

WIPO AGENDA FOR DEVELOPMENT OF THE INTERNATIONAL PATENT SYSTEM:

MEASURES AND QUESTIONS WHICH MIGHT BE CONSIDERED

(WIPO DOCUMENT A/36/14 ANNEX)

UNICE RESPONSE¹

GENERAL POLICY AND STRUCTURE OF THE INTERNATIONAL PATENT SYSTEM

- 1. *Should the revised structure of the international patent system rely on an extended version of existing systems, and particularly the PCT procedure, or should a new structure be designed?***

UNICE believes that efforts should focus on adapting the existing systems to the increasing demands of global users, rather than taking steps to design new ones.

In the revised structure of the international patent system, no national phase examination should be carried out anymore if the PCT search and examination are based on internationally agreed upon patentability standards laid down in the SPLT, and carried out by an organisation that is trusted by the various designated states. An independent quality control mechanism should be ensured. Moreover, after a positive PCT examination, the "international patent" thus obtained should be administered by WIPO, just as in the Madrid system for trademarks and in the Hague system for industrial designs.

- 2. *Subject to progress on substantive harmonization of patent laws, should there be an adoption of procedures where substantive rights could be granted under an internationally recognized procedure?***

Yes. Please refer to response under Question 1.

- 3. *How should much wider use of the PCT system by applicants in developing countries, least-developed countries and countries in transition be promoted?***

WIPO technical assistance should be further developed, considering a wider range of beneficiaries than usual (e.g. practitioners and users).

- 4. *What role should regional patent systems have in the international patent system? Should groups of countries be encouraged to establish further regional systems? In determining the form of any regional system, matters to be considered would include the potential for responding to current workload challenges.***

UNICE shares the view that further regional systems should be established upon existing experiences, and cooperation – involving the users – should be developed between them in order to overcome workload challenges until a satisfactory international patent granting procedure has been developed.

If the international patent system developed as indicated in our response to Question 1, i.a. with a fully international examination and administration of "international patents", regional patent offices could still play a role in carrying out a PCT search and examination provided that they can meet the quality requirements necessary for international acceptance of the examination result.

New regional patent offices should only be established if they can carry out a search and examination that are better than a search and examination carried out by the national patent offices in that region.

¹ WIPO's questions and suggested measures have been highlighted in bold and italics.

5. ***Should there be a reconsideration of the need for patent offices to subject each and every application to full pre-grant search and examination, subject to proper options for later assessment of patentability at the instigation of applicants, patent offices and/or third parties?***

In the interest of having patent applications properly and expeditiously searched, examined and granted, UNICE shares the view that an improved PCT, and/or regional systems and/or other work-sharing arrangements should assist states that are unable to carry out expeditious, substantive examination. UNICE opposes deferred examination.

6. ***Should there be studies aimed at broader and internationally consistent coverage in new, or newly exploited, fields of technology?***

Patentability requirements should be internationally agreed upon, as much as possible.

7. ***Should an internationally acceptable system for the preparation of applications, and more particularly for the drafting of patent claims and their interpretation, be investigated?***

UNICE believes that such an investigation should take place in the course of the PCT reform, as a basis to develop further a comprehensive SPLT system as regards substantive law and aiming to cover fully the area between procedural and substantive law.

SERVICE FOR USERS

8. ***In addition to the Patent Law Treaty and the on-going program for reform of the PCT, should there be further projects aimed at the simplification and streamlining of practices and procedures, with reduction in costs, and reduction or elimination of unnecessary formalities review and handling of applications, while maintaining an appropriate quality of search and examination?***

Yes. UNICE believes that, in the course of reforming the PCT and finalising a SPLT agreement, consultations of the users/patent offices should be undertaken to assess the problems and to collect suggestions for improvement.

9. ***Should patenting services be provided that are simple and easy to use for applicants, consistent with expectations based on wide use of "one click" transactions on the Internet, and if so, how?***

Such a measure would aim to simplify the procedures considerably. In this context, WIPO could be the pivotal body between the national authorities and the users for such transactions.

10. ***The development of timely processing, consistent with business needs and the commercial value and commercial life of inventions, including options for applicants to choose fast-track or deferred processing depending on the circumstances.***

Development of timely processing is definitely a vital issue. Options for expeditious processing should be explored in a pragmatic manner on the basis of the experiences drawn from the existing systems and bearing in mind that quality of the patent remains a prerequisite.

