



**Reform of the Patent Cooperation Treaty (PCT): Informal Consultation by the UK IPO**  
**IP Federation reply to the consultation**

**PP16/09**

**Introduction**

The IP Federation submitted a discussion paper, PP02/09, in January 2009 to WIPO and to the UK IPO, among others, outlining views on the enhancements necessary to improve the usefulness and trustworthiness of the PCT to users. We are therefore pleased that the need for reform is under serious discussion in international circles and that the UK IPO is seeking views. A copy of our paper is attached.

The questions set out in the UK IPO consultation document are included below in *italics*

**1. Collaborative international search**

**Q1 (a):** *What do you think about the idea of collaborative search?*

We are very much in favour of it

**Q1 (b):** *Do you have any views on the form that collaborative search should take?*

The International Search Authority (ISA) for the particular application should first carry out a high quality search of its own data base. (ISA status should be withdrawn from those authorities that cannot be relied upon to perform a consistently high quality search.) Thereafter, the ISA should ensure that any requests by the applicant for supplementary searches by other authorities are implemented. It should consider with the applicant whether significant searching skills and resources in the subject technology might lie elsewhere (taking account of the most likely languages of potential citations), in order to decide to what extent its own search should be complemented. The ISA should liaise with other search authorities, patent offices and even non governmental search institutions to produce a collaborative result. It may be that WIPO or an outside non governmental body, rather than the ISA, should in due course manage the collaborative process.

**Q1 (c):** *Would you be prepared to pay a higher search fee for a better quality international search?*

Yes, within reason. Additional costs should be limited because supplementary and additional searching should be carried out to complement the ISA search, rather than being carried out *ab initio*, so should be somewhat less extensive than the first ISA search, concentrating on areas where language or other special knowledge is relevant.

**2. Third party observations**

**Q2 (a):** *What do you think about the idea of introducing a system for filing third party observations in the international phase?*

We agree

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**Q2 (b):** *Do you think that the suggested details of the system would strike a fair balance between the interests of the applicant and of third parties?*

We consider that, if - but only if - the applicant requests international examination for designated states, there should be a full examination in the international phase, so that the application is ready for grant when it enters the national phase of those states. There may be a need for greater harmonisation of national laws concerning patentability and content of disclosure, or acceptance by member states of international provisions established in conjunction with the PCT, to ensure that the examining authority can do this.

**Q2 (c):** *Do you have any alternative suggestions for the form that the system should take?*

See Q2 (b)

### **3. International preliminary examination**

**Q3 (a):** *What do you think of the ideas for reforming the IPE procedure?*

We agree that it should be reformed. There should be a full examination in the international phase. The word "preliminary" should be discarded. See also answer to Q2 (b)

**Q3 (b):** *Do you think the suggested changes would affect the way applicants use the IPE procedure?*

Probably. We would expect far more applicants to request international examination.

**Q3(c):** *Do you think there is any value in the idea of collaborative international examination?*

Yes. A three person international examining division, working (via electronic communication) in a similar way to the EPO examining division, could be of real value. However, this is likely to be time consuming, more expensive and to put pressure on scarce resources in examining authorities. The first matter to focus on is collaborative search.

**Q3 (d):** *Do you think that the time limit for national phase entry under Chapter II should be extended?*

Yes, if a full examination is to be carried out.

**Q3 (e):** *If so, what should the time limit be and what measures should be taken to prevent applicants using Chapter II as a delaying tactic?*

48 months. Use merely as a delaying tactic would be avoided by requiring the results of international examination to be considered as final on entry to the national phase, subject only to immediate appeal if rejection is recommended in the international report, or very brief "top up" examination to check any national peculiarities if grant is recommended.

**Q3 (f):** *Do you have any other suggestions for improving the IPE procedure?*

Further details are given in our paper PP02/09



#### **4. Top-up search in the international phase**

**Q4 (a):** *What do you think about the idea of introducing a top-up search into the IPE procedure?*

We agree that a top up search should be carried out.

