toute inobservation d’une ou de plusieurs conditions applicables et de lui donner la possibilité de remplir ces conditions ultérieurement. Cela étant, il n’indique pas quelles erreurs peuvent être rectifiées. La règle 91.1 du règlement d’exécution du PCT prévoit la rectification des erreurs évidentes dans la demande internationale ou d’autres documents. Cela étant, elle ne fixe aucune exigence concernant la teneur de la requête en rectification. Elle n’impose pas non plus à l’office récepteur, à l’administration chargée de la recherche internationale, à l’administration chargée de l’examen préliminaire international ou au Bureau international, selon le cas, de notifier au déposant l’inobservation d’une ou de plusieurs conditions applicables ni de lui donner une possibilité de remplir ces conditions ultérieurement.”

3. Toutefois, il a été suggéré “de ne pas soumettre au groupe de travail de proposition visant à aligner le PCT sur la règle 18 du règlement d'exécution du PLT avant une session ultérieure, cette question ne semblant pas revêtir un rang de priorité élevé” (voir le paragraphe 15 du document PCT/WG/2/6); à la deuxième session, le groupe de travail n'a pas été en mesure, faute de temps, d'examiner le document PCT/WG/2/6 (voir le paragraphe 59 du document PCT/WG/2/12)).
4. À la troisième session, le groupe de travail a examiné une proposition de représentant de l'Office européen des brevets (OEB) en faveur de la modification de la règle 91.1.b) afin de mentionner une “personne du métier” au lieu de “n'importe qui” s'agissant de déterminer si une rectification proposée par le déposant est “évidente” au sens de cette règle. Plusieurs délégations ont appuyé cette proposition et ont estimé que, d'une manière générale, la règle 91 est inutilement stricte. Il a été convenu que l'OEB et le Bureau international collaboreront en vue d'examiner la règle 91 et de présenter une proposition par écrit pour examen par le groupe de travail (voir le paragraphe 64 du document PCT/R/WG/3/5 relatif au résumé de la troisième session du groupe de travail établi par la présidence).
5. L'annexe du présent document contient des propositions de modification de la règle 91 dans ce sens, ainsi que des propositions de modification à apporter en conséquence aux règles 12, 48, 66 et 70. Par souci d'information et de précision, les propositions de modification de la règle 91 sont indiquées à la fois sous la forme d'une version sans annotations du texte de la règle, telle qu'il se présenterait après modification, et sous la forme d'une version annotée du texte qu'il est proposé de modifier.

6. Le groupe de travail est invité à examiner les propositions contenues dans l'annexe.

[L'annexe suit]

ANNEXE

PROPOSITIONS DE MODIFICATION DE LA RÈGLE D'EXECUTION DU PCT :
RECTIFICATION D'ERREURS EVIDENTES

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Règle 12

Languedelademandeinternationaleettraductionauxfinsdelarecherche internationale etdelapublicationinternationale

12.1 [Sanschangement]

12.2 *Languedeschangementsapportésàlademandeinternationale*

a) [Sanschangement]

b) Toutrectificationd'une erreur **évidente**contenuedanslademandeinternationale faiteenvertudela règle [91](#) ~~91.1~~doitêtrérédigéedanslalanguedanslaquellelademandea étédéposée;toutefois,

[COMMENTAIRE :laprésente propositiondemodificationfaitsuiteàlapropositionde modificationdelarègle 91(voirci -après).]

i) etii) [Sanschangement]

c) [Sanschangement]

12.3 et12.4 [Sanschangement]

Règle 48

Publication internationale

48.1 [Sans changement]

48.2 *Contenu*

a) La brochure contient ou reprend:

i) à vi) [Sans changement]

vii) toute requête en rectification d'une erreur, tout motif et tout commentaire visés
à la règle 91.3.d) lorsqu'elle est publiée en publications selon la règle 91.3.d) a été reçue par le
Bureau international avant l'achèvement de la préparation technique de la publication
internationale ~~visée à la troisième phrase de la règle 91.1.f)~~;

viii) à x) [Sans changement]

b) à h) [Sans changement]

h-bis) Si l'autorisation de rectifier une erreur dans la demande internationale visée à la
règle 91.1.b) i) et ii) est reçue par le Bureau international après l'achèvement de la préparation
technique de la publication internationale, soit la brochure (contenant la demande
internationale rectifiée) fait l'objet d'une nouvelle publication, soit une déclaration indiquant
toutes les rectifications est publiée. Dans ce dernier cas, au moins la page de couverture

[Règle 48.2)h-bis,suite]

fait l'objet d'une nouvelle publication et les feuilles contenant les rectifications ou les pages de remplacement et la lettre fournie en vertu de la règle 91.2.c), selon le cas, sont publiées .

i) Les instructions administratives déterminent les cas où les diverses variantes mentionnées aux alinéas g) ~~e~~h) eth -bis seront appliquées. Cette détermination dépend du volume et de la complexité des modifications ou des rectifications et du volume de la demande internationale ainsi que des frais y relatifs.

j) Si la requête en publication selon la règle 91.3.d) est reçue par le Bureau international après l'achèvement de la préparation technique de la publication internationale, la requête en rectification, tout motif et tout commentaire visés à la règle 91.3.d) sont publiés à bref délai après la réception de la requête en publication et la page de couverture fait l'objet d'une nouvelle publication.

[COMMENTAIRE : les propositions de modification de la règle 48.2 font suite au changement de démarche proposé en ce qui concerne le délai dans lequel une requête en rectification d'une erreur peut être présentée; voir la nouvelle règle 91.2.a) proposée.]

48.3 à 49.6 [Sans changement]

Règle 66

Procédureuseindel'administrationchargéedel'examenpréliminaireinternational

66.1 à 66.5 [Sanschangement]

66.5 *Modifications*

Tout changement –autre quela ~~qu'une~~rectification d'uneerreur ~~d'erreursévidentes~~ –
apportéauxrevendications, àladescriptionouauxdessins,ycompristoutesuppressionde
revendications,depassagesdeladescriptionoudedessins,estconsidérécommeune
modification.

[COMMENTAIRE :laprésentepropositiondemodificationfaitsuiteàlapropositionde
modificationdelarègle 91(voirci -après).]

66.6 à 66.9 [Sanschangement]

Règle 70

Rapport d'examen préliminaire international sur la brevetabilité établi par l'administration chargée de l'examen préliminaire international (rapport d'examen préliminaire international)

70.1 à 70.15 [Sans changement]

70.16 *Annexes du rapport*

Chaque feuille de remplacement visée à la règle 66.8.a) ou b), chaque feuille de remplacement contenant des modifications effectuées en vertu de l'article 19 et chaque feuille de remplacement contenant des rectifications d'erreurs **évidentes** autorisées en vertu de la règle [91.1.b\)iii\)](#) ~~91.1.e)iii)~~ est, sauf si d'autres feuilles de remplacement lui ont été substituées ultérieurement ou si les modifications entraînent la suppression de feuilles entières comme il est prévu à la règle 66.8.b), annexée au rapport. Les modifications effectuées en vertu de l'article 19 qui ont été considérées comme écartées par une modification effectuée en vertu de l'article 34 et les lettres visées à la règle 66.8 ne sont pas annexées.

70.17 [Sans changement]

Règle 91[versionsansannotations] ²

Rectification d'erreurs contenues dans la demande internationale ou dans d'autres documents

91.1 *Rectification d'erreurs*

a) Une erreur contenue dans la demande internationale ou dans un autre document présenté par le déposant peut, sous réserve des alinéas b) à e) et des règles 91.2 et 91.3, être rectifiée sur requête du déposant .

b) Une rectification ne peut être faite que si elle est autorisée par "l'administration compétente", à savoir,

i) l'officier receveur si l'erreur se trouve dans la requête;

ii) l'administration chargée de la recherche internationale si l'erreur figure dans une partie de la demande internationale autre que la requête ou dans une modification ou une correction apportée à cette demande ou dans un autre document soumis à cette administration;

iii) l'administration chargée de l'examen préliminaire international si l'erreur figure dans une partie de la demande internationale autre que la requête ou dans une modification ou une correction apportée à cette demande ou dans un autre document soumis à cette administration;

² Les commentaires relatifs aux différentes dispositions ne figurent que dans la version annotée ci-après.

[Règle 91.1.b), suite]

iv) le Bureau international si l'erreur figure dans un document quelconque, autre que la demande internationale ou des modifications ou corrections à cette demande, soumis au Bureau international.

c) L'administration compétente autorise une rectification si elle constate que, à la date applicable visée à l'alinéa d), l'erreur signalée constitue manifestement une erreur et que le sens découlant de la rectification proposée est manifestement le même que celui visé dans la demande internationale ou dans un autre document; dans le cas contraire, l'administration compétente refuse d'autoriser la rectification. En cas d'erreur dans la description, les revendications ou les dessins, ou en cas de modification ou de correction de ces derniers en vertu de la règle 26, la constatation est fondée sur ce qu'une personne du métier aurait compris, à la date applicable visée à l'alinéa d), à la lecture de la demande internationale ou de la modification ou de la correction.

d) Aux fins de l'alinéa c), la date applicable est,

i) en cas d'erreur dans la demande internationale, la date du dépôt international;

ii) en cas d'erreur dans tout autre document, y compris une modification ou une correction apportée à la demande internationale, la date à laquelle ce document a été présenté.

[Règle 91.1, suite]

e) L'omission d'un élément entier ou d'une feuille entière de la demande internationale n'est pas rectifiable en vertu de la présente règle[, mais si dans la présente règle n'empêche l'inclusion, conformément à la règle 20.5, d'une partie manquante contenant un élément entier ou une feuille entière].

f) Lorsque l'officier récepteur, le Bureau international, l'administration chargée de la recherche internationale ou l'administration chargée de l'examen préliminaire international découvre ce qui semble constituer une erreur rectifiable dans la demande internationale ou dans un autre document, il peut inviter le déposant à demander une rectification en vertu de la présente règle .

91.2 Requête en rectification

a) La requête en rectification est présentée à l'administration compétente dans le délai indiqué ci-après, selon le cas :

i) lorsque l'administration compétente est l'officier récepteur, le Bureau international ou l'administration chargée de la recherche internationale, [26][27][28] mois à compter de la date de priorité;

ii) lorsque l'administration compétente est l'administration chargée de l'examen préliminaire international, au moment où cette administration commence à établir le rapport d'examen préliminaire international .

[Règle 91.2, suite]

b) La requête en rectification contient les indications suivantes :

i) l'indication du fait que la rectification d'une erreur est demandée;

ii) l'erreur à rectifier; et

iii) la rectification proposée;

ainsique, au choix du déposant,

iv) une explication succincte de l'erreur et de la rectification proposée.

c) La règle 26.4 est applicable, *mutatis mutandis*, à la procédure à suivre pour demander des rectifications.

91.3 Autorisation de rectifier

a) L'administration compétente décide à bref délai, conformément à la règle 91.1.c), de l'opportunité d'autoriser ou de refuser d'autoriser la rectification et le notifie à bref délai au déposant et au Bureau international, en motivant ses décisions s'ils'agit d'un refus.

[Règle 91.3, suite]

b) Lorsque la rectification est autorisée par l'administration compétente, elle doit être apportée dans la demande internationale ou l'autre document concerné de la manière prévue dans les instructions administratives.

c) Lorsqu'une rectification est autorisée par l'administration compétente, elle produit effet,

i) en cas d'erreur dans la demande internationale, à compter de la date du dépôt international;

ii) en cas d'erreur dans un autre document, y compris une modification ou une correction apportée à la demande internationale, à compter de la date à laquelle ce document a été présenté.

d) Lorsque l'autorisation de rectifier est refusée, le Bureau international, si la requête lui est présentée par le déposant dans un délai [d'un mois] [de deux mois] à compter de la date de la décision de l'administration compétente et sous réserve du paiement d'une taxe spéciale dont le montant est fixé dans les instructions administratives, publier la requête en rectification, les motifs du refus par l'administration compétente et tout autre commentaire succinct éventuellement formulé par le déposant, si possible avec la demande internationale. Une copie de la requête, des motifs et des commentaires (s'il y a lieu) est, si possible, insérée dans la communication selon l'article 20 lorsqu'un exemplaire de la brochure n'est pas utilisé pour cette communication ou lorsque, en vertu de l'article 64.3), la demande internationale n'est pas publiée.

Règle 91 [version annotée]

Rectification d'erreurs contenues dans la demande internationale ou dans d'autres

~~Erreurs évidentes contenues dans des~~ documents

91.1 *Rectification d'erreurs*

a) Une erreur ~~Sous réserve des alinéas b) à g) (quater)~~, les erreurs évidentes ~~contenues~~ dans la demande internationale ou dans un autre ~~d'autres~~ document ~~s~~ présenté ~~s~~ par le déposant ~~peut peuvent~~, sous réserve des alinéas b) à e) et des règles 91.2 et 91.3, ~~être~~ rectifiée ~~s~~ sur requête du déposant .

[COMMENTAIRE : bien que dans le projet de SPLT, le terme "correction" soit utilisé à la place de "rectification" (voir l'article 7.3 et la règle 7.2) du projet de SPLT), il est proposé, en ce qui concerne la règle 91 du PCT, de continuer à utiliser le terme "rectification" de manière à maintenir une distinction entre les "modifications" apportées à la description, aux revendications ou aux dessins (selon les articles 19 et 34) et les "corrections" des irrégularités de forme (selon l'article 14 et la règle 26).]

[Règle 91.1, suite]

- b) ~~e) Une Toute~~ rectification ne peut être apportée que si elle est autorisée par
“l’administration compétente”, à savoir, ~~exiger l’autorisation expresse~~
- i) ~~de~~ l’officier receveur si l’erreur se trouve dans la requête;
- ii) ~~de~~ l’administration chargée de la recherche internationale si l’erreur figure dans
une partie de la demande internationale autre que la requête ou dans une modification ou une
correction apportée à cette demande ou dans un autre document soumis à cette administration;
- iii) ~~de~~ l’administration chargée de l’examen préliminaire international si l’erreur
figure dans une partie de la demande internationale autre que la requête ou dans une
modification ou une correction apportée à cette demande ou dans un autre document soumis à
cette administration;
- iv) ~~du~~ le Bureau international si l’erreur figure dans un document quelconque, autre
que la demande internationale ou des modifications ou corrections à cette demande, soumis au
Bureau international.

[COMMENTAIRE : la modification proposée vise à préciser quel “administration compétente” à laquelle il est fait référence aux alinéas c), f) et g) de la règle 91.1 et aux alinéas b), c), d) et e) de la règle 91.2 est l’officier receveur, l’administration chargée de la recherche internationale, l’administration chargée de l’examen préliminaire international ou le Bureau international, selon le cas.]

[Règle 91.1, suite]

~~c) b) Les erreurs qui sont dues au fait que, dans la demande internationale ou dans les autres documents, était écrit quelque chose d'autre que ce qui, de toute évidence, était voulu, sont considérées comme des erreurs évidentes. La rectification elle-même doit être évidente en ce sens qu'en l'importe qui devrait constater immédiatement qu'il y a d'autre que le texte proposé tant que la rectification n'aurait pu être voulue. L'administration compétente autorise une rectification si elle constate que, à la date applicable visée à l'alinéa d), l'erreur signalée constitue un manifestement d'une erreur et que le sens découlant de la rectification proposée est manifestement le même que celui visé dans la demande internationale ou dans un autre document; dans le cas contraire, l'administration compétente refuse d'autoriser la rectification. En cas d'erreur dans la description, les revendications ou les dessins, ou en cas de modification ou de correction de ces derniers en vertu de la règle 26, la constatation est fondée sur ce qu'une personne du métier aurait compris, à la date applicable visée à l'alinéa d), à la lecture de la demande internationale ou de la modification ou de la correction.~~

[COMMENTAIRE : compte tenu des délibérations du groupe de travail à sa troisième session, il est proposé de rendre plus réalistes les exigences contenues dans le présent alinéa et, en cas d'erreur dans la description, les revendications ou les dessins, de renvoyer à une "personne du métier" plutôt qu'à "n'importe qui" s'agissant de déterminer si une telle erreur est rectifiable.]

