



IPO COMMITTEE NEWSLETTER

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Applicant clarifies the subject matter prior to a search, it should enable the correct invention to be examined.

Identifying Amendments

Amended Rule 137, related to amendments made to the application. Currently, the applicant may amend the description, claims and drawings of his own volition in response to the European Search Report and again after receipt of the first examination report. Any further amendments are only admissible at the discretion of the Examining Division.

As a result of new Rule 137 the applicant may amend the description, claims and drawings of his own volition only in response to the European Search Report. Any further amendments (for example, in response to any communication for the Examining Division) will only be admissible at the discretion of the Examining Division. Furthermore, any amendments made to the description, claims and drawings must be identified and basis in the application as filed must be provided.

Consequently, the applicant has only one chance, as of right, to make amendments to the application. All bases for amendments must be given. If basis is not provided or if the requirement is not met, the EPO will request that the Applicant corrects this deficiency within one month. This new Rule appears to have been implemented to ensure that applications do not proceed to grant and then subsequently fall at opposition due to the presence of “added matter”. Many applications fall foul of the inescapable trap of having an unallowable amendment that cannot be removed during opposition due to broadening the scope of the granted claim if such an amendment is removed, which is unallowable. By identifying amendments as they are made during prosecution, the Applicant should be able to rest assured that any granted patent is less likely to fall on the “added matter” ground.

It will remain to be seen whether the bar will indeed be raised, or whether the new Rules will merely speed up the grant of patents, strong

and, weak. As for legal certainty for third parties, this will only come to light once all the tricks in the book, and undoubtedly some new tricks, have been used to try and circumvent the new Rules. All we can do for now is watch, wait and perhaps be creative.

SUPPLEMENTARY INTERNATIONAL SEARCH

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Introduction

On January 1, 2009, the International Bureau of the World Intellectual Property Organization (WIPO) introduced a new element into the PCT system: supplementary international search (SIS). SIS is an optional service that allows a PCT applicant to receive one or more extra searches during the international phase in addition to the usual search performed by the applicant’s International Searching Authority (ISA). New Rule 45*bis* of the Regulations under the PCT¹⁰ establishes the SIS ground rules, which, like most of PCT, are somewhat complex and require some getting used to.

SIS was born out of the failure of the PCT system to provide sufficiently thorough international searches that reveal the full extent of the relevant prior art. International search is plagued by the tendency of ISAs to focus on prior art in languages with which the ISA examiners feel competent, while overlooking art in languages with which they are not familiar. By providing applicants with the opportunity to

¹⁰ See

<http://www.wipo.int/pct/en/texts/rules/r45bis.htm>
for the text of Rule 45*bis*. For a PDF version of the complete Regulations under the PCT (as in force on January 1, 2009), see
http://www.wipo.int/export/sites/www/pct/en/texts/pdf/pct_regs.pdf.

request searches by more than one ISA, the goal of SIS is to increase the breadth of the languages being searched and thereby to produce a richer, more reliable, and more linguistically diverse means for discovering the relevant art before applicants have to make costly national/regional phase decisions.

SIS is expensive and is therefore not intended for routine use. It is, however, a tool that may prove to be both helpful and effective in prosecuting applications for commercially important inventions where significant prior art is known to exist in a language in which the main ISA lacks search capacity.

Main Features Of The SIS System

PCT applicants may request SIS from any ISA that offers it, but the ISA that carries out the main search may not also carry out the SIS. Applicants must file their requests for SIS with the International Bureau – not the receiving office or the ISA – within 19 months of the priority date, and they must pay supplementary international search and handling fees *in Swiss francs* within one month of filing the request. In light of the PCT requirement of unity of invention, if an application claims more than a single inventive concept, the supplementary authority will identify and search only one invention claimed in the application. The result of the SIS procedure will be the establishment of a supplementary international search report, which will generally issue 28 months from the priority date.

SIS is currently offered by only three ISAs: the Nordic Patent Institute (a “virtual ISA” that consists of the Danish, Icelandic, and Norwegian patent offices); the Russian Federal Service for Intellectual Property, Patents, and Trademarks; and the Swedish Patent and Registration Office. In addition to searching the PCT minimum documentation, the Nordic Institute searches documents in Danish, Icelandic, Norwegian, and Swedish; the Russian office searches documents in Russian and some other languages of the former Soviet Union or members of the Commonwealth of Independent States; and the Swedish office searches

documents in Swedish, Danish, Finnish, and Norwegian. This is admittedly a narrow list of languages for the time being, but the Austrian, European, and Finnish offices are expected to begin offering SIS within the next year or two, with other ISAs considering joining the system sometime thereafter.

Mechanics Of The System

As mentioned above, the deadline for requesting SIS is 19 months from the priority date, a deadline that is predicated on the expectation – or at least the hope – that applicants will already have the benefit of the main international search. The deadline is binding, however, even in cases where the main international search report has not yet issued. The selected ISA will usually begin to carry out SIS upon receipt of the request and a copy of the main search report from the International Bureau, but where the main search report has not yet been established, the supplementary authority will begin SIS no later than 22 months from the priority date. The ISA has a 28-month deadline for establishment of the supplementary search report in order to ensure that applicants have sufficient time to study and react to the report before they have to enter the national/regional phase.

Applicants must use a particular form (PCT/IB/375¹¹) to request SIS. The form allows applicants to specify the supplementary authority they have chosen to carry out the search and, in cases where the PCT application does not meet the requirement of unity of invention, to identify the claims relating to a single invention that the applicant wishes the authority to search. While the main ISA is generally bound to search the first claimed invention in cases of lack of unity of invention, the supplementary authority may focus on a different claimed invention if the applicant so requests. The supplementary authority is also free to disagree with the main authority’s unity

¹¹ See http://www.wipo.int/export/sites/www/pct/en/forms/ib/editable/ed_ib375.pdf for an editable PDF version of the form.

of invention finding and determine that an invention possesses unity when the main authority found that unity was lacking, or vice versa.

