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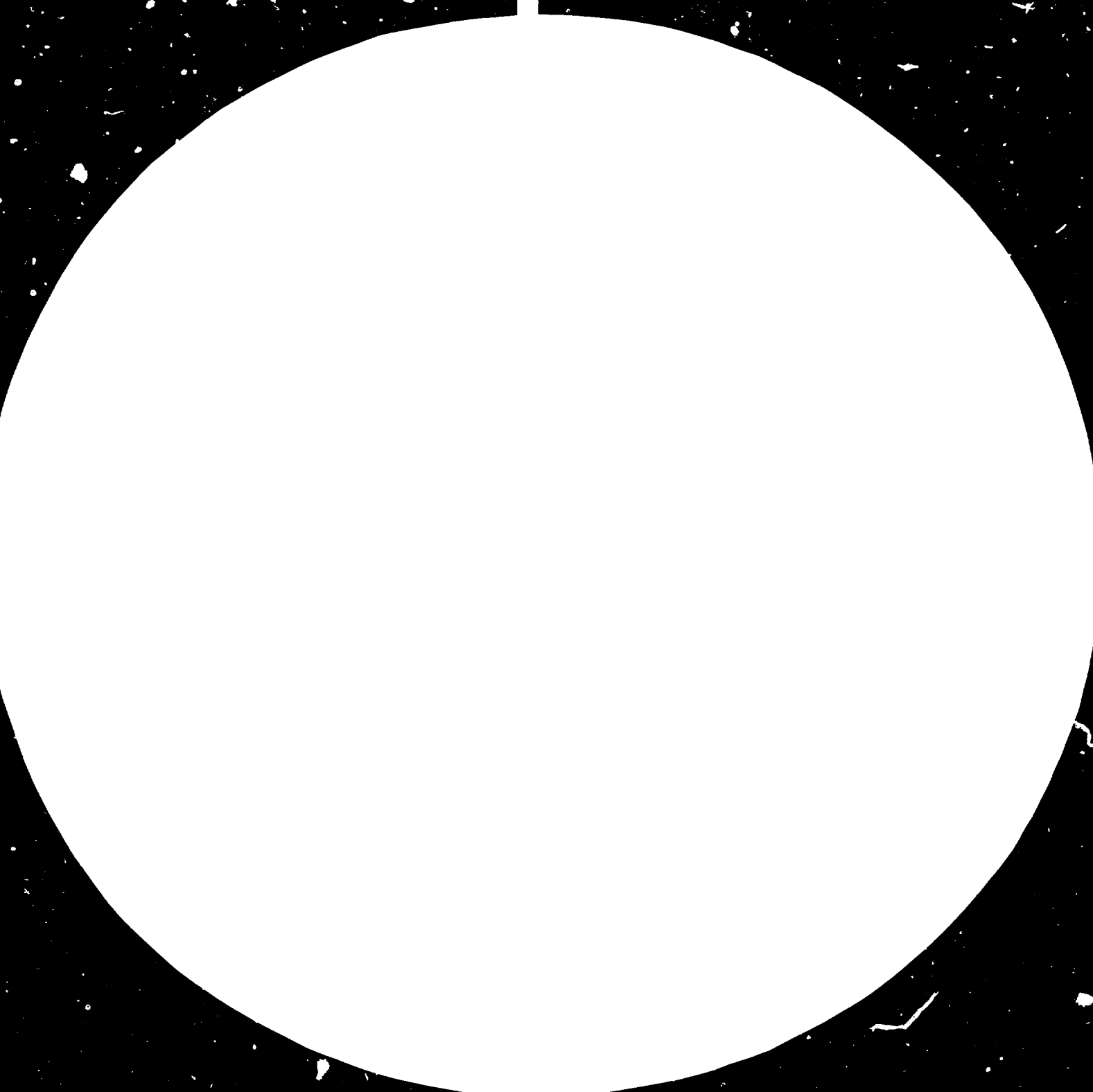