[Règle 91.1, suite]

d) Aux fins de l'alinéa c), la date applicable est,

i) en cas d'erreur dans la demande internationale, la date du dépôt international;

ii) en cas d'erreur dans tout autre document, y compris une modification ou une correction apportée à la demande internationale, la date à laquelle ce document a été présenté.

[COMMENTAIRE : une constatation selon l'alinéa c) serait donc fondée, i) si l'erreur est contenue dans la description, les revendications ou les dessins, sur ce qu'une personne du métier aurait compris, à la date du dépôt international, à la lecture de la demande internationale; ii) si l'erreur est contenue dans la requête, sur ce que la personne chargée au sein de l'office récepteur d'autoriser la requête en rectification aurait compris, à la date du dépôt international, à la lecture de la demande internationale; iii) si l'erreur est contenue dans une modification ou une correction apportée à la demande internationale, sur ce qu'une personne du métier aurait compris, au moment où la modification ou la correction serait présentée, à la lecture de cette modification ou de cette correction; iv) si l'erreur est contenue dans tout autre document, sur ce que la personne chargée au sein de l'administration compétente d'autoriser la requête en rectification aurait compris, au moment où le document en question serait présenté, à la lecture de ce document.]

[Règle 91.1, suite]

e) ~~e)~~ L'omission d'un élément d'éléments en tiers ou d'une de feuille ~~sentièr~~ ~~s~~ de la demande internationale ~~, même si elle résulte clairement d'une inattention, au stade, par exemple, de la copie ou de l'assemblage des feuilles,~~ n'est pas rectifiable en vertu de la présenterègle [mais riendans présenterègle n'empêchel'inclusion, conformément à la règle 20.5, d'une partie manquante contenant un élément entier ou une feuille entière].

[COMMENTAIRE : les mots entre crochets ne seront incorporés au présent alinéa que si les modifications de la règle 20 proposées dans le document PCT/R/WG/4/2, relatives à l'inclusion de "parties manquantes", sont adoptées en même temps que les présentes modifications; dans le cas contraire, ils devront être ajoutés ultérieurement, après la modification de la règle 20.]

f) ~~f)~~ Lorsque l'officier récepteur, le Bureau international, l'administration chargée de la recherche internationale ou l'administration chargée de l'examen préliminaire international découvre ~~Des rectifications peuvent être faites sur requête du~~ ~~déposant. L'administration~~ ~~ayant découvert~~ ce qui semble constituer une erreur rectifiable évidente dans la demande internationale ou dans un autre document, il peut inviter le déposant à demandeur une rectification ~~présenter une requête en rectification~~ ~~, dans les conditions prévues aux alinéas~~ ~~à g- quater)~~ en vertu de la présenterègle . ~~La règle 26.4 est applicable, mutatis mutandis, à la~~ ~~procédure à suivre pour demander des rectifications.~~

[COMMENTAIRE : la modification de la présente disposition est proposée uniquement à des fins de clarification. Il est proposé de transférer la dernière phrase du présent alinéa ~~d)~~ dans la nouvelle règle 91.2.b) proposée (voir ci -après).]

91.2 Requête en rectification

a) La requête en rectification est présentée à l'administration compétente dans le délai
indiqué ci-après, selon le cas : ~~L'autorisation de rectifier prévue à l'alinéa e) produite effet,~~
~~sous réserve des alinéas g) (bis), g) (ter) et g) (quater);~~

[COMMENTAIRE : il est proposé de fixer un délai précis pour la présentation de la requête en rectification par le déposant plutôt que, comme le prévoit la présente règle 91.1.g), de subordonner l'entrée en vigueur de l'autorisation de rectifier à la réception dans le délai voulu de l'autorisation par le Bureau international (et donc au traitement en temps voulu de la requête en rectification par l'administration compétente).]

i) lorsque l'administration compétente est ~~lorsqu'elle est donnée par~~ l'office récepteur, le Bureau international ~~ou par~~ l'administration chargée de la recherche internationale, [26][27][28] mois ~~: si la notification de l'autorisation qui est destinée au~~
~~Bureau international parvient à celui-ci avant l'expiration de 17 mois~~ à compter de la date de priorité;

[COMMENTAIRE : les points i) et iii) visent à assurer qu'une rectification autorisée au cours de la procédure prévue dans le chapitre I (si le déposant ne demandait pas un examen préliminaire international en vertu du chapitre II) serait incluse dans la demande internationale publiée dans un délai de 18 mois à compter de la date de priorité, compte tenu également du fait que la phase nationale de traitement devait être ouverte à l'égard de la demande dans un délai de 20 mois à compter de la date de priorité. Lorsque le déposant demandait un examen préliminaire international en vertu du chapitre II, le point ii) actuel permettait d'apporter des rectifications, après la publication de la demande, mais avant l'ouverture de la phase nationale dans un délai de 30 mois à compter de la date de priorité. Toutefois, le délai pour l'ouverture de la phase nationale en vertu des chapitres I et II est à présent le même, à savoir, 30 mois à compter de la date de priorité, de sorte qu'il ne semble pas nécessaire de maintenir la distinction actuelle entre les chapitres I et II à cet égard. Il est donc proposé de lier le délai prévu pour la rectification au délai pour l'ouverture de la phase nationale dans tous les cas. En vertu du chapitre I, un délai fixé vers la fin de la période de 30 mois semble approprié.]

[Règle 91.2.a), suite]

ii) lorsqu'administration compétente est ~~lorsqu'elle est donnée par~~
l'administration chargée de l'examen préliminaire international, au moment où cette
administration commence à établir le ~~: si elle est donnée avant l'établissement du~~ rapport
d'examen préliminaire international ~~.~~

[COMMENTAIRE : voir le commentaire relatif au point i). Lorsque le déposant demande un examen préliminaire international selon le chapitre II, des considérations légèrement différentes interviennent puisque l'administration chargée de l'examen préliminaire international sera entraînée à instruire la demande. Chaque feuille de remplacement contenant une rectification d'erreur autorisée par l'administration chargée de l'examen préliminaire internationale est annexée au rapport d'examen préliminaire international (voir la proposition de modification de la règle 70.16). Le délai approprié serait donc le moment où l'administration commence à établir le rapport d'examen préliminaire international.]

~~iii) lorsqu'elle est donnée par le Bureau international: si elle est donnée avant~~
~~l'expiration de 17 mois à compter de la date de priorité.~~

[COMMENTAIRE : les rectifications apportées par le Bureau international sont traitées dans la proposition de modification du point i).]

[Règle 91.2, suite]

b) La requête en rectification contient les indications suivantes :

i) l'indication du fait que la rectification d'une erreur est demandée;

ii) l'erreur à rectifier; et

iii) la rectification proposée;

[COMMENTAIRE : voir la règle 18.1.a)i),iii) et iv) du règlement d'exécution du PLT. L'indication, selon la règle 18.1.a)ii), d'un numéro de la demande ou du brevet en question, n'est pas prévue ici puisque la requête en rectification doit être présentée sous la forme d'une lettre permettant d'identifier la demande internationale qu'elle concerne ou être accompagnée d'une telle lettre (voir la règle 92.1.a) du règlement d'exécution du PCT). L'indication, selon la règle 18.1.a)v) du règlement d'exécution du PLT, du nom et de l'adresse du requérant, n'est pas prévue puisque la rectification ne peut être apportée que sur demande du déposant (voir l'alinéa d) ci-dessus).]

ainsique, au choix du déposant,

iv) une explication succincte de l'erreur et de la rectification proposée.

[COMMENTAIRE : cette explication aiderait l'administration compétente à décider de l'opportunité d'autoriser une rectification. Il convient de noter que l'article 19.1) prévoit une déclaration expliquant les modifications apportées aux revendications selon cet article.]

c) La règle 26.4 est applicable, *mutatis mutandis*, à la procédure à suivre pour demander des rectifications.

91.3 Autorisation de rectifier

a) ~~[91.1].f)~~ L'administration compétente décide à bref délai, conformément à la règle 91.1.c), de l'opportunité d'autoriser ou de refuser d'autoriser la rectification et ~~Toute administration qui autorise ou refuse une rectification~~ — ~~en~~ notifie à bref délai au déposant et au Bureau international, en motivant sa décision s'ils agissent d'un refus. L'administration qui autorise une rectification ~~en~~ notifie à bref délai au Bureau international. ~~—~~

[COMMENTAIRE : les modifications proposées visent à harmoniser ce libellé avec celui utilisé dans une autre partie de la règle modifiée.]

b) Lorsque la rectification est autorisée par l'administration compétente, elle doit être apportée dans la demande internationale ou l'autre document concerné de la manière prévue dans les instructions administratives.

[COMMENTAIRE : Les instructions 325, 413, 511 et 607 devront être modifiées.]

[Règle 91.3, suite]

c) Lorsqu'une rectification est autorisée par l'administration compétente, elle produit effet,

i) encas d'erreur dans la demande internationale, à compter de la date du dépôt international;

ii) encas d'erreur dans un autre document, y compris une modification ou une correction apportée à la demande internationale, à compter de la date à laquelle ce document a été présenté.

[COMMENTAIRE : le nouvel alinéa c) proposé indique clairement la date à partir de laquelle une rectification produira effet dès lors qu'elle aura été autorisée.]

[Règle 91.3, suite]

d) ~~[91.1.f)~~ Lorsque l'autorisation de rectifier ~~est a été~~ refusée, le Bureau international, si la requête lui est présentée en est faite par le déposant dans un délai [d'un mois] [de deux mois] à compter de la date de la décision de l'administration compétente ~~avant le moment pertinent selon l'alinéa g bis), g ter) ou g quater)~~ et sous réserve du paiement d'une taxe spéciale dont le montant est fixé dans les instructions administratives, publier la requête en rectification , les motifs du refus par l'administration compétente et tout autre commentaire succinct éventuellement formulé par le déposant, si possible avec la demande internationale. Une copie de la requête , des motifs et des commentaires (s'il y a lieu) ~~en rectification~~ est, si possible, insérée dans la communication selon l'article 20 lorsqu'un exemplaire de la brochure n'est pas utilisé pour cette communication ou lorsque, en vertu de l'article 64.3), la demande internationale n'est pas publiée.

[COMMENTAIRE : selon la proposition de modification de l'alinéa d), si le déposant en fait la demande, le Bureau international publiera également des informations relatives à une requête en rectification qui a été refusée par l'administration chargée de l'examen préliminaire international, même si la requête en publication est reçue après la publication internationale. Cela permettrait de combler une lacune qui existait dans le présent règlement d'exécution : en vertu de la règle 91.1.f), toute requête en publication d'informations relatives à une requête en rectification refusée doit être reçue par le Bureau international avant l'achèvement de la préparation technique de la publication internationale. Dans la pratique, cela signifie que les informations relatives à une requête en rectification ayant été refusée par l'administration chargée de l'examen préliminaire international après la publication internationale ne sont ni publiées, ni mentionnées dans le rapport d'examen préliminaire international et que seules les rectifications autorisées sont annexées au rapport (voir la présente règle 70.16; voir également, plus haut, la proposition de modification de la règle 70.16).]

[Règle 91.3, suite]

~~[91.1].g-bis) Si la notification effectuée en vertu de l'alinéa g) i) parvient au Bureau international, ou si la rectification effectuée en vertu de l'alinéa g) iii) est autorisée par le Bureau international, après l'expiration de 17 mois à compter de la date de priorité mais avant l'achèvement de la préparation technique de la publication internationale, l'autorisation produite a effet et la rectification est incorporée dans ladite publication.~~

~~[91.1].g-ter) Lorsque le déposant a demandé au Bureau international de publier sa demande internationale avant l'expiration de 18 mois à compter de la date de priorité, toute notification effectuée en vertu de l'alinéa g) i) doit parvenir au Bureau international, et toute rectification effectuée en vertu de l'alinéa g) iii) doit être autorisée par le Bureau international, pour que l'autorisation produise effet, au plus tard à la date d'achèvement de la préparation technique de la publication internationale.~~

~~[91.1].g-quater) Lorsque, en vertu de l'article 64.3), la demande internationale n'est pas publiée, toute notification effectuée en vertu de l'alinéa g) i) doit parvenir au Bureau international, et toute rectification effectuée en vertu de l'alinéa g) iii) doit être autorisée par le Bureau international, pour que l'autorisation produise effet, au plus tard au moment de la communication de la demande internationale conformément à l'article 20.~~

[Fin de l'annexe et du document]

OMPI



PCT/R/WG/4/10
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F

ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE
GENÈVE

UNION INTERNATIONALE DE COOPÉRATION EN MATIÈRE DE BREVETS
(UNION DU PCT)

GRUPPE DE TRAVAIL SUR LA RÉFORME DU TRAITÉ DE COOPÉRATION EN MATIÈRE DE BREVETS (PCT)

Quatrième session
Genève, 19 – 23 mai 2003

CALCUL DES DÉLAIS:

Propositions présentées par l'Australie, le Canada et l'Office européen des brevets

RAPPEL

1. Comme indiqué aux paragraphes 65 et 66 du résumé de la troisième session du Groupe de travail sur la réforme du Traité de coopération en matière de brevets (voir document PCT/R/WG/3/5), il a été proposé de modifier la règle 80.5 afin de tenir compte du fait que, notamment dans les pays géographiques étendus, un office peut avoir des services situés dans différents fuseaux horaires et bénéficiant de différents jours fériés. Il a été convenu que le représentant de l'OEB et les délégations de l'Australie, du Canada et du Royaume-Uni, qui ont proposé des modifications du règlement d'exécution allant dans ce sens, présenteraient des propositions écrites au groupe de travail.

2. En conséquence, l'Australie, le Canada et l'Office européen des brevets proposent que la règle 80.5 soit modifiée de la manière prévue dans l'annexe.

3. *Le groupe de travail est invité à examiner les propositions contenues dans l'annexe.*

[L'annexe suit]

ANNEXE

PROPOSITIONS DE MODIFICATION DU RÈGLEMENT D'EXECUTION DU PCT :
CALCUL DES DÉLAIS

Règle 80

Calcul des délais

80.1 à 80.4 [Sans changement]

80.5 *Expiration un jour chômé*

Si un délai quelconque pendant lequel un document ou une taxe doit parvenir à un officier national ou à une organisation intergouvernementale expire un jour

i) où cet office ou cette organisation n'est pas ouvert au public pour traiter d'affaires officielles ; ~~ou~~

ii) où le courrier ordinaire n'est pas délivré dans la localité où cet office ou cette organisation est situé ;

iii) qui, lorsque ce office ou cette organisation est situé dans plus d'une localité, est un jour férié légal dans au moins une des localités dans laquelle cet office ou cette organisation est situé, et dans les circonstances où la législation nationale applicable par cet office ou cette organisation prévoit, dans le cas des demandes nationales, que, dans cette situation, ce délai prend fin le jour suivant; ou

[Règle 80.5, suite]

iv) qui, lorsque cet office est l'administration gouvernementale d'un État contractant chargé de délivrer des brevets, est un jour férié légal dans une partie de cet État contractant, et dans les circonstances où la législation nationale applicable par cet office prévoit, dans le cas des demandes nationales, que, dans cette situation, ce délai prend fin un jour suivant;

le délai prend fin le premier jour suivant auquel aucune de ces ~~quatre~~ deux circonstances n'existe plus.

