

Report Q109

PCT – Patent Cooperation Treaty

by Heinz BARDEHLE

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Responsible Reporter	Shoichi OKUYAMA	Japan
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Report on the Second Session of the Patent Cooperation Treaty (PCT) Working Group, Geneva, May 4 to 8, 2009

The second session of the PCT Working Group was attended by representatives from all PCT Member States and a great number of international and national associations of the interested circles.

1. The meeting started with a discussion of WIPO paper PCT/WG/2/3 entitled "DRAFT ROADMAP FOR THE DEVELOPEMENT OF THE FUTURE PCT" (Annex 1), drafted with great care by the PCT Division of WIPO. The headlines of this roadmap included:
 - a) Duplication of work should be minimized.
 - b) The system must deliver results which meet the needs of applicants and designated offices.
 - c) The system must be accessible to applicants of all types (industrial countries and developing countries).
 - d) Patents granted on the basis of international applications should have a high presumption of validity.
 - e) Unnecessary actions for offices and applicants should be eliminated.
 - f) Information relating to international applications should be available as freely and efficiently as possible:

While the idea of minimizing duplication of work (work sharing) was generally viewed positively by the industrialized PCT Member States, concerns were expressed by a number of developing

countries, notably India, Brazil and China, that the draft roadmap might be seen as a move in the direction of issues going beyond the existing legal framework of the Treaty, such as harmonization of substantive patent law, mandatory effects of international reports in the national phase and legal presumptions of validity.

After long discussions, while the Working Group did not agree to submit the draft roadmap to the PCT Assembly with a view to its adoption, there was agreement that the PCT system can and should function more effectively, within the existing legal framework of the Treaty provisions, and that any changes should be incremental ones and should not affect the freedom of Contracting States to prescribe, interpret and apply substantive conditions of patentability and without seeking substantive patent law harmonization or harmonization of national search and examination procedures.

A proposal from the US delegation (document PCT/WG/2/12) of a "comprehensive revision of the international patent system which would result in the establishment of the new PCT" (proposing a system under which, similar to that under The Hague (1999) Agreement, an international application, having received a positive international report on patentability, would automatically issue as a national patent unless a national Office issued a notification of refusal within a specified period of time) was debated with some reluctance from the delegations from the industrialized PCT Member States but completely rejected by the developing countries.

For the moment, it has to be reported that nothing has changed but all proposals are shifted to future meetings, to be supported by more detailed studies and consultations with all stakeholder groups. Characteristic for the meeting was the negative attitude of several developing countries, lead by India and supported by others, notably, Brazil and China and a number of African countries.

Considering the attitude of India and China, it is completely incomprehensible why those countries reacted so negative to proposals for the improvement of the PCT which would be for the benefit of applicants. Those countries have a growing number of applicants filing PCT applications in consideration of the establishment of great centers for the development of new technologies (India in Bangalore for General Electric and Siemens) from where a steady flow of inventions go to their industries and their export accompanied by corresponding patent applications. It is therefore an important task for AIPPI with its special national groups in those countries to submit and underline the views and desires of the applicants from those countries to their authorities, which may be not advised in a complete and realistic sense. Therefore, it is to be hoped that symposia and other informative meetings organized by AIPPI could be a key for a better information of the members of the authorities who have to be urged to attend those meetings in order to give them information from first hand and may discuss their ideas with practitioners from India and other countries.

The PCT reform is a chance for all applicants from all countries in the world so that we should do our best to support the efforts of WIPO where the respective authors of the proposals have done an important work with great care for which we have to be thankful to them.

In this sense it shall be noted that before the meeting of the Working Group the Director General of WIPO had invited representatives of user organizations as well as representatives of some of the largest PCT filers to a meeting on March 2, 2008. This meeting only with the users really was a new step of WIPO in the area of consultations in the process of developing new stipulations. This meeting, to which AIPPI was also invited, took place in an atmosphere of mutual confidence and the intention to support the efforts of WIPO from the side of the users which of course have a good direct connection to their authorities in many countries. Therefore, all delegations on that meeting expressed their gratitude to the Director General for invitation in the hope that it will happen again in a new situation.

The Working Group also discussed eligibility criteria for reductions in PCT fees (see PCT/WG/2/4) and requested the International Bureau to present further studies, including into possible fee reductions for small and medium sized enterprises and universities.

Furthermore, the Working Group discussed and approved proposed amendments of the PCT Regulations, for adoption by the PCT Assembly in September 2009, which would:

- (a) require applicants to indicate the basis for amendments made under Articles 19 and 34 (PCT/WG/2/9);
- (b) clarify and improve the efficiency of the process for setting equivalent amounts of certain fees (PCT/WG/2/2); and
- (c) clarify the types of limitation which International Searching Authorities may make in relation to supplementary international search services (PCT/WG/2/10).

In this context, it is worth noting that, despite originally strong demands from the user community to offer this new service, to date, there have been very few requests for supplementary international searches since its start in January 2009, less than 10 requests have been made.

The summary by the Chair (PCT/WG/2/13) and the report of the session (PCT/WG/2/14) are available on the WIPO website.