COSTS

11. ***Can low cost, high quality, alternatives for securing patent protection be developed, accessible by those would-be users (notably, individual inventors, small and medium sized enterprises, and many applicants of all sizes from developing countries, least-developed countries and countries in transition) for whom international patent protection is presently inaccessible because it is too expensive to obtain?***

UNICE strongly believes that efforts to have a low cost patent should not put at stake the high quality which is sought and expected from it. In this respect, the current European experience illustrates well the issue and should be taken into account in further discussions. The ongoing projects aim to create user-friendly patents in terms of cost, seeking to preserve at the same time their competitive aspect and legal certainty (e.g. revision of the

EPC, Community patent). Besides, UNICE remains of the opinion that alternatives such as utility model would not solve the problem of a costly patent system but, on the contrary, will be the cause of more cost (e.g. ground for litigation). In this context, UNICE believes that only high-quality alternatives should be considered.

SEARCH AND EXAMINATION

12. Should there be studies aimed at consistency among patent offices in search and examination policy, practices and procedures?

Yes. UNICE is of the strong opinion that high quality and related control have to be well thought-out in order to ensure an international level playing-field; in particular, if the existing international mechanisms are developed further.

13. What possibilities exist for greater sharing of search databases?

The experience drawn from the existing exchanges of information between regional and national offices should be used in order to build up greater networks and corresponding access to these networks both by patent offices and by the public.

The creation of a centralised database system should be investigated.

14. What possibilities exist for enhancement of the value of the present search and examination procedures?

Search and examination are indissociable procedural elements, whose quality has to be ensured, with evenness from one office to another one. Experience should be drawn from existing practices; in particular by comparing regional offices and the conditions under which they operate.

15. Are there alternative ways of obtaining search results, possibly by more use of commercially available search databases, statutory requirements for applicants to disclose prior art, and enabling voluntary (and possibly anonymous, via the Internet) contributions to search work from third parties?

UNICE shares the view that an expanded network of shared search databases should be primarily used by offices which do not have the capacities to maintain a full search activity. In addition, listing citations should not be a requirement for applicants, rather the respective patent offices should cooperate to receive such information if desired.

16. Should multiple, supplementary or combined searches and examinations by different offices be available?

UNICE shares the view that this should be left to the applicant's choice.

17. Is it possible to simplify certain procedural aspects of search and examination, such as by combining search and examination, simplifying nucleotide and amino acid sequence application processing, and simplifying the procedure in case of lack of unity of invention?

Acknowledging that such simplifications would be desirable and achievable, it is primordial to ensure that they should not result in increased delays and unnecessary work. New techniques together with studies already undertaken should be examined and the solutions they afford should be explored before final solutions are given.

SHARING OF INFORMATION AND RESOURCES AMONG PATENT OFFICES

Is it feasible to consider:

18. Greater sharing of common tools (for example, search databases, computer-assisted translation techniques, search and examination reports, publication having international effect, a common register of granted patents); other offices (including small and non-examining offices) could make use of search and examination reports as non-binding opinions?

Greater sharing of common tools should be encouraged and based upon existing cooperation. Moreover, UNICE supports the suggestion that smaller offices could be encouraged to accept major office results as binding (e.g. offices of EPO extending states).

19. Programs for inter-office lending of experts to increase the flow of expertise and skills, and optimizing the use of resources among offices?

As an alternative, UNICE would like to suggest that efforts should be focused on developing further technical training at national level, and that inter-office lending of experts takes place in a second phase once the training programme has been fully completed.

This exchange of experts should be done on a case-by-case basis by carefully assessing the needs of the recipient office as well as by taking care not to impede the well-functioning both of the lending office and recipient office. This should not lead to the creation of a system whereby extra financial costs and time burdens would have to be borne by the users.

20. Specialization of patent offices' work in particular technical fields and in particular languages, of examiner expertise and of search resources; this would imply new organizational and inter-office operational policies?

The large majority of UNICE's members is not of the viewpoint that patent offices should operate on a specialisation basis. However, if this were to be considered, it should be subject to an in-depth analysis, taking into account the existing regional mechanism as well as the individual capabilities of the patent offices which could be involved. Please also refer to response under Question 14.