80.6 et 80.7 [Sans changement]

[Fin de l'annexe et du document]

WIPO



PCT/R/WG/4/4Add.3

ORIGINAL:English

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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

FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:

FURTHER CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

Document prepared by the International Bureau

1. The Annex to this document contains proposals to further amend Rules 16 *bis*.2, 32.1, 44*bis*, 60.1 and 90.2 as 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), and to further amend Rule 90.5. These proposed amendments are in the nature of corrigenda or consequential amendments based on the amendments already adopted. Explanations are set out in the Annex in Comments relating to the provisions concerned.

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

[Annex follows]

E

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

FURTHER CORRIGENDA AND CONSEQUENTIAL AMENDMENTS

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Rule 16 bis

Extension of Time Limits for Payment of Fees

16bis.1 [No change]

16bis.2 *Late Payment Fee*

(a) [No change] The payment of fees in response to an invitation under Rule 16bis.1(a) may be subjected by the receiving Office to the payment to it, for its own benefit, of a late payment fee. The amount of that fee shall be:

(i) 50% of the amount of unpaid fees which is specified in the invitation, or,

(ii) if the amount calculated under item (i) is less than the transmittal fee, an amount equal to the transmittal fee.

[COMMENT: No change is proposed to present paragraph (a); the text is reproduced above for convenient reference.]

(b) The amount of the late payment fee shall not, however, exceed the amount of 50% ~~25%~~ of the international filing fee referred to in item 1 of the Schedule of Fees, not taking into account any fee for each sheet of the international application in excess of 30 sheets.

[COMMENT: Without prejudice to the determination of the amount of the international filing fee (see document PCT/R/WG/4/8, paragraph 5), upon further reflection, the maximum amount of the late payment fee under Rule 16 bis.2(b) as adopted by the Assembly on October 1, 2002, with effect from January 1, 2004, (25% of the international filing fee)

[Rule 16bis.2.(b), continued]

appear to be too low and would result in a maximum amount of the late payment fee which would be much lower than the maximum amount of the late payment fee under present Rule 16bis.2(b) (under present Rule 16bis.2(b), the amount of the late payment fee must not exceed the amount of the basic fee which, at present, is fixed at 650 Swiss francs). In respect of certain receiving Offices, a maximum amount of the late payment fixed at 25% of the international filing fee would even have the result that the minimum amount of the late payment fee fixed in accordance with Rule 16bis.2(a)(ii) would be higher than the maximum amount of that fee fixed in accordance with Rule 16bis.2(b). It is thus proposed to fix the maximum amount of the late payment fee under Rule 16bis.2(b) at 50% of the international filing fee.]

Rule 32

Extension of Effect of International Application to

Certain Successor States

32.1 ~~Request for~~ *Extension of International Application to Successor State*

[COMMENT: Proposed amendment of the title of Rule 32.1 is consequential on the amendment of Rule 32.1 as adopted by the PCT Assembly on October 1, 2002, with effect from January 1, 2004. In line with the new approach with regard to designations, a request for extension by the applicant is no longer needed; the effects of an international application are automatically extended to a successor State which has deposited a declaration of continuation under Rule 32.1(a).]

(a) to (c) [No change]

(d) [*Remains deleted*]

32.2 [No change]

Rule44 bis

**International Preliminary Report on Patentability by
the International Searching Authority**

44bis.1 Issuance of Report [: Transmittal to the Applicant](#)

(a) [No change] Unless an international preliminary examination report has been or is to be established, the International Bureau shall issue a report on behalf of the International Searching Authority (in this Rule referred to as “the report”) as to the matters referred to in Rule 43 bis.1(a). The report shall have the same contents as the written opinion established under Rule 43 bis.1.

(b) [No change] The report shall bear the title “international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)” together with an indication that it is issued under this Rule by the International Bureau on behalf of the International Searching Authority.

[COMMENT: No change is proposed to paragraphs (a) and (b) as adopted by the PCT Assembly on October 1, 2002, with effect from January 1, 2004; the text is reproduced above for convenient reference.]

[\(c\) The International Bureau shall promptly transmit one copy of the report issued under paragraph \(a\) to the applicant.](#)

[COMMENT: It is proposed to add a new paragraph (c) so as to require the International Bureau to send one copy of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty) to the applicant as soon as it has been issued.]

44bis.2 to 44 bis.4 [No change]

Rule60

CertainDefectsintheDemand

60.1 *DefectsintheDemand*

(a) and(a *-bis*) [Nochange]

(a-*ter*) [Nochange] ForthepurposesofRule 53.8,iftherearetwoormoreapplicants,
itshallbesufficientthatthedemandbesigned byoneofthem.

[COMMENT:Nochangeisproposedtoparagraph(a *-ter*)asadoptedbythePCTAssembly
onOctober1,2002,witheffectfromJanuary1,2004;thetextisreproducedabovefor
convenientreference.]

(b) and(c) [Nochange]

(d) ~~[Deleted] Where,aftertheexpirationofthetimelimitunderparagraph(a),a
signaturerequiredunderRule53.8oraprescribedindicationislackinginrespectofan
applicantforacertainelectedsState,theelectionofthatStateshallbeconsideredasifithad
notbeenmade.~~

[COMMENT:Proposeddeletionofparagraph(d)isconsequentialontheadditionofnew
Rule 60.1(a-*ter*)(seeabove)asadoptedbythePCTAssemblyonOctober1,2002,witheffect
fromJanuary1,2004.]

(e) to(g) [Nochange]

60.2 *[Remainsdeleted]*

Rule 90

Agents and Common Representatives

90.1 [No change]

90.2 *Common Representative*

(a) Where there are two or more applicants and the applicants have not appointed an agent representing all of them (a “common agent”) under Rule 90.1(a), one of the applicants who is entitled to file an international application according to Article 9 [and in respect of whom the indication ~~all indications~~ required under Rule 4.5(a)(ii) has ~~have~~ been provided] may be appointed by the other applicants as their common representative.

[COMMENT: Although the words “and in respect of whom all indications required under Rule 4.5(a) have been provided” were only added to paragraph (a) by way of an amendment adopted by the Assembly on October 1, 2002, with effect from January 1, 2004, it is proposed to further amend paragraph (a) so as to no longer require that only an applicant in respect of whom *all* indications required under Rule 4.5(a) (name, address, nationality *and* residence) have been provided can be appointed as the common representative. Upon further consideration, it would appear sufficient that the name, the nationality *or* residence, and the address of the applicant be furnished to be appointed as a common representative. Note that the indication of the name and of the nationality *or* residence of the applicant is already required for the determination whether the applicant is entitled to file the international application according to Article 9, so that there would appear to be no need to specifically refer to the furnishing of the indications required under Rule 4.5(a)(i) and (iii). The requirement as such (“and in respect of whom the indication required under Rule 4.5(a)(ii) has been provided”) is presented in square brackets for consideration by the Working Group whether the furnishing of the address should be made a condition for the appointment of an applicant as the common representative or whether it should not, as at present, be left to the practice of the receiving Office to decide how to deal with the case of a missing address of the applicant to be appointed as a common representative.]

[Rule 90.2, continued]

(b) Where there are two or more applicants and all the applicants have not appointed a common agent under Rule 90.1(a) or a common representative under paragraph (a), the applicant first named in the request who is entitled according to Rule 19.1 to file an international application with the receiving Office ~~and in respect of whom all indications required under Rule 4.5(a) have been provided~~ shall be considered to be the common representative of all the applicants.

[COMMENT: Although the words “and in respect of whom all indications required under Rule 4.5(a) have been provided” were only added to paragraph (b) by way of an amendment adopted by the Assembly on October 1, 2002, with effect from January 1, 2004, it is proposed to further amend paragraph (b) so as to no longer require that only an applicant in respect of whom *all* indications required under Rule 4.5(a) (name, address, nationality *and* residence) have been provided can be considered to be the common representative. Upon further consideration, it would appear sufficient that, as at present, the name and the nationality *or* residence of the applicant be furnished to be considered to be common representative. Note that the indication of the name and of the nationality *or* residence of the applicant is already required for the determination whether the applicant is entitled according to Rule 19.1 to file the international application with the receiving Office, so that there would appear to be no need to specifically refer to the furnishing of the indications required under Rule 4.5(a)(i) and (iii). With regard to the address of the applicant to be considered as the common representative, rather than making the furnishing of the address a condition for considering the applicant to be the common representative, it is proposed to continue, as at present, to leave it to the practice of the receiving Office to decide how to deal with the case of a missing address. Otherwise, that is, if the furnishing of the address would be a condition for considering an applicant to be the common representative, it would appear possible that, in certain cases, none of the applicants could be considered to be the common representative (example: the applicant who is first named in the request is an applicant from a non-PCT Contracting State; the applicants named second and third in the request are applicants from a PCT Contracting State but not all indications required under Rule 4.5(a) have been provided for either of them).]

90.3 and 90.4 [No change]

90.5 *General Power of Attorney*

(a) [No change] Appointment of an agent in relation to a particular international application may be effected by referring in the request, the demand or a separate notice to an existing separate power of attorney appointing that agent to represent the applicant in relation to any international application which may be filed by that applicant (i.e., a “general power of attorney”), provided that:

(i) the general power of attorney has been deposited in accordance with paragraph (b), and

(ii) a copy of it is attached to the request, the demand or the separate notice, as the case may be; that copy need not be signed.

(b) [No change] The general power of attorney shall be deposited with the receiving Office, provided that, where it appoints an agent under Rule 90.1(b), (c) or (d)(ii), it shall be deposited with the International Searching Authority or the International Preliminary Examining Authority, as the case may be.

[COMMENT: No change is proposed to present paragraphs (a) and (b); the text is reproduced above for convenient reference.]

(c) Subject to paragraph (d), any receiving Office, any International Searching Authority and any International Preliminary Examining Authority may waive the requirement under paragraph (a)(ii) that a copy of the general power of attorney is attached to the request, the demand or the separate notice, as the case may be.

[Rule 90.5, continued]

(d) Where the agent submits any notice of withdrawal referred to in Rules 90bis.1 to 90bis.4, the requirement under paragraph (a)(ii) for the attachment of a copy of the general power of attorney to the request, the demand or these separate notices, as the case may be, shall not be waived under paragraph (c).

[COMMENT: During its second session, the Committee on Reform of the PCT agreed that there was no need to amend Rule 90.5 to permit a receiving Office or an International Authority to waive the requirement under Rule 90.5(a)(ii) for a copy of a general power of attorney to be attached to the request, demand or separate notice (see document PCT/R/2, paragraph 71). Upon further reflection, however, it would appear inconsistent to permit an Office to waive the requirement that a separate power of attorney is furnished while still insisting on the furnishing of a copy of such deposited general power of attorney. It is thus proposed to add new paragraphs (c) and (d) so as to permit (but not oblige) any receiving Office and any International Searching and Preliminary Examining Authority to waive the requirement that a copy of a deposited general power of attorney be submitted to it.]

90.6 [No change]

[End of Annex and of document]

WIPO



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

ORIGINAL:English

DATE:May6,2003

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

FURTHER STREAMLINING AND SIMPLIFICATION OF PCT PROCEDURES:
ANNEXES TO THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT

Document prepared by the International Bureau

BACKGROUND

1. Present Rule 70.16 of the Regulations under the PCT¹ provides for amendments to the international application that have been made in the course of the international preliminary examination procedure to be annexed to the international preliminary examination report. However, a replacement sheet which has been superseded by a later replacement sheet or amendments resulting in the cancellation of entire sheets under Rule 66.8(b) is not to be annexed.

2. In a case where the International Preliminary Examining Authority considers that the relevant superseding replacement sheet or sheets or amendments contain an amendment that goes beyond the disclosure in the international application as filed, the report will contain an

¹ References in this document to "Articles" and "Rules" are to those of the Patent Cooperation Treaty (PCT) and the Regulations under the PCT ("the Regulations"), or to such provisions as proposed to be amended or added, as the case may be.

indication accordingly under Rule 70.2(c). In order to make the report clear in this respect, it would be preferable for the superseded replacement sheet, suitably marked, also to be annexed to the report. The Annex to this document contains a proposal to amend Rule 70.16 accordingly.

3. The Working Group is invited to consider the proposals contained in the Annex.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS:

ANNEXES TO THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT

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Rule 70

**International Preliminary Report on Patentability by
the International Preliminary Examining Authority
(International Preliminary Examination Report)**

70.1 to 70.15 [No change]

70.16 *Annex to the Report*

(a) Each replacement sheet under Rule 66.8(a) or (b), each replacement sheet containing amendments under Article 19 and each replacement sheet containing rectifications of an ~~obvious errors~~ amistake authorized under Rule 91.1(b)(iii) ~~91.1(e)(iii)~~ shall, unless superseded by later replacement sheets or amendments resulting in the cancellation of entire sheets under Rule 66.8(b), be annexed to the report. Amendments under Article 19 which have been considered as reversed by an amendment under Article 34 and letters under Rule 66.8 shall not be annexed. ²

(b) Notwithstanding paragraph (a), a superseded replacement sheet shall also be annexed to the report where the International Preliminary Examining Authority considers that the relevant superseding replacement sheet or sheets or amendments contain an amendment that goes beyond the disclosure in the international application as filed and the report contains an indication referred to in Rule 70.2(c). In such a case, the superseded replacement sheet shall be marked as provided by the Administrative Instructions.

70.17 [No change]

[End of Annex and of document]

² The proposed amendments shown in paragraph (a) simply reproduce those proposed for Rule 70.16 in document PCT/R/WG/4/4Add.2.

WIPO



PCT/R/WG/4/8Add.1

ORIGINAL:English

DATE:May5,2003

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

AMENDMENT OF THE SCHEDULE OF FEES
ANNEXED TO THE REGULATIONS UNDER THE PCT

Proposals submitted by the United States of America

INTRODUCTION

1. This document contains a proposal for an amendment of the Schedule of Fees annexed to the Regulations under the Patent Cooperation Treaty (PCT). The proposal concerns the concept of the "flat" international filing fee for the automatic indication of all designations possible under the PCT that was approved by the PCT Assembly in September 2002 with effect from January 1, 2004 (see paragraph 45 and Annex V of PCT/A/31/10).

2. It is proposed that the international filing fee be fixed at 1,210 Swiss francs and that the handling fee of 233 Swiss francs remain a separate fee applied only to applications in which a demand is filed. This is proposed in order to reflect the reduction in fees previously envisioned by the PCT Assembly in 2001, as explained below, and to ensure that applicants who, under the present system and fee structure, only use the Chapter I procedure will not be disadvantaged by having to pay considerably higher fees than is presently the case under Chapter I.

BACKGROUND

3. The current fee structure of the PCT system includes a basic fee, a designation fee and, for international applications in which a demand is filed under PCT Chapter II, a handling fee. In addition, the maximum number of payable designation fees is currently five. For the year 2003, the fees are fixed at a basic fee of 650 Swiss francs, a designation fee of 140 Swiss francs and a handling fee of 233 Swiss francs. Because most PCT applicants indicate five or more designations per application, the great majority of applicants pay the maximum fee for designations of 700 Swiss francs. Under the current fee structure, therefore, most applicants using only Chapter I of the PCT pay a maximum fee of 1,350 Swiss francs, and those utilizing Chapter II of PCT pay a maximum fee of 1,583 Swiss francs.

4. A fee reduction was envisioned for the PCT that would have reduced the maximum number of payable designations to four with effect from January 1, 2003 (see paragraph 347 of WO/PBC/4/2 and paragraph 60 of PCT/A/31/6) in the 2001 meeting of the PCT Assembly. Assuming that the existing fee level had remained the same, this would have resulted in a basic fee of 650 Swiss francs, a maximum designation fee of 560 Swiss francs, or a total of 1,210 Swiss francs, plus a handling fee for international applications in which a demand had been filed of 233 Swiss francs. In other words, the envisaged fee reduction, which was not approved, would have resulted in maximum fees under Chapter I of the PCT of 1,210 Swiss francs, and maximum fees under both Chapters I and II of the PCT of 1,443 Swiss francs as from January 1, 2003.