**Q4 (b):** *What do you think about our suggested way of dealing with citations published after the priority date at IPE?*

Efforts should be made to harmonise laws to provide a standard treatment of applications with earlier priority but published after the application date of the patent in suit, so that such applications can be properly considered during the international examination. An appropriate model would be the EPC (such applications would be citable against novelty but not inventive step). For those states where this is not acceptable, then the approach in the consultation document could be followed (i.e., the applications would be drawn to the applicant's attention, but not considered during international examination).

**Q4 (c):** *Would you be prepared to pay a higher fee for an IPE that included a top-up search?*

Yes, within reason.

#### **5. Accelerated processing option in the international phase**

**Q5 (a):** *What do you think of the idea of introducing an accelerated processing option in the international phase?*

The option should be available, if resources permit.

**Q5 (b):** *Which of the two criteria for granting a request for acceleration would you prefer - a requirement to provide an adequate reason for the request or the payment of an additional fee?*

We would prefer a fee. The requirement for an adequately reasoned request would introduce scope for subjective consideration by the examining authority that would lead to argument, delay and disappointment.

**Q5 (c):** *Do you think the availability of an accelerated processing option under the PCT would stop applicants from filing parallel national applications in addition to their PCT applications?*

Probably in some but not all cases.

#### **6. Deferred search in the international phase**

**Q6 (a):** *What do you think about the idea of delaying the international search until after publication?*

We are opposed to this suggestion. The first ISA search should be carried out as promptly as possible and made available for 3<sup>d</sup> parties to consider with the published application. The practice of publishing the search report late should be abolished.

We realise that it might not be possible to meet the same strict time limit for supplementary and complementary collaborative searches. The results of these should be published as soon as possible after publication of the result of the first ISA search.

**Q6 (b):** *How important is it for the international search report to be available in time for international publication (i) from the point of view of third parties and (ii) from the point of view of the applicant?*

It is very important from both points of view. Third parties need as much information as possible when the application is published in order to assess its impact. As for the applicant, it would be useful to have the first ISA search report in time to consider withdrawal before publication and in any event to have the report very promptly so that the further progress of the application can be reviewed.

**Q6 (c):** *Would you make use of an option to defer search until after publication?*

We are opposed to deferred search. However, if it were to become an available option, there would inevitably be situations where it would be commercially or tactically advantageous to take advantage of it. Our members would use it where it would be disadvantageous to do otherwise.

## **7. Improved procedures for correction of errors made by the RO or the IB**

**Q7:** *Do you have any comments on the draft amendments to the Regulations in Annex 1?*

The draft amendments seem sound and should when implemented improve what is presently an unsatisfactory situation.

## **8. Accelerated processing option in the national phase for applications with a positive IPRP**

**Q8 (a):** *What do you think of the idea of introducing an accelerated processing option in the UK national phase for international applications having a positive IPRP?*

This might be acceptable, at the applicant's request, provided that the accelerated UK procedure would still involve an examination of good quality. As we do not consider the current IPER to be reliable, the UK examination procedure must not become slipshod.

In the longer term, accelerated grant on the basis of only a very limited national examination would depend upon very substantially improving the quality of the international examination, as discussed in our paper PP02/09 and in the answers above.

**Q8 (b):** *Would the option of accelerated processing in the national phase provide an incentive to get the application in order in the international phase?*

If a full and reliable examination were to be conducted in the international phase, then it should be an integral part of the system that the application proceeds to grant in the national phase very rapidly, with very limited further examination, or to immediate rejection following a negative report, subject to immediate appeal. Such a system should be attractive to many applicants.



Page 5 of 5

**Q8 (c):** *Is there any place for using fee reductions in the national phase (UK or otherwise) to provide an incentive to get a positive IPRP in the international phase?*

Fee reductions at the EPO and in all PCT member states would be an incentive to applicants to request international examination.

**9. Summary questions**

**Q9:** *Do you have any other comments on our ideas?*

Not at present, but we may have as ideas develop.

**Q10:** *Do you have any other suggestions for improving the PCT system*

We refer again to our paper PP02/09

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