



UNION OF EUROPEAN PRACTITIONERS IN INTELLECTUAL PROPERTY
UNION EUROPÄISCHER BERATER FÜR GEISTIGES EIGENTUM
UNION DES PRATICIENS EUROPÉENS EN PROPRIÉTÉ INTELLECTUELLE

Union-IP

Comments for the 13th session PCT Working Group meeting from 05 to 08 October 2020 PCT/WG/13

Introduction

The Union Of European Practitioners In Intellectual Property (UNION-IP) is an Association of practitioners in the field of Intellectual Property, that is of individuals whose principal professional occupation is concerned with Patents, Trade Marks or Designs and related questions and who carry on their profession independently or as employees. UNION-IP is a private, free, international Association which is not dependent on any National or International Authority: it approves its own members, in accordance with its Statutes, in total independence, and likewise decides on its own activities and its own budget. It aims on the one hand to work continuously on current developments in Intellectual Property in Europe, especially by making early submissions during the preparation of proposed laws and treaties with the intention of influencing them; and on the other hand to devote itself to the improvement of professional and personal understanding between European Practitioners in the Intellectual Property field in different countries and different branches of the profession. The following comments are filed on behalf of UNION-IP.

Review of the Supplementary International Search System (PCT/WG/13/4)

Point PCT/WG/13/4 REV. (the Document) of the agenda refers to the review of the Supplementary International Search (SIS) System. The Supplementary International Search is being periodically reviewed since its introduction into the PCT regulations in 2007.

The Document shows the numbers of SIS per year, which are quite low (average of ~60 per year), and further elaborates that, considering the very low number of SIS requests per year, a new revision of the system is required, since there will be further investment in automation of procedure. Two options are therefore presented (e.g. beginning of page 5), and the Working Group is asked to decide on recommending to the Assembly the maintenance of the SIS with a new revision or its abolishment.

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Rui Gomes – Patents Commission President

www.union-ip.org

UNION OF EUROPEAN PRACTITIONERS IN INTELLECTUAL PROPERTY, AISBL (ENT. NO.0548.830.057), BOULEVARD GENERAL WAHIS 15, 1030 BRU SSELS (BE)

Email: ruigomes@jpcruz.pt
Tel.: [+351 213 475 020]
Fax:

UNION-IP c/o J. Pereira da Cruz
Rua Vitor Cordon 10A
1249-103 Lisboa, Portugal



Comments and Position of UNION-IP

The experience of Union-IP members is aligned with the numbers provided in the PCT/WG/13/4, of low to no usage of the SIS system.

The main identified hurdles are:

- a) lack of participating offices of a larger dimension,
- b) cost of the searches,
- c) lack of awareness.

a) The only IP office of a larger dimension which is participating is the EPO. European applicants typically already have the EPO as ISA.

It could be interesting to have a SIS from an office that is relevant for a specific region or likely to come up with other prior art than the EPO, in order for an applicant to have more certainty about the chances in relevant national phases. These could be US, CN, KR and JP. However, none of these offices is presently a SISA.

b) Cost of the searches could be reviewed, especially as it is typically higher than an ISA search.

c) About awareness: we feel that a notice stating when and where a SIS could be requested would increase the awareness of such an option.

It is therefore suggested the maintenance of the SIS system and its improvement, with the following revisions:

- having all the IP5 offices as SISA,
- review costs, and
- issue a standard reminder of the SIS option to the applicant/representative.

Handwritten signature of Rui Gomes in blue ink.

Rui Gomes
President of the Patents Commission

Handwritten signature of Paul Rosenich in blue ink.

Paul Rosenich
Member of the Patents Commission