PCT REFORM AND FEES

5. The PCT Assembly, in September 2002, unanimously adopted new regulations (see PCT/A/31/10), that provide for a combined search and examination system, as well as automatic designation of all Contracting States, among other changes. In light of these changes, the designation-based fee system will no longer be continued as from January 1, 2004. Instead, the Assembly agreed to a single "flat" international filing fee as part of the amendment package (see paragraph 45 and Annex V of PCT/A/31/10). The new fee would combine the current basic and designation fees. At current levels, this fee would be 650+700 or 1,350 Swiss francs, while the fees envisioned by the reduction in paragraph 4, above, would be 650+560 or 1,210 Swiss francs.

6. Rather than attempting to implement the envisaged fee reduction, the International Bureau proposed that, in light of the significant revisions to the Regulations of the PCT, a review of the fee structure and the possible reduction of fees should be undertaken, in the context of the necessary determination of the new "international filing fee" (paragraph 27 of PCT/A/31/10). Although certain delegations at the 2002 PCT Assembly expressed concerns about this approach and doubts about the prospects for a fee reduction via this approach, the rationale of the International Bureau was eventually adopted.

7. The International Bureau now has produced a new proposal with respect to PCT fees for consideration at the May 2003 meeting of the Working Group on Reform of the PCT in document PCT/R/WG/4/8. In light of the fact that all applications will now require some type of report (International Preliminary Report on Patentability (Chapter I) and International Preliminary Report on Patentability (Chapter II)), the International Bureau proposes rolling the handling fee into the international filing fee, thereby applying a handling fee to all international applications. This is in contrast to the current system in which only those applications where the applicant files a demand are charged a handling fee.

8. The International Bureau proposes an amount of 1,530 Swiss francs for the new fee. This represents a fee of 1,297 Swiss francs in addition to the current level of 233 Swiss francs for a handling fee. This is 87 Swiss francs higher than the reduction originally envisioned for January 1, 2003, as noted above, and additionally would provide that each and every international application be subject to a handling fee. That is, in addition to the issue of the handling fee, the International Bureau's proposal does not provide the previously promised 8% reduction in fees or any reduction to compensate for the delay in implementing that reduction. Rather, the International Bureau proposes a substantial increase in PCT international fees. The International Bureau has indicated that the specific figures are based on the calculation of estimated income in the context of WIPO's proposed program and budget for 2004-2005 presented in document WO/PBC/6/2 (paragraph 5 of PCT/R/WG/4/8). The current PCT fees in effect in 2003, the original reduction plan described in paragraph 4, above, WIPO's fee proposal in PCT/R/WG/4/8 and WO/PBC/6/2, and the fees under this proposal are compared in Annex II of this document.

PROPOSAL

9. It is proposed instead that the international filing fee be fixed at 1,210 Swiss francs and the handling fee remain a separate fee applied only to applications in which a demand is filed, in order to reflect the reduction in fees previously envisioned. With particular regard to the handling fee, while we recognize the existence of the new report, the International Bureau does not appear to have justified the need for the entire handling fee to be applied to all PCT cases. Therefore we propose to leave that fee as is.

10. The Working Group on PCT Reform is invited to recommend adoption by the Assembly of the PCT Union of the proposed amendment to the Schedule of Fees annexed to the Regulations under the PCT as appearing in Annex I of this document and to decide that it will enter into force on January 1, 2004, and that it will apply only in respect of international applications filed on or after that date.

[Annex I follows]

ANNEXI

PROPOSED AMENDMENT OF
THE REGULATIONS UNDER THE PCT

SCHEDULE OF FEES ¹

(as proposed to be amended with effect from January 1, 2004)

Fees	Amounts
1. International Filing Fee: (Rule 15.2)	<u>1,210</u> 650 Swiss francs plus 15 Swiss francs for each sheet of the international application in excess of 30 sheets
2. Handling Fee: (Rule 57.2)	233 Swiss francs

Reductions

3. The international filing fee is reduced by 200 Swiss francs if the international application is, in accordance with and to the extent provided for in the Administrative Instructions, filed:
- (a) on paper together with a copy thereof in electronic form; or
 - (b) in electronic form.
4. All fees payable (where applicable, as reduced under item 3) are reduced by 75% for international applications filed by any applicant who is a natural person and who is a national of and resides in a State whose per capita national income is below US\$3,000 (according to the average per capita national income figure resused by the United Nations for determining its scale of assessments for the contributions payable for the years 1995, 1996 and 1997); if there are several applicants, each must satisfy those criteria.

[Annex II follows]

¹ The "present" text shown is that of the Schedule of Fees as amended by the Assembly on October 1, 2002 (see document PCT/A/31/10) and due to enter into force on January 1, 2004.

ANNEXII

COMPARISON OF PCT FEES
(all fees shown in Swiss francs)

	<i>Basic Fee</i>	<i>Designation Fee</i>	<i>Maximum Designations</i>	<i>Maximum Combined Fee</i>	<i>Maximum Combined Fee with Handling Fee (plus 233 Sfr)</i>
<i>Current PCT Fees</i>	650	140	5 (700 Sfr)	1,350	1,583
<i>Original Reduction Plan</i>	650	140	4 (560 Sfr)	1,210	1,443
<i>WIPO Proposal (in PCT/R/4/8)</i>					1,530 flat fee for all cases
<i>Proposal in this Document</i>				1,210 flat fee	Plus 233 Sfr for ONLY those cases in which a demand is made

Not that the WIPO Proposal in PCT/R/4/8 of a flat fee of 1,530 Swiss francs in ALL cases represents a Maximum Combined Fee of 1,297 Swiss francs (1,530 - 233 handling fee), which is 87 Swiss francs higher than the estimated fee under the original reduction plan of 1,210 Sfr.

With respect to rationales for charging a PCT handling fee in all cases, it must also be borne in mind that PCT fees have no direct relation to services provided or work required under the PCT. Not that in the proposed 2004 - 2005 Program and Budget, PCT fee income is expected to fund 80% of the entirety of WIPO's budget, while Main Program 3 (Patents and the PCT System) accounts for only 21.5% of WIPO's total budget (see Table 7, p. 24). Hence, there is no relation between the PCT fees and PCT work undertaken by the International Bureau of WIPO, and no justification for charging a handling fee in all PCT cases.

[End of Annex II and of document]

WIPO



PCT/R/WG/4/11
ORIGINAL:English
DATE:April23,2003

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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

PERIOD FOR PERFORMING THE INTERNATIONAL SEARCH

Proposals submitted by the United States of America

BACKGROUND

1. In earlier proposals for integration of the search and examination stages of PCT processing, the United States has urged that the period for establishment of the International Search Report (ISR) and the Written Opinion of the International Searching Authority (WO/ISA) should be relaxed (see PCT/R/WG/1/3 and PCT/R/WG/2/9). Relaxation of the time limits is warranted due to the extension of the Article 22 time period for national stage entry from 20 to 30 months and the desire to more effectively utilize the entire time period now provided for Chapter I processing. The time limit for establishment of the ISR and the WO/ISA should be relaxed if the revised PCT system is to function as envisioned. Three areas of concern that have arisen are: (1) issues with regard to priority claim processing, (2) issues regarding unity of invention, and (3) issues concerning the processing of sequence listings.

PRIORITY CLAIM ISSUES

2. There is currently a conflict between the time limit for establishment of the search and the time limits pertaining to the priority claim. This conflict first came to light as the result of comments by the delegation of Japan in the second meeting of the Committee in July of last year. The comments of the Japanese delegation dealt with the conflict between the time limit under Rule 17.1 for providing a copy of the priority document and the time limit under

Rule 42.1 for establishment of the WO/ISA, and the fact that applicant may have difficulty providing a copy of the priority document in time for the ISA to take it into account in establishing the WO/ISA. Rather than shorten the period during which applicant could submit a copy of the priority document, a move that was viewed as being detrimental to applicants' rights, the Committee chose to resolve this conflict by making Rule 66.7 apply *mutatis mutandis* to the establishment of the WO/ISA (see document PCT/R/2/9, paragraphs 113-115).

3. However, it has come to light that there may be an even greater conflict between the Rule 42.1 time limit and the time limit under Rule 26 *bis* for correction or addition of a priority claim. Specifically, under Rule 42.1 the ISR and WO/ISA must be established by the later of three months from receipt of the search copy by the ISA or nine months from the priority date, or between nine and 16 months from the priority date (the 16 month date being based on an assumed average search copy processing time on the part of the receiving Office of 1 month). However, under Rule 26 *bis*, applicants have until 16 months from the priority date to submit any corrections or additions to the receiving Office. Assuming an average processing time of one month by the RO of any request under Rule 26 *bis*, the ISA is required to begin the international search and establish the WO/ISA during a period that can range from 1 to 8 months prior to the ISA becoming aware that a priority claim exists. In that, under Rules 43 *bis*.1(b) and 64.1, the ISA must take into account any priority claim in establishing the WO/ISA, a relaxation of the Rule 42.1 time limit would appear to be necessary in order to protect applicants' right to have all priority claims permissible under the Treaty taken into account when the WO/ISA is established.

UNITY OF INVENTION ISSUES

4. During the last meeting of the Working Group, discussions were held on several proposals concerning unity of invention, and specifically to either simplify or eliminate altogether the protest mechanism. Comments were made by the delegation of the EPO, and supported by other delegations, that the protest procedure was quite time consuming and when invoked by an applicant often led to problems in meeting the time limit under Rule 42.1. The United States would urge that a relaxation of the Rule 42.1 time limit would, in most instances, eliminate this problem by allowing ample time for protests to be properly resolved. Such a relaxation would be advantageous to applicants in that it would allow for sufficient time, prior to the deadline for establishment of the ISR and WO/ISA, for any protest to be properly and thoroughly considered.

SEQUENCE LISTING ISSUES

5. Similarly, during the last meeting of the Working Group discussions were also held on the topic of sequence listings. During these discussions the delegation of the EPO pointed out that as many as 50% of international applications containing disclosure of nucleotide and/or amino acid sequences were not accompanied by an acceptable computer readable form sequence listing. It was further pointed out that in many cases multiple invitation to provide such a sequence listing are required before an acceptable listing is submitted. Therefore, in a large number of applications requiring a sequence listing it is difficult, if not impossible, for the searching authority to carry out a meaningful international search within the Rule 42.1 time limit as a result of these delays in obtaining an acceptable listing. The United States, as with unity of invention protests discussed above, believes that a relaxation of the Rule 42.1 time limit would, in most instances, eliminate this problem by allowing ample time for proper sequence listings to be filed. The relaxation of this time limit would be beneficial to

applicants in that it would provide the necessary time for the filing of an acceptable computer readable form sequence listing thus allowing the ISA to establish a search which is as complete and accurate as possible.

PROPOSAL

6. There are various processing conflicts that arise as the result of the current limited time period for establishment of the international search under Rule 42.1. Given that the Article 22 time period for entering the national stage has been extended to 30 months from the priority date, it would be reasonable to also extend the Rule 42.1 time limit for establishment of the ISR and WO/ISA. This would allow the Authorities to take full advantage of the complete time period available for international stage processing in order to properly address these conflicts.

7. Therefore, it is the proposal of the United States that Rule 42.1 be amended as follows:

(i) to extend the time limit by which the ISA is supposed to have established the ISR and WO/ISA to 22 months from the priority date thus providing sufficient time for the resolution of all issues that must be addressed prior to the international search; and

(ii) to include a minimum period in which the ISR and WO/ISA may be established of 17 months from the priority date so as to ensure that applicants have the full time period afforded them under Rule 26 *bis* to make changes or additions to the priority claim and have those changes or additions taken into account by the searching authority as required by Rules 43 *bis*.1(b) and 64.1.

8. The upper limit period of 22 months has been chosen as a date that would allow sufficient time for resolution of these search related issues as well as for any response by applicants and issuance of the International Preliminary Examination Report by 28 months. The lower limit of 17 months is based on the 16 months allowed by the Rule 26 *bis* plus an additional one month to allow for RO processing and transmission to the ISA of any such requests. Finally, the current provision that the ISR and WO/ISA be due 3 months from the date of receipt of the search copy has been retained to protect the ISA from being accountable for any delays on the part of the RO which would prevent the timely establishment of the search.

9. A review of both the existing Rules and those which are scheduled to take effect 01 January 2004 indicates that the only Rules that would need to be amended in this regard are Rules 42.1, 46.1 and 69.2.

10. The Working Group is invited to consider the proposals contained in the Annex to this document.

[Annex follows]

ANNEX

PROPOSED AMENDMENTS OF THE PCT REGULATIONS
PERIOD FOR PERFORMING THE INTERNATIONAL SEARCH

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Rule 42

Time Limit for International Search

42.1 *Time Limit for International Search*

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be :

(i) not more than the later of three months from the receipt of the search copy by the International Searching Authority, or 22 ~~nine~~ months from the priority date ~~whichever time limit expires later~~; and

(ii) not less than 17 months from m the priority date.

Rule 46

Amendment of Claims Before the International Bureau

46.1 *Time Limit*

The time limit referred to in Article 19 shall be two months from the date of transmittal of the international search report to the International Bureau and to the applicant by the International Searching Authority ~~or 16 months from the priority date, whichever time limit expires later~~, provided that any amendment made under Article 19 which is received by the International Bureau after the expiration of the applicable time limit shall be considered to have been received by that Bureau on the last day of that time limit if it reaches it before the technical preparations for international publication have been completed.

46.2 to 46.5 [No change]

Rule 69

Start of and Time Limit for International Preliminary Examination

69.1 [No change]

69.2 *Time Limit for International Preliminary Examination*

The time limit for establishing the international preliminary examination report shall be whichever of the following periods expires last:

(i) 28 months from the priority date; or

(ii) three ~~six~~ months from the time provided under Rule 69.1 for the start of the international preliminary examination; or

(iii) three ~~six~~ months from the date of receipt by the International Preliminary Examining Authority of the translation furnished under Rule 55.2.

[End of Annex and of document]

WIPO



PCT/R/WG/4/12
ORIGINAL:English
DATE:April28,2003

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WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

WORKING GROUP ON REFORM OF THE PATENT
COOPERATION TREATY (PCT)

Fourth Session
Geneva, May 19 to 23, 2003

A COMMON FRAMEWORK FOR
INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION

Initial Task Force Report prepared by the United Kingdom

INTRODUCTION

1. At the third session of the Working Group on Reform of the PCT, held in Geneva from November 18 to 22, 2002, it was decided to establish a "virtual" task force to consider the proposals put forward by the United Kingdom for a common quality framework (PCT/R/WG/3/4) and other points raised during the discussion on those proposals. The United Kingdom was asked to coordinate the work of the task force and submit an initial report to the Working Group and to the Meeting of the International Authorities (MIA) by the end of April 2003.

2. To facilitate discussion the United Kingdom prepared a discussion document which was posted for comment on the electronic forum website the International Bureau had created for the task force. All the responses received on that discussion paper can be viewed on the e-forum site (<http://www.wipo.int/pct/reform/qualityframework>).

3. The present document constitutes the initial report of the task force. It contains a synopsis of the comments received on the discussion document together with brief analysis by the United Kingdom. Attached in Annex I is a framework document which takes into account the comments received on the discussion document and sets out the key components of a quality framework the aim of which is to provide a model on which each Authority can base

its own detailed quality system. Reproduced in Annex II are the comments on the other points raised when document PCT/R/WG/3/4 was discussed. The United Kingdom is very grateful for the detailed and constructive comments received and thanks all those who made comments.

4. It should be stated at the outset that in light of the strong opposition expressed by the Authorities to the idea of an independent review mechanism, as proposed in the discussion document, that feature has now been replaced in the framework document by an internal review system for self-assessment.

QUALITY MANAGEMENT SYSTEM (QMS)

5. This part of the framework document sets out the basic features of a management system considered necessary to support the international search and preliminary examination process.

