



**TOGETHER**  
*for a sustainable future*

## OCCASION

This publication has been made available to the public on the occasion of the 50<sup>th</sup> anniversary of the United Nations Industrial Development Organisation.



**TOGETHER**  
*for a sustainable future*

## DISCLAIMER

This document has been produced without formal United Nations editing. The designations employed and the presentation of the material in this document do not imply the expression of any opinion whatsoever on the part of the Secretariat of the United Nations Industrial Development Organization (UNIDO) concerning the legal status of any country, territory, city or area or of its authorities, or concerning the delimitation of its frontiers or boundaries, or its economic system or degree of development. Designations such as “developed”, “industrialized” and “developing” are intended for statistical convenience and do not necessarily express a judgment about the stage reached by a particular country or area in the development process. Mention of firm names or commercial products does not constitute an endorsement by UNIDO.

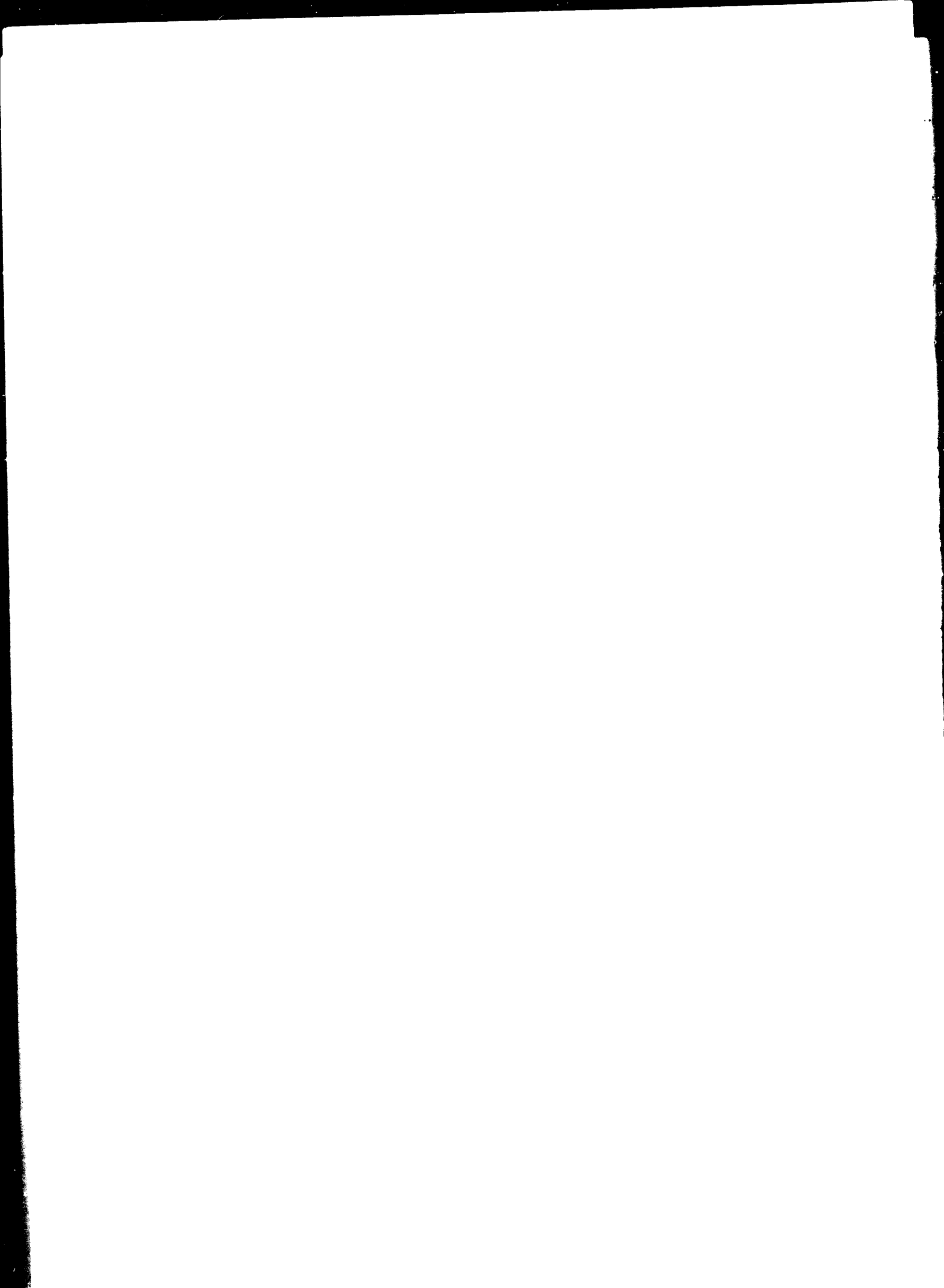
## FAIR USE POLICY

Any part of this publication may be quoted and referenced for educational and research purposes without additional permission from UNIDO. However, those who make use of quoting and referencing this publication are requested to follow the Fair Use Policy of giving due credit to UNIDO.

## CONTACT

Please contact [publications@unido.org](mailto:publications@unido.org) for further information concerning UNIDO publications.

For more information about UNIDO, please visit us at [www.unido.org](http://www.unido.org)



DO 1716

## The BIRPI Plan for a Patent Co-operation Treaty\*

The United International Bureaux for the Protection of Intellectual Property (BIRPI) Plan, also called the Patent Co-operation Treaty (PCT) Plan, originated as the result of a unanimous resolution adopted by the Executive Committee of the Paris Union in September 1966 following a proposal of the United States Government.

### Reasons for the Plan

The conditions leading to this proposal and consequent resolution were several, the main one being that the international patent system was plagued by the constant duplication of work for applicants and patent offices. For the same inventions, applicants have to file separate applications in each of the countries where they wish to obtain protection. These applications must be in the language of the country, and almost every country uses a different form with a different approach to the description of the invention and the wording of the claims. The patent offices work on these different but analogous patent applications for the same invention in almost complete isolation from each other. This system is cumbersome and costly for inventors and industry and has caused unacceptable backlogs in the work of many patent offices.