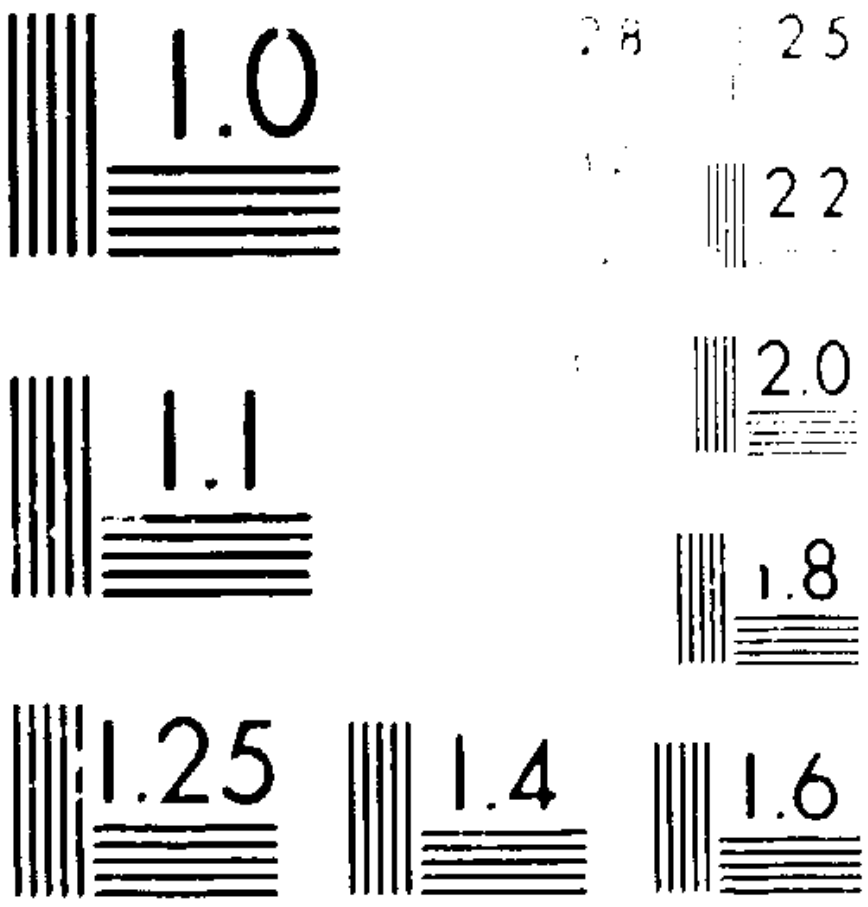
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PATENT EXAMINATION IN DEVELOPING COUNTRIES —

Paper prepared by the World Intellectual Property Organization (WIPO) at the request of the Executive Director of UNIDO

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Background

1. The laws of most countries provide for the granting of patents for inventions. Inventions are new, industrially applicable, solutions to technological problems. A patent gives its owner the exclusive right for a limited time to exploit the invention in the country granting the patent; he may himself use the patent in manufacture, or may license others to do so. The exclusive right is subject to limitations in the public interest particularly if the patented invention is not used, for patents are intended to encourage industrial activity. The granted patent is a document which discloses to the public the technological specification of the invention; most laws require that this disclosure must be sufficient to enable a person with the relevant background knowledge to work the invention.

2. The validity of a granted patent can be challenged in the courts, principally on the grounds that the technological solution was already known, was not truly inventive, or was not sufficiently disclosed. Such litigation can be long and expensive: if there seems to be a large risk of being challenged, patent owners and patent licensees are discouraged from investing money, time and effort in new industrial applications.

3. Thorough examination of patent applications diminishes the risk to the patentee that his patent may be successfully challenged in the courts, and diminishes also the risk to the public that patents may be granted for technical solutions which are not new, inventive or sufficiently disclosed. Therefore the Governments of many countries subject patent applications to a rigorous procedure designed to check, so far as possible, that they conform to the requirements of the law.

The Problem

4. Thorough examination of patent applications is expensive. In most countries which practise it, the cost of the operations of the Government's Patent Office is covered by the fees paid by applicants at various stages of the procedure and subsequently by patentees to maintain their patents in force until the statutory date of expiry.

5. But even when the financial cost is covered by fees from industry, the Government must still devote important human and technical resources if the examination is to be thorough. Professionally qualified staff are needed, trained in the different fields of technology and alert to new developments; they must have at their disposal a world-wide collection of technological literature (patent documents, technical periodicals, etc.), organized and classified for search purposes and constantly kept up to date. One hundred trained examiners and fifteen million documents can be reasonably regarded as minimum requirements to ensure a consistently high standard of examination.

6. The legal rights in particular patents exist only in the country or countries granting them. If patent rights are applied for, for the same invention, in more than one country, and the same process of examination is carried out by each of them, there is repetition which is expensive and wasteful.

