

Report Q109

PCT – Patent Cooperation Treaty

by Heinz BARDEHLE

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The PCT is in a steady process of modernisation considering the expressed needs of the applicants. We have to be thankful to the PCT-Department of WIPO and the staff of the PCT-Department, which is always open to well-founded proposals for improving the service supplied by the PCT.

WIPO has installed a Patent Cooperation Treaty Working Group, which had its first session in Geneva on May 26 – 30, 2008. The essential points of said meeting are outlined in this report:

The 30-month-term for entering the national phase is a well-established feature of our handling of PCT applications. However, in case of a late issue of the PCT search shortly before the end of this term the applicant has to draw a quick decision about the basic question either to enter the national phase or to drop the application, or to file amended claims in order to reasonably consider the search.

This situation has influenced the delegation from Israel to propose a possible extension of the 30-month-term by 6 months. This proposal was rejected by the majority of the member states with the consideration that the 30-month-term is already a long term, in which competitors of the applicant having seen the 18-month-publication of the respective application have to decide about own activities with regard to a possible protection in PCT countries, in which the applicant would enter the national phase. If this term would be extended by 6 months, the competitor would be in a legal uncertainty of some time after the end of the 30-month-period, whether the applicant would start a national phase and where. The proposal from Israel was in principal not rejected, but attention was drawn to the representatives of the international searching authorities to be more diligent and to observe the needs of the applicants and to provide an early search.

After the adoption of the languages Portuguese and Korean for publication under the PCT a general debate took place, in which the majority of member states wanted to establish criteria for the addition of further languages of publication by which the number of people speaking a respective language would have to be taken into consideration in comparison with the world-wide number of readers of PCT applications in many countries. In view of the fact that as of January 01, 2009 the

following 10 languages of publication under the PCT will be in force – Arabic, Chinese, English, French, German, Japanese, Korean, Portuguese, Russian, Spanish – there is already a great variety of languages. Based on concrete figures of the use of languages the Secretariat of PCT will put forward to the PCT assembly a proposal, which “must properly balance interests of different users of the patent system, including costs incurred as well as convenience, and recognize the political importance of the question of language”.

The European Patent Office had proposed to introduce a claims fee because of the experience that an excessive number of claims is recognized in many countries. This is a practice of certain applicants who expect from patent applications with a large number of claims, particularly independent claims, a illegal uncertainty about a possible later granted protection. In view of a fair balance between the interest of applicants and third parties, offices should not accept the tendency of certain applicants to obscure their inventions for as long as possible for examiners and the public. Because there was broad support in the meeting for further consideration of the proposal for the introduction of claims fees in the PCT the matter will remain on the table with a more detailed proposal prepared by the European Patent Office and the International Bureau.

Please see also PCT Newsletter of June 2008:

http://www.wipo.int/export/sites/www/pct/en/newslett/2008/pdf/newslett_08.pdf.

Heinz BARDEHLE
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