21. More efficient and comprehensive monitoring of the processing of applications by the patent offices involved in the processing of applications under the various national, regional and international systems?

This question should be more clearly re-formulated.

AVOIDING UNNECESSARY DUPLICATION OF WORK

22. Are there ways in which there might be a reduction in duplication of work, especially in search and examination, with resulting cost savings for applicants and offices? This would imply greater recognition or exploitation of the results of the work done by other offices. Can expanded procedures be developed which would allow patent offices to use the results of work undertaken by other offices, for example, by a centralized monitoring system of all applications to allow offices to avoid duplicative work?

Please refer to responses under Questions 13, 14, 15, 18 and 19.

23. Are there ways in which positive examination results in other patent offices may be recognized?

Bearing in mind that patentability standards differ from one office to another one, it is true that common search and quality control would be desirable.

In any case, UNICE views that there should not be any automatic refusal on the basis of negative results elsewhere: the applicant should always be allowed to make the case for grant and given the benefit of the doubt. Please also our response to Question 1.

INFORMATION AND COMMUNICATIONS TECHNOLOGY

24. How may greater use be made of modern information and communications technology in the obtaining and processing of patent rights, by both applicants and offices?

UNICE understands that WIPO together with the major patent offices are currently working on the set-up of an online system, and supports this initiative.

In addition, UNICE also shares the viewpoint that modern technologies should be used in the obtaining and processing of patent rights. Patent offices, which do not have the ability

to reach such technological capacities should be seconded in an adequate manner (see responses to Questions 4, 13 and 19).

DISSEMINATION OF INFORMATION TO THE PUBLIC

25. Are there ways for ensuring that third parties are able to determine at the earliest opportunity whether a patent is likely to be, or has been, granted by any particular patent office? Issues which may be considered include electronic international publication, publishing international preliminary examination reports, greater use of computer-assisted translation, permitting access to files by all offices and third parties at any time after publication of the application, and a common register of granted patents.

Please refer to response under Question 13.

ORIENTATION TOWARDS LICENSING AND MARKETING

Issues which may be addressed here include the necessity for mechanisms and programs designed to provide:

26. Support for international licensing and other business transactions, including development, manufacturing, sales, marketing and technology transfer agreements.

UNICE is of the opinion that WIPO could be regarded as a suitable forum to develop training and/or central information exchange for enterprises in developing countries. However, other non-governmental and business bodies/associations should be involved.

27. Assistance in the identification of tools necessary for assisting research and development activities and the valuation and commercialization of patented technology.

UNICE believes that such activity should be handled by other international agencies in cooperation with local government assistance programmes.

28. Reliable and certain operation of the system so as to support international investment, for example, in relation to decisions concerning patentability.

UNICE is of the strong opinion that the view that decisions about patentability cannot be reliable until an internationally recognised and acceptable search has been conducted.

RESOLUTION OF POST-GRANT DISPUTES

29. Are there any new possibilities for resolving infringement and validity disputes in an international context by provision of a system of alternative dispute resolution, for example, using an expert arbitrator, as in WIPO's arbitration procedures?

It should be left to the parties to decide whether they want to call upon an arbitration mechanism.

SMALLER PATENT OFFICES

30. What sort of advice and assistance should be provided for small and medium-sized patent administrations in respect of the introduction of systems for pre-grant processing of applications for patent rights?

Acknowledging that smaller patent offices can draw on experience from larger offices, UNICE also supports the view according to which incentives/programmes should be developed in order to encourage and second small and medium-sized patent administrations to join or form regional groupings. WIPO would have an important role to play, providing input both for management and for technical courses. Please refer also to responses Questions 9, 18 and 19.

COOPERATION FOR DEVELOPMENT

- 31. What sort of advice and assistance should be provided to provide a more focused development orientation, in which the patent system encourages new business development, investment and the movement of technology, hence contributing to employment and wealth creation?**

Awareness campaign and related concrete follow-up activities both for the governmental authorities in charge and for the local companies are imperative in order to promote the concern that a sound climate for investment is backed up by the encouragement of an effective and efficient patent system. In this context, upon its experience and its past practices, WIPO should pursue its activities, working hand in hand with the relevant circles concerned by business development.

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