6. A proposal by the Netherlands to restructure this part of the framework by grouping the requirement criteria into two broad categories, namely: (a) technical competences of searchers and examiners, and (b) management and administration systems, has not been adopted at this stage but the document can be reformatted along these lines if others consider it appropriate. Moreover, the additional requirement criteria listed in Annex 3 of the Netherlands' submission may be too prescriptive for a document the aim of which is to provide a set of broad requirement criteria on which each Authority can base its QMS. However, these can be added if others consider them appropriate.

7. On a general point, the United States of America felt that there should be flexibility in the requirements to meet the time limits for issuing search and examination reports and that those time limits should be re-evaluated. However, we would suggest that this is not a matter which falls within the remit of the task force.

8. Japan asked who would judge the effectiveness and appropriateness of the measures taken by Authorities to meet the requirements criteria while the United States of America indicated that it should be for each Authority to decide what is appropriate. To take account of these comments it is made clear in the framework document that it is for individual Authorities to make these judgements.

Resources

9. Singapore stated that the resources specified in this section were an essential element in achieving and maintaining quality. Austria, in expressing support for this item, mentioned that it already has the listed resources in place. However, Japan wondered whether some of the resources mentioned were appropriate while Spain, Sweden and the European Patent Office (EPO) indicated that an Authority should not be tied to a standard list. To address these concerns the resources listed are represented as "examples" of the kind of resources an Authority should consider establishing to support the search and examination process.

10. Canada and the United States of America, while agreeing that each Authority should acquire and maintain sufficient resources, believe that it should be left to the individual Authorities rather than an outside body to determine what constitutes sufficient staffing and

appropriate equipment and facilities. This point has been taken into account by the replacement of the idea of an independent review mechanism with internal review systems in each Authority.

11. Sweden asked if there was any thought of establishing ISAs with responsibility for less than all technical fields. The International Federation of Intellectual Property Attorneys (FICPI) proposed that the complementary resources and competences of the Authorities could be pooled so that different Authorities could conduct parallel, supplementary, non-overlapping searches the results of which could be drawn together in a final composite international search report. The United Kingdom considers that this is more appropriate for discussion by the Working Group as part of the general discussion on PCT reform.

12. The Russian Federation suggested the creation of a centralised distance learning and training course for all staff involved in the search and examination process, analogous to WIPO World Academy's "General Course in Intellectual Property."

Administration

13. Canada, Spain, Sweden and the EPO, in referring to control mechanisms postulated under this item, indicated that it is not possible to guarantee that search and examination reports will always be issued on time and that backlogs will be kept to a minimum. They therefore preferred a less rigid approach. Japan also questioned the feasibility of imposing a strict requirement for the control mechanism with regard to backlogs. These concerns have been taken into account in the framework document by proposing more flexible administration criteria.

14. Australia suggested that the administration arrangements should also provide for preventative action and continuous improvement. These suggestions have been reflected in the attached document.

15. Singapore, in supporting the concept of a control mechanism, suggested that each Authority should include a report on backlog to the proposed external review panel. Although it is now proposed to drop the idea of an external panel, reporting on backlogs should form part of the internal reporting mechanism within each Authority. This is taken into account in the framework document.

16. The United States of America supported the concept of each Authority establishing a control mechanism but felt that the Authorities themselves should determine how to deal with backlogs. This will be possible under the proposed internal review arrangement.

17. Canada also felt it may be of limited value to establish procedures for measuring user perception.

Quality Assurance

18. The EPO said that it should be left to each Authority to decide what quality assurance procedures to implement rather than be subject to a standard set of procedures. Canada, Spain and Sweden also felt that the proposals were too rigid and needed to be more flexible. To address these concerns the attached framework document sets out what aspects a quality

assurance systems should cover, for example verification, validation and monitoring of search and examination work, and leaves it to individual Authorities to set up appropriate arrangements.

19. Australia believes that the quality assurance procedures should also verify the action taken by an Authority to address deficiencies and prevent recurrence. This suggestion has been taken on board in the framework document.

20. Japan expressed concern over the use of the terms “effective,” “suitable” and “reliable” which it felt were unclear. The words “suitable” and “reliable” have now been deleted and it is made clear in the framework document that it is for each Authority to determine whether the measures it takes to meet the QMS requirement criteria are effective and appropriate.

21. Japan also questioned the feasibility of providing “evidence” of conformity while the United States objected to such evidence being made available outside the Authority. To overcome these concerns no reference is made in the framework document to the provision of “evidence.”

22. Singapore expressed support for the quality assurance proposal which it viewed as a means of meeting and maintaining user expectations.

23. Austria said that more practical languages should be used to clarify what needs to be accomplished with regard to measuring, recording, monitoring and analyzing the performance of a quality management system. In this regard, as explained above, the framework document now simply sets out the basic requirement criteria of a QMS leaving it to individual Authorities to decide how to build those requirements into their individual QMSs.

Feedback Arrangements

24. In view of their opposition to an external review panel, Australia, Canada, Japan, Spain, Sweden, the United States of America and the EPO could not support the proposal that each Authority establish arrangements to allow for feedback from such a body.

25. Canada did however say that it would support the sharing of best practice between Authorities and leave it to each Authority to react as appropriate. It also made the point that a well-functioning feedback mechanism is an essential element of the proposed quality framework which needed a means by which users could voice their opinion and their views could be assessed. EAPO felt that the feedback mechanism could include arrangement of meetings and seminars.

26. The Russian Federation suggested that it would be useful to establish a common central database containing information about applications filed under the PCT in order to provide quality assessment of international searches and examinations in comparison with the national phase. The information would allow examiners to assess the quality of their work and identify any mistakes they may have made.

27. Japan expressed concern about using subjective indexes, like user satisfaction and perception, because of the variations between countries in user characteristics and filing strategies. Singapore, on the other hand, said that two-way communication/feedback arrangements should help clarify doubts and reservation while FICPI felt that it was important to canvass users' views.

28. The United Kingdom appreciates that there may be variations between countries but believes that the views of customers on the service they receive is a central plank of any quality system if the organisation providing the service is to be able to understand and meet its customer needs and expectations.

29. Japan questioned the meaning of “constructive feedback” and felt that feedback from national and regional Offices to Authorities should be flexible and voluntary. The word “constructive” has accordingly been deleted from the framework document while it is left open for each Authority to arrange how it might receive feedback from national and regional Offices.

30. Canada also expressed concern about the nature of comments from national and regional Offices and suggested the creation of a centralized feedback repository, controlled by the International Bureau.

31. Austria felt that the use of the word “mechanism” where used in respect to feedback from national and regional Offices should be replaced with something more precise. Accordingly, the word “mechanism” is not now used in the framework document and the passage in question has been revised.

Communication and Guidance to Users

32. Japan, Singapore, Spain and the EPO found the proposals under this item acceptable though the EPO expressed a preference for the use of the word “communication” in place of “dialogue.” Austria also said it preferred “communication.”

33. FICPI stressed that it was important for Authorities to warn applicants about proceeding without professional help.

INTERNAL REVIEW

34. Singapore supported the concept of a review mechanism, as proposed in the discussion document, which involved the use of an independent assessment panel, and made several recommendations. The Netherlands agreed that a common quality framework should be supported by a quality review panel acting initially as a forum for disseminating best practice, monitoring progress and providing advice and subsequently as an assessment body. Hungary suggests that, besides the use of an independent panel, the possibility of a uniform internal validation system should be explored. New Zealand said that, while it could understand the sensitivities in publishing the identity of an Authority that did not meet quality standards, it would be extremely useful for national Offices to know how much credibility to place on the search and examination reports from particular Authorities. FICPI supported the idea of an independent review and said that the findings should be made publicly available to ensure transparency.

35. Austria also felt that some outside control of the work of the Authority could be helpful in securing the quality of search and examination reports but, because of the practical and cost implications, questioned the feasibility of an independent review panel.

36. Canada, Spain and the EPO stated that they could not support the concept of an external review panel. Sweden also expressed scepticism and mentioned the difficulties in identifying and choosing suitable candidates for such a panel and the bureaucracy and costs implications. Japan also referred to the practical implications and the effect on an Authority's discretion to act and indicated that a review arrangement should be considered in the context of self-assessment.
37. The United States of America could see a benefit in Authorities sharing information about how they achieved and monitored compliance with quality standards but could see little or no benefit in an Authority disclosing the results of its internal review to other bodies. The United States of America strongly opposed the concept of an independent review panel and took the view that each Authority must retain the right to determine how to allocate its resources. It also doubted the ability of an external panel to provide advice to an Authority without knowledge of that Authority's resource constraints and to define and evaluate quality beyond objective statistics. Like others, the United States of America also expressed concerns over the resources needed to maintain such a panel.
38. Australia put forward an alternative approach whereby the results of an internal performance audit and system audits should be made publicly available or at least available to other Offices using a standard reporting template. This it said would assure Offices that the QMS were operational and effective and provide a means of disseminating best practice.
39. In light of the reservation expressed by the Authorities to the concept of an independent review panel the original idea of a review mechanism has been replaced in the attached framework document with a scheme that recommends that each Authority establish its own internal review system for self-assessment. The document sets out a model review arrangement on which individual Authorities should base their own in-house systems.
40. The framework document also proposes that each Authority present an annual report to MIA and that MIA in turn submit a general progress report to the PCT Assembly. This should help disseminate best practice between Authorities and promote confidence among national and regional Offices in the work undertaken by those Authorities and hopefully discourage the duplication of work in the national and regional phase. It is for future debate whether the specific results of each Authority's internal review are made available to other Authorities and national and regional Offices.

IMPLEMENTATION

41. If the quality framework set out in the attached document is acceptable, consideration will need to be given as to how it should be implemented. For instance, should it be incorporated in the agreements between the International Authorities and the International Bureau, the International Search and Preliminary Examination Guidelines, the PCT Administrative Guidelines, the PCT Regulations or should it be implemented by some other means? Australia believed it should form part of the agreements between an Authority and the International Bureau while the EPO were of the view that quality should remain an issue for each Authority and would not be appropriate for inclusion in such agreements. The Netherlands would like to see the framework incorporated in the PCT Guidelines initially but ultimately presented in a document of a more general nature.

COMMENTS BY TASK FORCE MEMBER OR OTHERS SUGGESTIONS MADE BY DELEGATIONS WHEN DOCUMENT PCT/R/WG/3/4 WAS DISCUSSED AT THE THIRD SESSION OF THE WORKING GROUP ON REFORM OF THE PCT

42. The detailed comments made by those who subscribed to the task force e-forums site on the other points made by the Working Group when PCT/R/WG/3/4 was discussed are reproduced in Annex II. The following is a summary of those comments.

A common central database containing the entire PCT minimum documentation and accessible by all Authorities would help to ensure consistency

43. Canada, Japan, the Russian Federation, Sweden, the United States of America and FICPI supported this proposal though the United States of America expressed concern over funding and maintaining such a database. Australia and Sweden also questioned how it would help improve consistency of citation. Austria, Spain and the EPO and felt that the idea of a central database was more a matter for consideration by the PCT Committee on Technical Cooperation.

Mechanisms could usefully be provided for feedback from designated and elected Offices, as well as from applicants and their representatives who received searches carried out by different Offices on applications from the same patent family

44. There was general support for this proposal though Australia, Austria and the EPO indicated that the feedback should be directed to the Authorities only. Sweden asked in instances feedback would be given while the United States of America and Canada felt that it should be better defined. what

It may be useful for the International Bureau to arrange meetings or seminars at which Offices could exchange experience in quality control

45. There was general support for this idea though Austria raised the question of cost while Sweden felt that bilateral visits would probably be more beneficial than meetings.

An extensive examiner exchange program would encourage the development of consistent standards and practices

46. There was general support for this proposal though reservations were expressed about an "extensive" exchange program in view of the resource implications for Authorities. The United States of America suggested that it might be worth exploring other ways of improving communication and cooperation among Authorities to achieve consistency. FICPI also suggested supplementing an exchange program with a common training program for examiners.

"Top-up" searches might be introduced into the PCT system, providing for additional search, late in the international phase, for potentially relevant material which had not yet been included in the relevant search databases at the time of the main international search

47. Views were mixed on this proposal. Australia and Sweden were not in favor of a "top up" search which the latter felt would result in duplication while Austria also expressed concerns and wondered whether it would result in a new fee and if the results would be -

published. Canada also felt that the proposal was not feasible given current work pressures. The EPO also had reservation over “top -up” searches being carried out in the international phase while the United States of America said that such searches should only be performed as part of the international preliminary examination report (IPER). Singapore thought that “top up” searches could be beneficial but that a detailed time/cost/benefit analysis should be undertaken. The Russian Federation also felt they could be beneficial but expressed concerns about the effect on time limits and suggested that they should be performed in conjunction with the preparation of an IPER. FICPI, expressed strong support for the proposal.

In relation to the reference to “inventive concept(s)” in the suggested quality criteria in the Appendix, the search could consider the limitation of every claim, rather than a general inventive concept

48. Spain and Sweden were opposed to this proposal while the EPO did not consider it feasible. Canada also felt that it would not add any value as the claims may change during the international and national phase. The United States of America in contrast supported the proposal on the grounds that it would increase the usefulness to national and regional Offices of the Preliminary Report on Patentability.

The definition and monitoring of quality may be a matter to be dealt with in the agreement between the International Bureau and various Authorities

49. Canada and the EPO did not consider quality to be appropriate for inclusion in the agreements between the Authorities and the International Bureau while Australia, in contrast felt that it should be part of those agreements. Canada felt that a quality framework should be incorporated in the Search and Examination Guidelines. Austria questioned the role of the International Bureau if quality was included in the agreements.

[Annex follows]

ANNEXI

ACOMMONFRAMEWORKFOR
INTERNATIONALSEARCHANDPRELIMINARYEXAMINATION

INTRODUCTION

1. This document sets out the main features of a quality framework for international search and preliminary examination. It describes a minimum set of criteria which each International Authority (“Authority”) should use as a model for establishing their individual quality scheme.

QUALITY MANAGEMENT SYSTEM

2. Each Authority should establish and maintain a quality management system (QMS) which sets out the basic requirements with regard to resources, administrative procedures, feedback and communication channels required to underpin the search and examination process. The QMS established by each Authority should also incorporate a quality assurance scheme for monitoring compliance with these basic requirements and the International Search and Preliminary Examination Guidelines.

3. Adoption by the Authorities of common QMS requirements, which are recognised by all Authorities and national and regional Offices, should help achieve a consistent approach. This, in turn, should help build confidence among national and regional Offices in the work done by the Authorities. It will be for each Authority to ensure that the measures they have taken to meet the requirements are effective and appropriate.

Resources

4. An Authority should be able to accommodate changes in workload and should have an appropriate infrastructure to support the search and examination process and comply with the QMS requirements and Search and Examination Guidelines. The following are examples of the kind of resources and infrastructure an Authority should consider establishing:

(a) A complement of staff sufficient to deal with the inflow of work and which has the technical qualifications to search and examine in the required technical fields and the language facilities to understand at least those languages in which the minimum documentation referred to in PCT Rule 34 is written or translated.

(b) Appropriately trained/skilled administrative staff, resources at a level to support the technically qualified staff and facilitate the search and examination process.

(c) Appropriate equipment and facilities, such as IT hardware and software, to support the search and examination process.

(d) Possession of, or access to, at least the minimum documentation referred to in PCT Rule 34, properly arranged for search and examination purposes, on paper, in microform or stored on electronic media.

(e) Comprehensive and up-to-date work manuals to help staff understand and adhere to the quality criteria and standards and follow work procedures accurately and consistently.

(f) An effective training and development programme for all staff involved in the search and examination process to ensure they acquire and maintain the necessary experience and skills and are fully aware of the importance of complying with the quality criteria and standards.

