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BUSINESSEUROPE COMMENTS ON PROPOSALS TO FURTHER IMPROVE PCT SERVICES

BUSINESSEUROPE welcomes the opportunity by the World Intellectual Property Organization (WIPO) to comment on the proposals for further improvement of the Patent Cooperation Treaty (PCT) system as presented on the one hand by the United Kingdom and the United States (Expanded PCT 20/20 proposals), and on the other hand by the European Patent Office (EPO) (proposals to strengthen the PCT).

BUSINESSEUROPE considers PCT as the primary tool for international patent protection and cooperation. This is why we welcome proposals to improve the PCT system in line with its objective “to simplify and render more economical the obtaining of protection for inventions where protection is sought in several countries”.

We look forward to working together with WIPO and all Patent Offices in order to further improve the PCT. In this context, we would like to provide the following detailed comments on the two sets of proposals from the United Kingdom and the United States on the one hand, and the European Patent Office on the other hand.

We particularly welcome the UK/US proposals on “STANDARDIZING FEE REDUCTIONS FOR NATIONAL STAGE APPLICATIONS” (D, ANNEX I) and on “FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT, FAST TRACK OF NATIONAL PHASE APPLICATIONS, IMPROVE REUSE OF PCT WORK AT THE NATIONAL PHASE” (K, ANNEX I).

These should lead to an increased use of PCT-II, as they require a positive PCT report. It is better to have part of the substantive examination only done once rather than multiple times before each of the designated offices.

We also wonder why in proposal D it is suggested that the national fee is reduced while in proposal K that a fee may be charged for PPH processing. These two elements do not seem to be aligned.

We also fully endorse the UK/US proposal to introduce MANDATORY “TOP-UP” SEARCHES (I, Annex I). If applications would enter the national phase while there is relevant prior art that has not been considered by the applicant when deciding on national phase entry, this would be a waste of scarce resources both for applicants and offices. If this proposal cannot be adopted, the EPO proposal to INTRODUCE OPTIONAL “TOP-UP” SEARCHES IN CHAPTER II (ANNEX II) should be put in place.

The UK/US proposal on “INTERNATIONAL SMALL/MICRO ENTITY REDUCTION” (E, Annex I), raises the issue of the availability of sanctions if an applicant misrepresents itself as an SME or a micro-entity, and consequently wrongly benefits from a fee reduction. In a US-style common law system, the sanction would be that the patent is unenforceable. It is unclear how this could work in civil law jurisdictions. Article 138



European Patent Convention (EPC) only allows for a limited number of revocation grounds. Wrongly benefiting from fee reductions is not among them.

Concerning the UK/US proposal to “INTEGRATE NATIONAL/INTERNATIONAL PHASES, USE A NATIONAL FIRST ACTIONS ON THE MERITS FOR PCT SEARCH REPORT, REQUIRE RESPONSE TO NEGATIVE COMMENTS AT THE NATIONAL PHASE” (F, Annex I), applicants may wish to file PCT applications that take into account the objections made by the office of first filing (“OFF”, i.e. the office with which the priority application was filed). Only before filing the PCT application it is possible to amend the application in a way that would otherwise result in a new matter objection. For example, with knowledge of the prior art found by the OFF, it may be desired to mention additional advantages of what now appears to be the main invention and/or to introduce intermediate generalizations.

It is possible that the PCT application differs from the priority application. In that case a combined processing of priority application and PCT application, or a filing of a patent specification once only does not make sense.

It is obvious that the international search and examination should get full faith and credit before the designated office that has already looked into the application in its previous capacity as International Searching Authority (ISA) / International Preliminary Examining Authority (IPEA).

Also, it makes sense to require from an applicant, at the time of national phase entry, a complete response to any outstanding negative indications made by the ISA/IPEA, even if the designated office has not acted as ISA / IPEA.

An automatic exchange of priority documents would result in a clear simplification for both applicants and offices.

We welcome the objective of the UK/US proposal on “COLLABORATIVE SEARCHING (2+OFFICES), ELIMINATE SUPPLEMENTARY INTERNATIONAL SEARCH” (H, Annex I), to provide applicants with a high-quality PCT search and a solid basis for deciding whether to continue with the application towards national phase entry.

However, the total search fee may be rather high. It is therefore unlikely that applicants will make a wide use of the facility. In view thereof, the supplementary international search (SIS) system should not be abandoned in favour of a collaborative search system. The SIS system allows an applicant to only apply for a SIS if the regular PCT search shows that the invention is still sufficiently worthwhile to justify further investments.

We observe that the EPO has proposed a very interesting improvement to the SIS system namely to open the EPO's Chapter II to PCT applicants who do not use the EPO as ISA. In this proposal, the EPO would carry out a supplementary search within the framework of a PCT-II procedure, which allows applicants not only to start this PCT-II procedure only when the regular PCT search shows that the invention is still sufficiently worthwhile to justify further investments, but also to amend the PCT application in the light of the regular PCT search when filing the PCT-II demand, so that the IPEA's supplementary search and preliminary examination can be directed to



claims that already take the ISA's objections into account. In contrast, a regular SIS is based on the PCT application as filed, so that the SISA has to re-search claims already found to be objectionable by the ISA.

The proposal on "DEVELOPMENT AND IMPLEMENTATION OF THE GLOBAL DOSSIER AND INCORPORATION OF SAID SYSTEM IN THE PCT" (J, Annex I) is supported by BUSINESSEUROPE.

BUSINESSEUROPE participates in the Global Dossier Task Force and is keen to work together with the Offices to develop its framework and the various projects under the Global Dossier. It might be premature to talk about incorporating the results of the work being performed into the PCT. We support the evaluation of an ePCT system to make entry into the national phase more efficient.

BUSINESSEUROPE supports the objective of the EPO proposal to "IMPROVE TIMELINESS FOR ESTABLISHMENT OF INTERNATIONAL SEARCH REPORTS" (Annex II).

The Offices concerned have to improve respectively the transmittal of receipt of the search copy.

If more time is allocated to the PCT-I search, less time remains for the PCT-II phase, which makes it more difficult for applicants to qualify for PPH processing and fee reductions in the national phase by getting a positive PCT report. Insofar as this is the likely effect of the proposed amendment to Rule 42.1 PCT, we do not support that amendment.

Instead, it should be ensured that the search copy and the search fee are sent to the ISA without delay, to improve timeliness of international search reports so that all PCT publications are A1 publications.

We also support the EPO proposal to "CLARIFY PRACTICE ON AUTHORISING INCORPORATION BY REFERENCE OF MISSING PARTS" (Annex II, paragraphs 12 to 16) but would invite offices to consider the following improvements.

In case some Receiving Offices (ROs) apply their own principles on allowing an application text which is not related to the originally filed text, it is not a problem of an ISA which of these two documents should be searched. It is a problem of the public affecting legal certainty.

We welcome paragraph 16 of the proposal, but suggest that an expert group should reword Rule 4.18 and Rule 20.5. This rewording could be made perhaps by adding a summarizing sub-paragraph f) to Rule 20.5 which corresponds to the proposed amendment (cf Appendix III). The law must be made transparent to the applicant. Guidelines are also publicly available but it is rather difficult to retrieve the exact part of these Guidelines for RO's.