The current ISAs offering SIS all accept and perform searches on applications written in English. Where the language of an application is not one that the authority searches, however, an applicant seeking SIS must translate the application into a language that the authority does accept. In the same vein, if an application contains a sequence listing, the applicant must submit a copy of the sequence listing in electronic format.

ISAs carry out SIS on the basis of the claims as filed in the PCT application. Consequently, any Article 19 or Article 34 amendments that an applicant may have filed will not be taken into account for the purpose of SIS. Furthermore, if an ISA does not normally search particular subject matter in accordance with Article 17(2) of the PCT, it need not do so when carrying out supplementary searches. So if the national law of an ISA does not permit the patenting of business methods or methods of treatment of the human or animal body, the ISA may refuse to carry out SIS. Similarly, if the ISA determines that the description, claims, or drawings are so unclear as to render a meaningful search impossible, it may refuse to perform SIS just as it may decline to perform the main search.

It is up to each ISA to determine the scope of the SIS that it is willing to undertake. The ISA will usually make such a determination at the time it declares its willingness to perform SIS. An ISA may declare, for example, that for each request for SIS, it will undertake a new search of the PCT minimum documentation as well as a search of documents in other languages held by that authority. The Swedish Patent Office and the Nordic Patent Institute have both agreed to such a broad scope. An ISA may decide to carry out SIS on the basis of a more restricted scope, however. For instance, an ISA may agree only to focus on language-specific documentation held by the authority. This is the case with respect to the primary scope of search

offered by the Russian Federal Service; however, if an application relates to methods of treatment of the human or animal body and the main ISA has refused to carry out a search, the Russian Service will undertake SIS on a broader, all-inclusive scope.¹²

The fee for SIS consists of a supplementary search fee, which each ISA is free to set, and a supplementary search handling fee of 200 Swiss francs (CHF 200), which is set by WIPO. Requests for SIS may be withdrawn any time prior to the issuance of the supplementary international search report or declaration by the ISA that no report will be established, but the SIS fee will only be returned if the International Bureau has not yet transmitted the request for SIS to the ISA.

The Supplementary International Search Report

The result of SIS is the issuance by the ISA of a supplementary international search report (form PCT/SISA/501). The supplementary report resembles the main international search report, but it eliminates some elements that would be duplicative, such as the classification of the invention and the list of prior art citations included in the main report (unless the citations have a bearing on the findings of the supplementary report). The supplementary report also differs in that it is not accompanied by a written opinion, although the supplementary report may contain more detailed explanations than the main report regarding the references cited and, particularly where the supplementary authority had to carry out the SIS without the benefit of the main search report, it may include a fuller description of the scope of the search performed.

The ISA transmits copies of the supplementary international search report to the

¹² For a table outlining the requirements, fees, and scope of services offered by the three current SIS authorities, see *PCT Newsletter*, December 2008, available at http://www.wipo.int/edocs/pctndocs/en/2008/pct_news_2008_12.pdf.

applicant and the International Bureau of WIPO. In cases where an ISA does not establish the supplementary report in English (for example, where a Russian applicant requests SIS for a Russian-language application from the Russian Federal Service), the International Bureau will produce an English-language translation. It is also the responsibility of the International Bureau to send copies of the supplementary report to all designated offices once the application has entered national/regional phase and to make the report publicly available by posting it with the application file on the WIPO Patentscope® database.

Conclusion

It is far too early to judge the impact of SIS, especially since few applicants have availed themselves of the service so far. But if it serves the purpose for which it was intended, SIS should help applicants evaluate the likelihood of successfully prosecuting their applications in the national/regional phase and give designated offices greater confidence in the results of international search, thereby limiting the need to duplicate searches. The end result could be savings in time and efficiency for applicants and offices alike.

PCT-NATIONAL PHASE ENTRIES IN BRAZIL AFTER THE 30-MONTH TIME LIMIT

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Diverging from some national IP laws or Patent Office practices in other jurisdictions the Brazilian Industrial Property Law, henceforth referred to as BIPL and the rules of the Brazilian Patent and Trademark Office, henceforth referred to as BPTO do not contain time extension provisions for actions that could still be taken to avoid the loss of rights on paying a supplemental fee.

As a matter of fact, the BIPL and the BPTO rules (also known as the Normative Acts) do explicitly provide for the loss of rights or the definitive shelving of the application without right to appeal for formal deficiencies, while in other jurisdictions these deficiencies can be remedied with the reinstatement of the application on payment of a prescribed fee. By way of example, in BR such formal deficiencies entailing the definitive shelving of patent, trademark, and industrial design applications are:

(i) The Power of Attorney is not filed within 60 (sixty) days counted from the practice of the first act by the party, independently of a notification from the BPTO to the applicant or his patent attorney;

(ii) A reply is not filed to an office action within 90 (ninety) days independently of a notification from the BPTO to the applicant or his attorney also;

(iii) Non compliance with the requirements set out in an office action issued to an industrial design application, even if a timely reply was filed;

(iv) Non-payment of the final fee at grant and again, independently of a notification from the BPTO to the applicant; and

(v) National phase entry after PCT Article 22 time limit of 30 months.

It is also true that Chapter III Section 221 of the BIPL defines the legal remedy for excepting the failure to observe the respective time limits in (i), (ii), (iii), and (iv). As to (v), the failure to observe the 30-month term, at first glance, it could be inferred that Section 221 would also serve as basis for a request for the further processing of the national phase entry beyond said 30-month term but there are some limitations of legal and practical nature.