(g) A scheme for periodically testing all staff for knowledge of the requirements and standards of search and examination.

(h) A system for continuously monitoring and identifying the resources required to deal with demand and comply with the quality standards for search and examination.

Administration

5. An Authority should have in place the following minimum practices and procedures for handling search and examination requests and performing related functions, such as data-entry and classification:

(a) Effective control mechanisms regarding timely issue of search and examination reports to a quality standard consistent with the Search and Examination Guidelines.

(b) Appropriate control mechanisms regarding fluctuations in demand and backlog management.

(c) An appropriate system for handling complaints and taking corrective and preventative action where appropriate, and the application of monitoring procedures for measuring users satisfaction and perception and for ensuring their needs and legitimate expectations are met.

(d) An effective system for ensuring the continuous improvement of the established processes.

Quality Assurance

6. An Authority should have procedures regarding timely issue of search and examination reports of a quality standard in accordance with the Search and Examination Guidelines. Such procedures should include:

(a) An effective internal quality assurance system for self assessment, involving verification and validation and monitoring of searches and examination work for compliance with the Search and Examination Guidelines and channeling feedback to staff;

(b) A system for measuring, recording, monitoring and analysing the performance of the quality management system to allow assessment of conformity with the requirements; and

(c) A system for verifying the effectiveness of action taken to address deficiencies and to prevent issues from recurring.

Feedback Arrangements

7. To help improve performance and foster continual improvement, each Authority should:

(a) Communicate the results of their internal quality assurance process to their staff to ensure that any necessary corrective action is taken and for the dissemination and adoption of best practice; and

(b) Provide for effective communication with WIPO and designated and delected Offices to allow for prompt feedback from them so that potential systemic issues can be evaluated and addressed.

Communication and Guidance to Users

8. An Authority should have in place the following arrangements for ensuring effective communication with users:

(a) Effective communication channels so that enquiries are dealt with promptly and that appropriate two-way communication is possible between applicants and examiners.

(b) Clear, concise and comprehensive guidance and information to users (particularly unrepresented applicants) on the search and examination process which could be included on each Authority's website as well as in guidance literature.

INTERNAL REVIEW

9. In addition to establishing a quality assurance system for checking and ensuring compliance with the requirements set out in its QMS, each Authority should be required to establish its own internal review arrangements to determine the extent to which it has established a QMS based on the above model and the extent to which it is complying with the QMS requirements and the Search and Examination Guidelines. The reviews should be objective and transparent so as to demonstrate whether or not those requirements and guidelines are being applied consistently and effectively and should be undertaken at least once a year.

10. It is open to each Authority to set up its own arrangements but the following is proposed as a guide to the basic components of an internal review mechanism and reporting system.

Monitoring and Measuring

11. The input to each review should include information on:

- (a) conformity with the QMS requirements and Search and Examination Guidelines;
- (b) any corrective and preventative action taken to eliminate the cause of non-compliance;
- (c) any follow-up action from previous reviews;
- (d) the effectiveness of the QMS itself and its processes ;
- (e) feedback from customer, including designated and delected Offices as well as applicants; and
- (f) recommendations for improvement.

12. Suitable arrangements should be established for monitoring, recording and measuring compliance with the QMS requirements and Search and Examination Guidelines. Arrangements should also be made to measure customer satisfaction, which should include the views of designated and delected Offices as well as applicants and their representatives.

Analysis

13. The collected data should be analysed to determine to what extent the QMS requirements and Search and Examination Guidelines are being met. The results of the internal review should be presented to senior management within the Authority so that they can gain an objective appreciation of performance against the QMS requirements and Search and Examination Guidelines and identify opportunities for improvement and whether changes are needed.

Improvement

14. Each Authority should:

- (a) have an established system to continually improve its performance against the QMS requirements and to review the effectiveness of its QMS; and
- (b) identify and promptly take corrective action to eliminate the cause of any failure to comply with the QMS requirements and Search and Examination Guidelines.

REPORTING ARRANGEMENTS

15. There should be two stages in the reporting arrangements.

Stage 1

16. Each Authority should be required to submit an initial report to MIA describing what it has done to implement a QMS based on the broad requirements set out in the present document. This would help identify and disseminate best practice among Authorities. MIA should then submit a general initial report on progress to the PCT Assembly.

Stage 2

17. Following the initial reporting in stage 1, annual reports should be prepared by each Authority on the results of its internal review. The reports should be submitted to MIA using a standard template. Without naming specific Authorities, MIA should, in turn, present a general progress report each year to the PCT Assembly.

[Annex II follows]

ANNEXII

COMMENTSMADBYMEMBERSOFTHETASKFORCEON
THEOTHERSUGGESTIONSMAD BYDELEGATIONSWHEN
DOCUMENTPCT/R/WG/3/4WASDISCUSSEDATTHETHIRDSESSIONOF
THEWORKINGGROUPOONREFORMOFTHEPCT

- (A) ACOMMONCENTRALDATABASECONTAININGTHEENTIREPCT
MINIMUMDOCUMENTATIONANDACCESSIBLEBYALLAUTHORITIES
WOULDHELPTOENSURECONSISTENCY ?

CommentbyAustralia: “Weunderstandthishasbeendrivenbyuserdissatisfactionwhere
potentiallydifferentcitationshavebeenraisedbydifferentOfficesagainstthesameinvention.
Howeverwedonotbelievethattheprovisionofacommo ncentraldatabasewilladdressthis
problem.”

CommentbyAustria: “Thiswasalreadydiscussedinthelastmeetinganditwasconsidered
thatthisquestionshouldbediscussedintheframeworkofthePCTCTC.”

CommentbyCanada: “CIPOfullysupportstheestablishmentofacommoncentraldatabase
containingtheentirePCTminimumdocumentationasameansofpromotingconsistency
amongInternationalAuthorities.”

CommentbytheEPO : “ShouldbereferrdtothePCTCommitteeonTechnical
Co-operation.”

CommentbyJapan: “Wesupport.”

CommentbyRussianFederation: “Rospatentsupporttheestablishmentofacommoncentral
databasecontainingtheentirePCTminimumdocumentation.”

CommentbySpain: “ThismattershouldbestudiedinthePCT/CTC.”

CommentbySweden: “Wewonderinwhatway“commoncentraldatabase...”couldhelp
improveconsistencyandwhowillfinancehostingofthedatabase,updatingitandthe
necessaryhigh -speed-links.”

Commentbythe UnitedStatesofAmerica : “Thisproposalsupportstheestablishmentofa
commoncentraldatabase.TheUnitedStatessupportsthisproposalinprinciple,buthas
concernsoverfundingandmaintenanceofsuchadatabase.”

CommentbytheInternationalFederationofIntellectualPropertyAttorneys (FICPI): “...a
commondatabaseisa sinequanon totheobjectiveofachievingconsistency.Itisequally
importantthatsearchers/examinersshouldinterrogatethedatabaseinacommonwayand
shouldbeprovidedwiththesamesearchtoolsandacommon practicemanual.”

(B) MECHANISMS COULD USEFULLY BE PROVIDED FOR FEEDBACK FROM DESIGNATED AND ELECTED OFFICES, AS WELL AS FROM APPLICANTS AND THEIR REPRESENTATIVES WHO RECEIVED SEARCHES CARRIED OUT BY DIFFERENT OFFICES ON APPLICATIONS FROM THE SAME PATENT FAMILY

Comment by Austria: “This obviously covers only a feedback to the Authorities not to a QRP.”

Comment by Australia: “We support this because feedback is an inherent part of a quality system. However we believe the feedback should be given directly to the International Authority.”

Comment by Canada: “While, in general, CIPO supports a feedback mechanism, once again we would appreciate a more detailed description of the proposed mechanism.”

Comment by the EPO: “Supported, however feedback should only be to the International Authorities themselves, not to any external body.”

Comment by Spain: “We can support.”

Comment by Sweden: “It is not clear to what instances the feedback will be given.”

Comment by the United States of America: “The United States can support a proposal to implement a system that would allow the national and regional Offices the ability to provide feedback to the Authorities. However, the nature of the feedback must be better defined in line with our previous comments to paragraph 6(d)(ii) above.”

(C) IT MAY BE USEFUL FOR THE INTERNATIONAL BUREAU TO ARRANGE MEETINGS OR SEMINARS AT WHICH OFFICES COULD EXCHANGE EXPERIENCE IN QUALITY CONTROL

Comment by Australia: “We believe this would foster understanding between Offices and enable all Offices to learn and contribute.”

Comment by Austria: “The Austrian Patent Office can support this; however, also in this context we would like to raise the question of costs.”

Comment by Canada: “CIPO fully supports a greater forum for the exchange of ideas concerning quality control.”

Comment by the EPO: “Supported.”

Comment by Japan: “We support.”

Comment by the Netherlands: “Organisation of meetings and seminars to exchange experience will be very useful. It could also be worthwhile to organise presentations on key aspects of the quality system.”

Comment by Sweden: “Bilateral visits would probably yield more than the proposal international meetings.”

Comment by Spain: “We can support.”

(D) AN EXTENSIVE EXAMINER EXCHANGE PROGRAM WOULD ENCOURAGE
THE DEVELOPMENT OF CONSISTENT STANDARDS AND PRACTICES

Comment by Australia: “We support this but have reservations about an “extensive” program as the feasibility of such a program would be dependent on the available human and financial resources of individual International Authorities.”

Comment by Austria: “In principle the Austrian patent Office can support this, however in the current workload situation we are not in favour that the exchange should be extensive.”

Comment by Canada: “While the productivity and financial implications associated with an extensive exchange program raises some concern, on general CIPO is supportive of this type of initiative.”

Comment by the EPO: “Supported, however the word extensive should be removed, as this would perhaps not be realistic in the current work environment.”

Comment by Japan: “We support.”

Comment by Spain: “We can support.”

Comment by Sweden: “This proposal is very well worth pursuing, since it is an effective means to ensure harmonisation. However, for economical and production reasons we are not in favour of “extensive” examination exchange, but we have good experience of a more moderate exchange of examiners.”

Comment by the United States of America: “This proposal calls for establishment of an extensive examiner exchange program. While we share the goal of encouraging development of consistent standards and practice, we have some reservations concerning the effectiveness of such a program in achieving this goal. While it is possible that a limited, voluntary exchange program might have some value, an extensive program as proposed would be very resource intensive and would likely yield little in the way of results for the amount of funds expended. It may be helpful to investigate other ways of improving communication and cooperation among offices to achieve the stated goal of consistency in a more effective manner.”

Comment by FICPI: “...searchers should be given common training, preferably under central control...supplemented with systematic and extensive exchange of examiners between offices.”

(E) “TOP-UP” SEARCHES MIGHT BE INTRODUCED INTO THE PCT SYSTEM, PROVIDING FOR ADDITIONAL SEARCH, LATE IN THE INTERNATIONAL PHASE, FOR POTENTIALLY RELEVANT MATERIAL WHICH HAD NOT YET BEEN INCLUDED IN THE RELEVANT SEARCH DATABASES AT THE TIME OF THE MAIN INTERNATIONAL SEARCH

Comment by Australia: “We would not support the concept of supplementary searches being carried out routinely because we believe this would largely result in duplication of work. However, we acknowledge that there may be limited occasions when a “top -up” search may be necessary.”

Comment by Austria: “We have some concerns about this proposal. At this time there is no possibility for this in present PCT -Rules. In addition we are wondering if this would not result in a new fee for the applicants. How would the results of the “Top -up” search be published?”

Comment by Canada: “This proposal is not feasible in the current environment of unprecedented growth and escalating backlogs.”

Comment by the EPO: “This was mentioned by some delegates during the last meeting of the PCT Reform Working group, however we have reservations as to the feasibility of such a system and in any event would oppose a motion to restrict the possibility of designated Offices carrying out their own supplementary search reports after entry to the national/regional phase.”

Comment by Russian Federation: “Top-up” searches could be beneficial, but we have some concerns about time limits. It seems to us that such searches should be performed in conjunction with the preparation of an IPR.”

Comment by Singapore: “The proposal on top -up searches as we understand from previous PCT documents, is focused on giving applicants an opportunity to file such requests with another Authority (An Authority different from the Authority that conducted the International Search) if time permits and the applicant furnishes whatever fees necessary. The results of such searches could be relied upon during the national or regional Phase, and possible fee reductions could be in place, where appropriate. Such top -up searches could be beneficial but a more detailed time/cost/benefit analysis of having this feature in the international phase of the PCT should be made.”

Comment by Sweden: “During the time there have been proposals for additional searches, for parallel searches, for stocked searches and now for top -up search. The international search is done normally within 16 months from priority date and in that case 4 months from the international filing date. At that time the documentation databases should be updated with relevant material. The cost to make a new database -search must be weighed against the possibility to find relevant material added after the ordinary search. We think that service can be given by other than the ISA. Thus we oppose to introduce the proposed top -up-search.”

Comment by the United States of America: “The concept of performing a “top -up” or updated search may have some benefits so long as it is envisioned that such a search is only to be performed in conjunction with the preparation of an IPR (i.e. not at a time prior to 30 months in cases where no Demand has been filed or where the issuance of the IPR occurred substantially prior to the 30 month period.”

Comment by FICPI: “The PCT searching system at present suffers from the disadvantage that it is not able to find prior art, especially prior patent applications, which were filed shortly before the international filing date. For this reason FICPI strongly supports the proposal to provide for additional “top -up” searching later in the international phase.”

(F) IN RELATION TO THE REFERENCES TO “INVENTIVE CONCEPT(S)” IN THE SUGGESTED QUALITY CRITERIA IN THE APPENDIX, THESE SEARCH COULD CONSIDER THE LIMITATIONS OF EVERY CLAIM, RATHER THAN A GENERAL INVENTIVE CONCEPT

Comment by Austria: “It is not clear to us what this proposal means. However, we have the vague impression this has nothing to do with the question of quality.”

Comment by Canada: “CIPO does not believe that this suggestion would add any value to the process as the claims may change during both the international and national phase.”

Comment by the EPO: “Not feasible.”

Comment by Spain: “We are not able to support this point.”

Comment by Sweden: “Not support. The quality of search and examination in PCT is defined through PCT Articles, Rules, Administrative Instructions and Guidelines for search and examination. In the agreement between the ISA / IPEA and WIPO it is stated that in carrying out search and examination the ISA and IPEA shall apply and observe all the common rules for search and examination.”

Comment by the United States of America: “The United States support this proposal. We believe that it would increase the usefulness of the Preliminary Report on Patentability to all national and regional Offices.”

(G) THE DEFINITION AND MONITORING OF QUALITY MAY BE A MATTER TO BE DEALT WITH IN THE AGREEMENT BETWEEN THE INTERNATIONAL BUREAU AND VARIOUS AUTHORITIES

Comment by Australia: “Assuming that the quality system is set up appropriately, we believe that this should be part of the agreement between an Authority and WIPO and that it should be a requirement to be met by all new Authorities.”

Comment by Austria: “Also in this point we are not clear what is meant. Does this mean that the International Bureau shall control the work of the Authority? However in this case it would mean that only the formal aspects of the report would be viewed because the IB lacks the technical staff and knowledge to review the contents of the reports.”

Comment by Canada: “CIPO feels that the quality assurance framework and the associated standards should be reflected in the Search and Preliminary Examination Guidelines and not in the agreement between the International Bureau and the respective International Authorities.”

Comment by the EPO: “Once again our view is that quality must remain an issue for each international Authority and would not be appropriate for inclusion in the agreement between the authority concerned and the International Bureau.”

[End of Annex II and of document]

WIPO



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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
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PROPOSALS BY SWITZERLAND REGARDING
THE DECLARATION OF THE SOURCE OF GENETIC RESOURCES
AND TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS

Document prepared by the International Bureau

1. The proposals appearing on the following page were made by Switzerland in a submission to the International Bureau received on May 1, 2003.