Another reason for the proposal was the situation in countries where patent applications are not examined as to substance and where patents are merely registered in conformity with the application. This system is causing mounting concern, because in many cases unexamined patents constitute unjustified monopolies or means of intimidation, to be annulled or reduced only after lengthy and costly actions in court.

This system is totally unacceptable to many developing countries, most of which have a non-examining system. Whereas in developed countries the chances of granting worthless patents are diminished by the expertise of the patent attorneys or agents assisting the applicant and by the expertise of the courts, these safeguards are missing, to a large extent, in many developing countries. Thus the need for examination is greater in developing countries, but because of the scarcity of technically trained persons and of adequate documentation and because of the high cost of examination, such countries are less in a position to introduce an examining system—even if they join efforts on a regional basis—than are developed countries.

For these reasons, many countries felt it necessary to try to internationalize, to a certain extent, the examination of patent applications and to make the system available to countries which, in the foreseeable future, would not be able to set up even a limited examination system of their own.

A solution was proposed in the form of a draft treaty. In October 1967 it was submitted to a Committee of Governmental Experts from 25 countries, assisted by observers from many intergovernmental and non-governmental organizations. Although on the whole the Plan elicited a positive response, it became evident from the discussion that several substantial points would have to be modified and that other points would require further studies. As these studies have not been completed nor the modifications made, the Plan is in a somewhat fluid stage.

\* This article was prepared by the United International Bureaux for the Protection of Intellectual Property (BIRPI).

## Principal features

The following is a summary of the principal features of the Plan as it was submitted to the Committee in October.

The participating states would agree that an applicant who now may file many different national patent applications for the same invention would file only one international application, in one language (translation, if necessary, to follow later), with a designation of the states in which he wished this application to have effect.

