



Advancing Industry's View On Intellectual Property Since 1920

PCT Reform - Preparatory Papers 1-7 for 7th session of WIPO Working Group on PCT Reform

TMPDF* has the following comments on preparatory papers 1 Rev - 7 for the next, 7th, session of the working party.

Paper 1 Rev - Missing elements and parts of the International application

Incorporation of parts of the description in the application by reference to an earlier priority application - rules 4.18 and 20.6.

These draft rules imply that a part only of the description can be incorporated into the application by reference to an earlier priority application. The particular part, so it seems, will not be made clear until the full text of it is filed later under rule 20.6. Thus at the date of filing, it will not be clear what the description in the application contains. This differs from PLT Article 4(7), which indicates that the reference should replace the description and drawings - i.e., a whole description should be present at the date of application, or it should be entirely represented by the reference, so that it is clear on the application date what constitutes the description. Note also new UK Section 15 (1)(c), where either a (whole) description, or a reference, should be supplied. We consider that the new PCT rules should correspond closely with the PLT and that it should not be permissible to put the description together at a date later than the filing date.

Time limits under rule 20.7

We favour two months rather than one, to allow reasonable time to prepare translations where these are needed, for representatives to obtain instructions, etc.

Transitional reservations under rule 20.8

We are concerned that receiving offices are not to be required to apply the provisions concerning incorporation by reference when their national laws do not provide for this. The result will be that the approach of some receiving offices to according filing dates will be different from others. We consider that (allowing for language differences and local representation rules) all receiving offices should operate to the same standards, particularly concerning the filing date, and apply the provisions of the PCT rather than national law, as required by PCT article 10.

Paper 2 Rev - Restoration of the right of priority

We are concerned that the options and reservations available to receiving offices will lead to a wide variation of practices between receiving offices, inconsistent with what should be a single international system and highly confusing. There should be one criterion for allowing restoration, i.e., that the failure to file within 12 months was unintentional, and all receiving offices should apply it. (As with filing the description by reference, reservations should not be allowed on the basis of incompatibility with national law - receiving offices should apply the PCT to international applications, whatever their national law.)

Moreover, we also consider that all designated/elected offices should be encouraged to accept the "unintentional" standard. If they do not, the consequences will be that applications considered valid

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in some offices will be refused in others - a trap for applicants and a failure of international harmonisation.

Papers 3, 4 and 5 - no comments at this stage

Paper 6 - Rectification of obvious mistakes

While we agree that this rule should be restricted to mistakes and should be applicable to other documents besides the international application, we are concerned that it is drafted too restrictively. We consider that mistakes should be "obvious" - it is not clear what standard would apply if the test were to be "manifestly obvious".

Further, we consider that it should be permissible to consult the priority document to establish what the proper correction of an obvious mistake should be. We also see no problem with referring to the common general knowledge in the art concerned to establish the proper correction of an obvious mistake.

The new rules appear to make it more dangerous for the applicant, in the case of an application claiming priority from an earlier application, to provide a new description at the filing date rather than merely to provide a reference to the earlier application, because of the possibility of transcription mistakes. This is a deplorable development.

Paper 7 Swiss proposals regarding the declaration of the source of genetic resources

We are generally opposed to requirements for such declarations, for reasons given in a letter (of 15 September 2004), to the Chief Executive of the UK Patent Office (copy available on request from <mailto:admin@tmpdf.org.uk>). We do not think the PCT should be adjusted to provide for these declarations. Rather, it should be made clear that no state should require such a declaration to be supplied in relation to a PCT application in the international phase.

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*TMPDF represents the views of UK industry in matters concerning intellectual property. It has close links with the CBI. Its members include many of the major innovative UK companies, which are represented at meetings of the governing Council and Committees of the Federation by their professional IP managers. Before the Federation takes a position on any issue, official consultation documents and other relevant papers are submitted to the members for debate and dialogue. An appropriate Committee and/or the Council, depending on the issue, then determines the position, taking account of comments.

The published views/opinions/submissions of the Federation are normally approved by consensus. In cases where there is a substantial majority view falling short of consensus, any significant disagreement will be indicated.