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

[Annex follows]

ANNEX

PROPOSALS BY SWITZERLAND REGARDING
THE DECLARATION OF THE SOURCE OF GENETIC RESOURCES
AND TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS

SUMMARY

The present document contains the proposals by Switzerland regarding the declaration of the source of genetic resources and knowledge, innovations and practices of indigenous and local communities (traditional knowledge), in patent applications, if an invention is directly based on such resources or traditional knowledge. These proposals are to be seen in the wider context of the efforts of various international forums in the area of access to genetic resources and traditional knowledge and the fair and equitable sharing of the benefits arising out of their utilization. These international forums include in particular the Convention on Biological Diversity (CBD); the Food and Agriculture Organization (FAO); the “Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore” (IGC) of the World Intellectual Property Organization (WIPO); and the Council for Trade-Related Aspects of Intellectual Property Rights (TRIPS Council) of the World Trade Organization (WTO). The proposals are intended to enhance the cooperation between these international forums and the mutual supportiveness of the applicable international agreements.

With regard to the underlying issues, Switzerland holds the view that a fair and balanced approach must be taken: on one hand, Switzerland supports the effective protection of biotechnological innovations through intellectual property rights, in particular patents. On the other hand, a fair and balanced approach necessitates effective, efficient, practical and timely solutions to the issues arising in the context of access to genetic resources and traditional knowledge and the fair and equitable sharing of the benefits arising out of their utilization. Various approaches are currently being discussed at the international level, including the realization of measures that increase transparency in the context of access and benefit sharing, in particular, with regard to the obligations of the users of genetic resources and/or traditional knowledge (transparency measures). Switzerland considered in detail the options available and the possible modalities and implications of such transparency measures. Based on these considerations, Switzerland submits the following proposals:

Switzerland proposes to explicitly enable the national patent legislation to require the declaration of the source of genetic resources and traditional knowledge in patent applications. More specifically, Switzerland proposes to amend the Regulations under the Patent Cooperation Treaty (PCT) to explicitly enable the Contracting Parties of the PCT to require patent applicants, upon or after entry of the international application into the national phase of the PCT procedure, to declare the source of genetic resources and/or traditional knowledge, if an invention is directly based on such resource or knowledge. Furthermore, Switzerland proposes to afford applicants the possibility of satisfying this requirement at the time of filing an international patent application or later during the international phase. In case an international patent application does not contain the required declaration, national law may foresee that in the national phase the application is not processed any further until the patent applicant has furnished the required declaration.

By reference, the proposed amendment to the PCT would also apply to the Patent Law Treaty (PLT). Accordingly, the Contracting Parties of the PLT would be able to require in their national patent law that patent applicants declare the source of genetic resources and/or traditional knowledge in national patent applications. Based on the PLT, national law may foresee that the validity of granted patents is affected by a lacking or incorrect declaration of the source, if this is due to fraudulent intention.

In the view of Switzerland, the proposed amendments to the PCT - Regulations present one simple and practical solution to the issues arising in the context of access to genetic resources and traditional knowledge and the fair and equitable sharing of the benefits arising out of their utilization. These amendments could be introduced in a timely manner and would not require extensive changes to the provisions of relevant international agreements. d

**PROPOSALS BY SWITZERLAND REGARDING
THE DECLARATION OF THE SOURCE OF GENETIC RESOURCES
AND TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS**

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I. OVERVIEW

1. The present document contains proposals by Switzerland regarding the declaration of the source of genetic resources and knowledge, innovations and practices of indigenous and local communities (traditional knowledge), in patent applications, if an invention is directly based on such resources or traditional knowledge.

2. Part II outlines the general approach that according to Switzerland should be taken with regard to the underlying issues (see paras. 3 - 4). Part III summarizes the recent developments at the international level that are of importance with regard to transparency measures under patent law (see paras. 5 - 11), and Part IV provides an overview of the current international legal framework affecting the form, structure and contents of such measures (see paras. 12 - 19). Part V presents the proposals of Switzerland regarding the declaration of the source of genetic resources and traditional knowledge in patent applications (see paras. 20 - 29): Switzerland proposes to amend Rules 51 *bis*.1 and 4.17 of the Regulations under the Patent Cooperation Treaty (PCT) to explicitly enable the national patent legislation to require the declaration of the source of genetic resources and traditional knowledge in international patent applications, if an invention is directly based on such resources or knowledge. By reference, these amendments would also apply to national patent applications that are in accordance with the provisions of the Patent Law Treaty (PLT). Finally, in Part VI, Switzerland invites the World Intellectual Property Organization (WIPO), in close collaboration with the Convention on Biological Diversity (CBD), to consider the establishment of a list of government agencies competent to receive information about patent applications containing a declaration of the source of genetic resources and/or traditional knowledge (see paras. 30 - 32).

II. A FAIR AND BALANCED APPROACH

3. With regard to the issues addressed in this document, Switzerland holds the view that a fair and balanced approach must be taken: On one hand, Switzerland supports the effective protection of biotechnological innovation through intellectual property rights, in particular patents. On the other hand, a fair and balanced approach necessitates effective, efficient, practical and timely solutions to the issues arising in the context of access to genetic resources and traditional knowledge and the fair and equitable sharing of the benefits arising out of their utilization. This is why Switzerland has been actively supporting efforts to find these solutions in various international fora, including the CBD; the Food and Agriculture Organization (FAO); the “Intergovernmental Committee on Intellectual Property and Genetic

¹ In the CBD, Switzerland presented the “Draft Guidelines on Access and Benefit-Sharing Regarding the Utilization of Genetic Resources,” which formed an important basis in the discussion that led to the adoption of the “Bonn Guidelines on Access to Genetic Resources and Fair and Equitable Sharing of the Benefits Arising Out of Their Utilization” by the sixth Conference of the Parties (COP6) of the CBD in April 2002. At COP6, Switzerland furthermore presented a study on the certification for bioprospecting activities (see Lyle Glowka, Towards a Certification System for Bioprospecting Activities (document UNEP/CBD/COP/6/CH/RPT); this document can be found at <http://www.biodiv.org/doc/meetings/cop/cop-06/other/cop-06-ch-rpt-en.pdf>).

Resources, Traditional Knowledge and Folklore” (IGC) of WIPO;² and the Council for Trade-Related Aspects of Intellectual Property Rights (TRIPS Council).³

4. One crucial issue that these international fora have been addressing is the need for and the realization of measures that increase transparency in the context of access to genetic resources and/or traditional knowledge and the sharing of the benefits arising out of their utilization, in particular with regard to the obligations of the users of genetic resources and traditional knowledge (hereinafter “transparency measures”). Such measures will enhance the mutual supportiveness of the applicable international agreements and can only be successfully realized if all relevant international fora coordinate their efforts closely and strive for coherent results. Switzerland holds the view that transparency measures are an important element in the fair and balanced approach that was advanced above. This is why Switzerland considered in detail the various options available for such measures and their possible modalities and implications. Based on these considerations, Switzerland elaborated proposals regarding the declaration of the source of genetic resources and traditional knowledge in patent applications presented in Part V, below.

III. RECENT DEVELOPMENTS AT THE INTERNATIONAL LEVEL

5. When addressing the issue of transparency measures under patent law, the developments in several international fora need to be considered. Of primary importance are the following:

6. The PLT, adopted 1 June 2000 by a diplomatic conference convened by WIPO, aims at harmonizing certain formalities in national patent laws with regard to the acquisition and maintenance of patents. Among others, it contains provisions on the formal requirements that patent applicants must fulfill and limits the freedom of its Contracting Parties to introduce additional such requirements in their national patent laws.

7. The 31st FAO Conference adopted 3 November 2001 the International Treaty on Plant Genetic Resources for Food and Agriculture (FAO -IT). This treaty contains, among others, provisions on access to plant genetic resources for food and agriculture (PGRFA) and the sharing of the benefits arising out of their utilization.

8. The Doha Ministerial Declaration, adopted 14 November 2001, states in para. 19 that the TRIPS Council is instructed, “in pursuing its work program including under the review of Article 27.3(b), the review of the implementation of the TRIPS Agreement under Article 71.1 and the work foreseen pursuant to paragraph 12 of this declaration, to examine, inter alia, the relationship between the TRIPS Agreement and the Convention on Biological Diversity, the protection of traditional knowledge and folklore, and other relevant new developments raised by Members pursuant to Article 71.1.”

² In the past meetings of the IGC, Switzerland proposed several practical and concrete steps and solutions with regard to the issues on the agenda of the committee. Furthermore, Switzerland supported a proposal that WIPO shall provide additional financial means allowing for the increased participation of indigenous and local communities in the future meetings of the IGC.

³ Among others, Switzerland proposed an international gateway for traditional knowledge (see paras. 16 -19 of document IP/C/W/284).

9. The sixth meeting of the Conference of the Parties (COP6) of the CBD was held in April 2002. Among others, COP6 adopted the “Bonn Guidelines on Access to Genetic Resources and Fair and Equitable Sharing of the Benefits Arising Out of Their Utilization” (Bonn Guidelines). According to its para. 1, this voluntary instrument “may serve as inputs when developing and drafting legislative, administrative or policy measures on access and benefit-sharing with particular reference to provisions under Articles 8(j), 10(c), 15, 16 and 19; and contracts and other arrangements under mutually agreed terms for access and benefit sharing.” With regard to transparency measures, the Bonn Guidelines state in para. 16(d) that

“Contracting Parties with users of genetic resources under their jurisdictions should take appropriate legal, administrative, or policy measures, as appropriate, to support compliance with prior informed consent of the Contracting Party providing such resources and mutually agreed terms on which access was granted. These countries could consider, inter alia, the following measures:

[...]

(ii) Measures to encourage the disclosure of the country of origin of the genetic resources and of the origin of traditional knowledge, innovations and practices of indigenous and local communities in applications for intellectual property rights[.]”⁴

10. The IGC of WIPO decided at its third meeting held in June 2002 to carry out the technical study referred to in para. 4 of Section C of Decision VI/24 adopted by COP6. In this paragraph, WIPO is invited

“to prepare a technical study, and to report its findings to the Conference of the Parties at its seventh meeting, on methods consistent with obligations in treaties administered by the World Intellectual Property Organization for requiring the disclosure within patent applications of, inter alia:

⁴ The following decisions adopted by COP6 also refer to the disclosure of the source of genetic resources and traditional knowledge in patent applications: In para. 1 of Section C of Decision VI/24 (“Access and benefit sharing as related to genetic resources”), the Conference of the Parties

“[i]nvites Parties and Governments to encourage the disclosure of the country of origin of genetic resources in application for intellectual property rights, where the subject matter of the application concerns or makes use of genetic resources in its development, as a possible contribution to tracking compliance with prior informed consent and the mutually agreed terms on which access to those resources was granted[.]”

Furthermore, in para. 46 of Decision VI/10 (“Article 8(j) and related provisions”), the Conference of the Parties

“[i]nvites Parties and Governments to encourage the disclosure of the origin of relevant traditional knowledge, innovations and practices of indigenous and local communities relevant to the conservation and sustainable use of biological diversity in applications for intellectual property rights, where the subject matter of the application concerns or makes use of such knowledge in its development[.]”

- (a) Genetic resources utilized in the development of the claimed inventions;
- (b) The country of origin of genetic resources utilized in the claimed inventions;
- (c) Associated traditional knowledge, innovations and practices utilized in the development of the claimed inventions;
- (d) The source of associated traditional knowledge, innovations and practices; and
- (e) Evidence of prior informed consent[.]”

11. The World Summit on Sustainable Development (WSSD), held in August/September 2002, calls in para. 42(o) of the Plan of Implementation on States to “negotiate within the framework of the Convention on Biological Diversity, bearing in mind the Bonn Guidelines, an international regime to promote and safeguard the fair and equitable sharing of benefits arising out of the utilization of genetic resources.” The General Assembly of the United Nations invites in para. 8 of Resolution A/Res/57/269 adopted at the 57th session of the COP of the CBD “to take appropriate steps in this regard.” It is foreseen that the seventh meeting of the Conference of the Parties (COP7) of the CBD, to be held in April 2004, will address the issue of an international regime.

IV. THE CURRENT INTERNATIONAL LEGAL FRAMEWORK

12. When addressing the issue of transparency measures under patent law, the provisions of several international agreements need to be considered. These are in particular the PCT, the PLT once it enters into force, the TRIPS Agreement, the CBD and the FAO-IT once it enters into force.

(1) *The Patent Cooperation Treaty (PCT)*

13. The PCT provides a widely used centralized system for receiving and searching international patent applications. According to Art. 27.1, “[n]ational law shall require compliance with requirements relating to the form or content of the international application different from or additional to those which are provided for in this treaty and the regulations.” In this regard, Rules 4.1 and 51 bis.1 of the Regulations under the PCT are of particular importance:

- Rule 4.1 enumerates the mandatory and optional contents of the request of an international patent application. According to Rule 4.1(c)(iii), such request may contain “declarations as provided in Rule 4.17.” Rule 4.17 deals with certain declarations that are required by national laws in accordance with Rule 51 bis.1(a). Rule 4.17 permits applicants to include in the request certain declarations corresponding to the matters set out in Rule 51 bis.1(a)(i) to (v), relating to which designated Offices may require evidence or documents. According to Rule 4.18(a), “[t]he request shall contain no matter other than that specified in rules 4.1 to 4.17[...];” furthermore, Rule 4.18(b) requires the receiving Office to delete ex officio any such additional matter.

- Present Rule 51 *bis.1* lists in subparas. (a) to (f) a number of matters relating to which the applicant may be required to furnish documents or evidence under the national law applicable by the designated Office. This rule provides clarity for both applicants and designated Offices that such items may be required to be furnished by the applicant under the national law applicable by the designated Office.

14. The current Rule 4 of the Regulations under the PCT does not require the declaration of the source of genetic resources and/or traditional knowledge in international patent applications. Furthermore, Rule 4 prevents patent applicants submitting an international patent application from voluntarily including any such information as part of the PCT procedure, except in the specification, that is, the description, of the invention. Furthermore, Rule 51 *bis.1*, as currently worded, does not expressly mention the possibility of designated Offices to require the applicant to furnish information on the source of genetic resources and/or traditional knowledge under the national law applicable by the designated Office.

(2) *The Patent Law Treaty (PLT)*

15. Art. 6.1 of the PLT, which deals with the form and contents of national patent applications, states that

“[e]xcept where otherwise provided for by this Treaty, no Contracting Party shall require compliance with any requirement relating to the form or contents of an application different from or additional to:

- (i) the requirements relating to form or contents which are provided for in respect of international applications under the Patent Cooperation Treaty;
- (ii) the requirements relating to form or contents compliance with which, under the Patent Cooperation Treaty, may be required by the Office of, or acting for, any State party to that Treaty once the processing or examination of an international application, as referred to in Article 23 or 40 of the said Treaty, has started[.]”

In this context, Rules 4.1 and 51 *bis.1* of the Regulations under the PCT are of particular importance.

16. Art. 10 of the PLT states that “[n]on-compliance with one or more of the formal requirements referred to in Articles 6(1)[...] with respect to an application may not be a ground for revocation or invalidation of a patent, either totally or in part, except where the non-compliance with the formal requirement occurred as a result of a fraudulent intention.” The validity of granted patents is thus not affected should the patent applicant not comply with the formal requirements enumerated in Art. 6.1. The only exception to this general rule is where such non-compliance results from fraudulent intention. Art. 10 of the PLT, however, only applies once a patent is granted, whereas it does not apply to the national patent granting procedure as such. Art. 10 does therefore not prevent Contracting Parties of the PLT from introducing sanctions for non-compliance with formal requirements prior to the granting of a patent (see Art. 6.8 of the PLT).