This international application would be checked to see that it complied with the formal requirements stipulated in the Treaty. It would then be forwarded to a searching authority which would make a search report.

In view of the evident impossibility of concentrating all applications with one searching authority, this work would be distributed among existing national patent offices willing and able to co-operate and the International Patent Institute in The Hague. These offices would have to follow identical methods and examine the same material in order to make their search reports. The search reports would cite the so-called prior art, that is, publications which should be considered when an opinion is to be formed on the question of whether the invention claimed is new and involves an inventive step. No such opinion, however, would be given by the searching authority: it would limit itself to giving the background necessary to evaluate the claimed invention. Thus, for each invention claimed, there would be only one search report, based on internationally accepted criteria.

Once the search report was completed, it would be sent to the applicant who could then adapt his policy to it. If the subject of his application was clearly not new, he would probably drop his application and save money and further effort. If he wished to amend his claims, he could do so within a certain period. If, on the other hand, the search report seemed to confirm the novelty of his invention, he would pursue his application further in the designated countries.

Unless the applicant withdrew his application, it would be communicated, together with the search report, to all the designated states and would be published internationally within a certain period (18 to 24 months). This international application would be recognized in each designated state as being equal to a national application. It would probably be wise to stop there and to leave the subsequent fate of the application to the national legislations of the designated states and to the activities of the applicant.

A second part of the draft treaty contains further procedure with respect to what is called a certificate of patentability, but which also may be called a certificate of examination. The certificate would be a document—again to be established, according to common criteria, by one of the co-operating offices—stating that the claimed invention had been examined as to novelty, inventiveness and applicability to industry, and giving the results of this examination. This certificate would be used only in the states designated by the applicant which recognized and accepted its validity.

After examination of the claimed invention by the examining authority, an international certificate would be issued or denied. Following notification of intention to deny, there would be a possibility of having the application reviewed by an international review board chosen from a panel. The issuance or denial of an international certificate would not impinge on national sovereignty. National patent offices would in no case be bound by the issuance or denial of a certificate; if they thought it necessary or desirable, they could review the examination or completely re-examine the application.

## Benefits of the Plan

The BIRPI Plan offers a clear and simple solution to the patenting problems of the developing countries. A United Nations Secretariat report (UN document E/4319, 27 March 1967) contains a statement that "the Governments of most developing countries thus find themselves caught in a dilemma between the dangers of a distorted patent system and the practical difficulty, if not impossibility, of marshalling the broad range of highly qualified technicians and scientific source materials which would be needed to permit an adequate novelty search".

Under the BIRPI Plan, the developing countries would not need the personnel and materials to make a novelty search because the results of that search and of the examination would be procured by the International Bureaux from the searching and examining authorities. Moreover, the patent systems of developing countries would not be distorted because applications accompanied by international certificates of patentability would guarantee a high degree of reliability to their patent grants. In fact, their patents generally would be as justified, reliable and binding as those of the developed countries with the most sophisticated corps of patent examiners.

The BIRPI Plan would thus protect developing countries from unjustified monopoly restrictions. Furthermore, their own inventors and industrialists would receive patents on which they could rely and which would not crumble when attacked by foreign competitors. The transfer of technology to developing countries would be encouraged because these countries could offer meaningful protection to foreign entrepreneurs owning patented technology.

It was known from the start that the formulation and application of the new international patent plan would encounter formidable problems. This was confirmed in the discussions of the intergovernmental committee of experts in October. The most important problem is the organization of the international search and examination in such a way that the quality will be high and uniform, regardless of which office carries out these activities. It is clear that the administration of the operation should be as simple as possible and that the plan should interfere as little as possible with the existing national laws.

Further studies of these and other problem areas will have to be made, and the draft treaty will have to be revised. To accomplish these tasks, several working groups and another Committee of Governmental Experts will be convened in 1968.



9 . 6 . 71