(3) *The TRIPS Agreement*

17. Art. 27.1 of the TRIPS Agreement does not allow for any other substantive conditions for patentability than (1) novelty, (2) inventive step or non-obviousness, and (3) capability of industrial application or usefulness. Members are therefore prohibited from introducing different or additional substantive conditions for patentability. Furthermore, according to Art. 29, patent applicants must “disclose the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art [...]”. And finally, Art. 62.1 only allows for “reasonable procedures and formalities,”⁵ prohibiting Members from burdening patent applicants with procedures and formalities that are not reasonable within the meaning of Art. 62.1.

(4) *The Convention on Biological Diversity (CBD)*

18. With regard to access to genetic resources and traditional knowledge and the sharing of the benefits arising out of their utilization, Arts. 8(j),⁶ 10(c), 15.4, 15.5,⁷ 15.7⁸ and 16.5⁹ of the CBD are of particular relevance. The CBD itself does not prescribe specific transparency measures that the Contracting Parties should introduce in their national legislation. These measures are addressed in greater detail in the Bonn Guidelines and in two decisions adopted by COP6: Para. 16(d) of the Bonn Guidelines¹⁰ as well as para. 46 of Decision VI/10 and para. 1 of Section C of Decision VI/24¹¹ all refer to the disclosure of the source of genetic resources and traditional knowledge in patent applications.

⁵ Art. 62.1 of the TRIPS Agreement states that “Members may require, as a condition of the acquisition or maintenance of the intellectual property rights provided for under Sections 2 through 6 of Part II, compliance with reasonable procedures and formalities. Such procedures and formalities shall be consistent with the provisions of this agreement.”

⁶ Art. 8(j) of the CBD requires Contracting Parties to “respect, preserve and maintain knowledge, innovations and practices of indigenous and local communities embodying traditional lifestyles relevant for the conservation and sustainable use of biological diversity and promote their wider application with the approval and involvement of the holders of such knowledge, innovations and practices and encourage the equitable sharing of the benefits arising from the utilization of such knowledge, innovations and practices [...]”

⁷ Art. 15.5 of the CBD states that “[a]ccess to genetic resources shall be subject to prior informed consent of the Contracting Party providing such resources, unless otherwise determined by that Party.”

⁸ Art. 15.7 of the CBD states that “[e]ach Contracting Party shall take legislative, administrative or policy measures, as appropriate, [...] with the aim of sharing in a fair and equitable way the results of research and development and the benefits arising from the commercial and other utilization of genetic resources with the Contracting Party providing such resources. Such sharing shall be upon mutually agreed terms.”

⁹ Art. 16.5 of the CBD states in the context of access to and transfer of technology that “[t]he Contracting Parties, recognizing that patents and other intellectual property rights may have an influence on the implementation of this Convention, shall cooperate in this regard subject to national legislation and international law in order to ensure that such rights are supportive of and do not run counter to its objectives.”

¹⁰ See para. 9 above.

¹¹ See footnote 4 above.

(5) *The International Treaty on Plant Genetic Resources for Food and Agriculture of FAO (FAO-IT)*

19. With regard to access to PGRFA and the sharing of the benefits arising out of their utilization, Arts. 12.2, 12.3(b), 12.4, 12.5 and 13.2 of the FAO -IT are of particular relevance. The FAO -IT introduces a specific transparency measure, that is, an internationally agreed standard material transfer agreement (M-TA). This measure, however, is not related to the international intellectual property rights system.

V. PROPOSALS BY SWITZERLAND REGARDING THE DECLARATION OF THE SOURCE OF GENETIC RESOURCES AND THE RELATED TRADITIONAL KNOWLEDGE IN PATENT APPLICATIONS

20. Based on the aforementioned developments at the international level and the applicable provisions of relevant international agreements, Switzerland considered in detail the various options available for transparency measures and the various modalities and implications. These considerations were guided by the following principles: First, any such measure should allow to attain the desired transparency in an effective and efficient manner. Second, any transparency measure should ensure legal certainty, be practicable and avoid unnecessary administrative burdens and costs for patent applicants and patent authorities. Third, any measure should leave States with as much freedom as possible, enabling them to introduce solutions at the national level that take into account national needs and interests. And fourth, the proposed transparency measure should be mutually supportive with existing obligations of relevant international agreements. Based on these considerations, Switzerland submits the following proposal to the fourth session of the Working Group on Reform of the PCT:

(1) *Proposal to Amend Rule 51 bis. 1 of the Regulations Under the PCT*

21. Switzerland proposes to introduce a new subpara. (g) in Rule 51 bis. 1 of the Regulations under the PCT, which could read as follows:

“(g) The national law applicable by the designated Office may, in accordance with Article 27, require the applicant

- (i) to declare the source of a specific genetic resource to which the inventor has had access, if an invention is directly based on such a resource; if such source is unknown, this shall be declared accordingly;
- (ii) to declare the source of knowledge, innovations and practices of indigenous and local communities relevant for the conservation and sustainable use of biological diversity, if the inventor knows that an invention is directly based on such knowledge, innovations and practices; if such source is unknown, this shall be declared accordingly.”

22. With regard to the terminology used in this proposal, the following can be said:

- First, the proposal uses the rather general term “source.” This term is intended to be understood in its broadest sense possible: It not only includes other terms used

in this context such as “origin,” “geographical origin,”¹² “country of origin of genetic resources”¹³ or “Contracting Party providing genetic resources,”¹⁴ but also any other sources such as publications in scientific journals or books,¹⁵ databases on traditional knowledge, or *ex situ* collections of genetic resources. This broad meaning of the term “source” will help to avoid the difficulties and uncertainties that could arise with other terms used in this context. Furthermore, it allows to indicate whether the genetic resource in question was obtained from the Multilateral System established under the FAO-IT on mutually agreed terms according to the CBD. This is of importance since the rules of the FAO-IT on access to PGRFA and the sharing of the benefits arising out of their utilization differ from the respective rules of the CBD. Additionally, the term “source” allows to specifically declare the region, community or individual that provided the knowledge, innovations and practices. And finally, if genetic resources or traditional knowledge have more than one source, this can be declared accordingly. This may, for example, apply to traditional knowledge of a local community that is described in a scientific journal. In this case, the declaration of this secondary source “scientific journal” would not be adequate; instead, the local community would have to be declared as the primary source as well.

- Second, the proposal uses the term “genetic resource” instead of terms such as “biological material”¹⁶ to ensure consistency with the CBD and the FAO-IT. Art. 2 of the CBD defines the term “genetic resources” as meaning “genetic material of actual or potential value,” and the term “genetic material” as meaning “any material of plant, animal, microbial or other origin containing functional units of heredity.” These definitions are in harmony with the definitions of the terms “PGRFA”¹⁷ and “genetic material”¹⁸ in Art. 2 of the FAO-IT.

¹² This term is used in Recital 27 of the Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the Legal Protection of Biotechnological Inventions (EU Biotech Directive).

¹³ This term is used in Art. 15.3 of the CBD. It is defined in Art. 2 of the CBD as “the country which possesses those genetic resources in *in situ* conditions.”

¹⁴ This term is used in Arts. 15.5 and 15.7 of the CBD. Art. 2 of the CBD defines the term “country providing genetic resources” as meaning “the country supplying genetic resources collected from *in situ* sources, including populations of both wild and domesticated species, or taken from *ex situ* sources, which may or may not have originated in that country.”

¹⁵ This may, for example, be the case where knowledge, innovations and practices of indigenous and local communities, were found in a scientific journal.

¹⁶ This term is used in Recital 27 of the Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the Legal Protection of Biotechnological Inventions (EU Biotech Directive).

¹⁷ Art. 2 of the FAO-IT defines the term “PGRFA” as meaning “any genetic material of plant origin of actual or potential value for food and agriculture.”

¹⁸ Art. 2 of the FAO-IT defines the term “genetic material” as meaning “any material of plant origin, including reproductive and vegetative propagating material, containing functional units of heredity.”

- And third, the proposal uses the term “knowledge, innovations and practices of indigenous and local communities relevant for the conservation and sustainable use of biological diversity” instead of the term “traditional knowledge.” This is to ensure consistency with Art. 8(j) of the CBD and to avoid difficulties that could arise with the term “traditional knowledge,” for which at present no internationally agreed definition exists.¹⁹ As the proposed declaration of the source of knowledge, innovations and practices of indigenous and local communities concerns patent law, it is self-evident that the focus will be on the technical forms of such knowledge, innovations and practices.

23. Rule 51 *bis*.1(g) would only apply if the national law of a Contracting Party of the PCT requires patent applicants submitting an international patent application to declare the source of genetic resources and/or knowledge, innovations and practices, in their patent applications. It is thus the national legislator who decides whether such a declaration is required or not. In case an application does not contain the required declaration, the national law may foresee that the application is not processed any further until the patent applicant has furnished the required declaration; the national law may also foresee that non-declaration will not affect the processing of patents.²⁰

24. The proposed wording “if an invention is directly based on” makes clear that the requirement is complied with if an invention makes immediate use of the genetic resource and/or the knowledge, innovations and practices.

25. Patent applicants will only be able to declare the source of genetic resources and knowledge, innovations and practices, if in fact they do have information about this source. Patent applicants, however, that have no such information, should not be freed from any obligations. For this reason, it is proposed that patent applicants can be required to declare that the source is unknown to them. Consequently, if an invention fulfills the conditions of the new Rule 51 *bis*.1(g), the proposed wording would explicitly enable national legislation to require patent applicants to either declare the source of the genetic resource or knowledge, innovations and practices, or to declare that this source is unknown to them.

¹⁹ The following definition of the term “traditional knowledge”, for example, would seem much too broad for the purposes of the proposed new subpara.(g) in Rule 51 *bis*.1: This term is defined as “encompassing traditional and tradition-based literary, artistic or scientific works; performances; inventions; scientific discoveries; designs; marks, names and symbols; undisclosed information; and all other traditional and tradition-based innovations and creations resulting from intellectual activity in the industrial, scientific, literary or artistic fields.” (See para. 13 of document WIPO/GRTKF/IC/Q.2 “Questionnaire of Contractual Practices and Clauses Relating to Intellectual Property, Access to Genetic Resources and Benefit-Sharing”).

²⁰ This is, for example, the case with the EU Biotech Directive. Recital 27 of this directive reads as follows: “Whereas if an invention is based on biological material of plant or animal origin or if it uses such material, the patent application should, where appropriate, include information on the geographical origin of such material, if known; whereas this is without prejudice to the processing of patent applications or the validity of rights arising from granted patents[.]”

(2) *Proposal to Amend Rule 4.17 of the Regulations Under the PCT*

26. Complementary to the new subpara. (g) of Rule 51 *bis.1*, Switzerland proposes to introduce a new subpara. (vi) in Rule 4.17 of the Regulations under the PCT, which could read as follows:

“(vi) a declaration as to the source of a specific genetic resource and/or knowledge, innovations and practices of indigenous and local communities relevant for the conservation and sustainable use of biological diversity, as referred to in Rule 51 *bis.1* (g).”

27. This proposal would give patent applicants the possibility of satisfying the declaration requirement under national patent law in accordance with the proposed new Rule 51 *bis.1* (g) at the time of filing an international patent application or later during the international phase. This would further simplify procedures related to the declaration of the source of genetic resources and/or knowledge, innovations and practices, with regard to international patent applications.

28. The standard wording in the Administrative Instructions for such a declaration would have to be amended accordingly.

(3) *Effect of the Proposals by Switzerland on the PLT*

29. With regard to “requirements relating to former contents of an application,” Art. 6.1 of the PLT refers to the provisions of the PCT, in particular Rules 4.1 and 51 *bis* of the Regulations under the PCT. Based on the reference to the PCT contained in Art. 6.1 of the PLT, the proposed new Rule 51 *bis.1* (g) of the PCT would also apply to the PLT. The Contracting Parties of the PLT would thus be able to introduce in their national patent laws a declaration requirement that applies to national patent applications. Based on Art. 10 of the PLT, the national patent law may foresee that the validity of a granted patent is affected by a lacking or incorrect declaration of the source, if this is due to “fraudulent intention.” This could, for example, be the case if the patent applicants submit an intentional wrongful declaration that the source is unknown.

VI. ESTABLISHMENT OF A LIST OF GOVERNMENT AGENCIES COMPETENT TO RECEIVE INFORMATION ON THE DECLARATION

30. Several factors weaken the effectiveness of the proposed requirement to declare the source of a genetic resource and/or knowledge, innovations and practices, in patent applications: If the source of a genetic resource or knowledge, innovations and practices, is merely declared in patent applications, States and other stakeholders interested in verifying whether they are named in patent applications would have to scrutinize the large number of patent applications filed annually worldwide. Additionally, some patent offices do not publish patent applications at all or only after the expiration of a certain period of time; furthermore, it may take several years from the filing of a patent application to the granting of a patent and its publication. Thus, if patent applications are not published, the declaration of the source would not become publicly accessible until the patent is granted and published.

31. This could be changed if the officer receiving a patent application containing a declaration of the source of genetic resource or knowledge, innovations and practices, would inform a government agency of the State declared as the source about the respective declaration. Particularly well suited for this task would seem to be the national focal point for access and benefit sharing as described in para. 13 of the Bonn Guidelines. Switzerland therefore invites WIPO, in close collaboration with the CBD, to consider the establishment of a list of government agencies competent to receive this information. This list could be made accessible through WIPO and the Clearing House Mechanism (CHM) of the CBD. States interested in receiving such information could indicate to WIPO the competent government agency, which would then be included in the proposed list.

32. The information about the declaration could be provided in a standardized letter which is sent to the competent government agency in the State indicated in the patent application. This letter would inform this government agency that the respective State has been declared as the source of the genetic resource or knowledge, innovations and practices, and contain the name and address of the patent applicant.

VII. CONCLUSIONS

33. The proposals submitted by Switzerland would explicitly enable the Contracting Parties of relevant international agreements, including the PCT, the PLT, the TRIPS Agreement, the CBD and the FAO-IT, to fulfill their respective obligations. This applies in particular to Art. 27.1 of the PCT, which prohibits additional requirements relating to the form or contents of international patent applications; Art. 6.1 of the PLT, which prohibits additional requirements relating to the form or contents of national patent applications; Arts. 27.1 and 62.1 of the TRIPS Agreement, which prohibit additional criteria of patentability and unreasonable procedures and formalities, respectively; and Arts. 8(j), 15.4, 15.5, 15.7 and 16.5 of the CBD.

34. The proposals submitted by Switzerland furthermore provide the means to ensure that the relevant international agreements on intellectual property, the CBD and the FAO-IT can be implemented in a mutually supportive way. Additionally, the proposals will enable the Contracting Parties of the CBD to implement the provisions of the Bonn Guidelines, in particular their para. 16(d), as well as para. 46 of Decision VI/10 and para. 1 of Section C of Decision VI/24 adopted by COP6.

35. Transparency measures have been called forth that enable the Contracting Parties of the CBD to verify whether their national systems of prior informed consent (PIC) have been adhered to and whether benefits arising are shared fairly and equitably. In the view of Switzerland, this task can best be carried out by the Contracting Party providing the genetic resources in accordance with Art. 15.5 of the CBD. In order to facilitate this task, Switzerland proposes to explicitly enable national patent legislation to require the declaration of the source of genetic resources in patent applications.²¹ Additionally, Switzerland invites

²¹ This is acknowledged in para. 1 of Section C of Decision VI/24 adopted by COP6 of the CBD, according to which the disclosure of the source of genetic resources in applications for intellectual property rights is “a possible contribution to tracking compliance with prior informed consent and the mutually agreed terms on which access to those resources was granted.”

WIPO, in close collaboration with the CBD, to consider the establishment of a list of government agencies that would be competent to receive information about patent applications containing declarations of the source. The disclosure and the respective information would allow the Contracting Party providing the genetic resources to verify whether the patent applicant has fulfilled the requirements and procedures of its national system of PIC and whether provision has been made for fair and equitable benefit sharing.

[End of Annex and of document]