Solutions

7. Two extreme solutions, while theoretically possible, should be discarded at the outset as politically and technically impracticable in the foreseeable future. One such solution is that a single international authority should carry out examination of all patent applications on behalf of all States. The other such solution is that, through a massive effort of international co-operation in training, in building national infrastructure and in providing equipment and documents, all States should become able to give a rigorous examination at least to patent applications made to their own authorities.

8. The first extreme solution, the establishment of a single international authority for patent examination, would not be acceptable to countries, including developing countries, which already have or are actively planning to have their own examination facilities, nationally or in regional groups. Such countries place a high value on the contribution made by the patent system and the patent office, with its highly qualified staff, to national or regional economic interests. The second extreme solution, equipping all States for patent examination, would require a major readjustment of priorities in the allocation of national and international resources for development.

9. Between the two extremes, solutions can be found through a flexible approach enabling countries or groups of countries to have the benefit of international co-operation in accordance with their own priority needs, including the need to build or strengthen their own legal and administrative infrastructure in this field. Considerable progress has already been made in such an approach within the World Intellectual Property Organization (WIPO), and, for the reasons explained below, can be expected to accelerate from 1980.

10. WIPO is the specialized agency of the United Nations system which promotes and serves intergovernmental co-operation in the field of patents. It administers intergovernmental treaties in this field, in particular the Paris Convention for the Protection of Industrial Property and the Patent Co-operation Treaty. It has a substantial programme of development co-operation activities, supervised in this field by an intergovernmental committee, open to all Member States, the WIPO Permanent Committee for Development Co-operation Related to Industrial Property.

11. A Diplomatic Conference for the revision of the Paris Convention will be held in February and March, 1980, primarily for the purpose of introducing changes and new provisions for the benefit of developing countries. Among the new provisions proposed as a result of five years of preparatory work at the intergovernmental level are two draft articles directly relevant to developing countries' problems in patent examination. One draft article would provide for a new treaty obligation for the furnishing by Member States of information concerning the examination of "corresponding" applications for patents for the same inventions in different countries. The other draft article referred to would, for the first time, formally require the Member States, acting together, to contribute to the development of developing countries by means of industrial property, with particular emphasis on, among other things, the modernization of industrial property laws and their administration and on the best use of patent documentation.

12. The adoption of these proposals by the Diplomatic Conference in 1980, the ratification of the revised Paris Convention by developing and developed Member States, and accession to it by additional States, can be expected to stimulate the acceleration of progress in solving the practical problems of patent examination in developing countries.

13. But a highly efficient method of joint intergovernmental co-operation for the examination of patent applications is already in force within the framework of the Patent Co-operation Treaty (PCT) which entered into force in 1978. It now has 25 Member States, including eleven developing countries, out of a total of 88 Member States of the Paris Convention. Within a few years, the number of the Member States is expected to grow considerably. The PCT provides for patent applications to be subjected to novelty searches and patentability examination by well-equipped patent offices acting as international authorities, and for the resulting technical reports to be communicated to the countries for which the patent applications are made, and which themselves decide whether or not patents should be granted under their laws. The procedure can be applied even when the application is limited to one Member State. Already in the first year of operations under the PCT, over 1,700 patent applications were processed by the Member States, the international searching and examining authorities and the Secretariat of WIPO, which acts as a channel of information and a record office, and publishes the applications.

14. The number of applications under the PCT, and the number of Member States, continue to grow. The PCT can be expected to make an increasingly important contribution to the patent examination problem of developing countries.

15. The WIPO Permanent Committee for Development Co-operation Related to Industrial Property has been invited by the Governing Bodies of WIPO to concentrate attention, at its next session in April 1980, on problems of patent examination and means to assist developing countries in solving them. The reason for this concentration of attention now is that an increasing number of developing countries, in all regions, are planning or carrying out, with the assistance of WIPO, the modernization of their industrial property laws and administration. In this process the Governments concerned are finding themselves confronted by the problem of patent examination. The means of co-operation already available to them under the programme supervised by the Permanent Committee include training, by means of fellowships, seminars and workshops, advice and assistance (including model laws and regulations) in legislative drafting and administrative systems, a service providing, free of charge, reports on the state of the art relating to specific technological

problems or solutions, and arrangements for the provision of patent documents from other countries. Also available to them are the services of the International Patent Documentation Centre (INPADOC), operated by the Government of Austria in accordance with a formal agreement with WIPO. INPADOC maintains a constantly up-dated computer file of bibliographic data relating to nearly all the published patent documents of the world and micro-film copies of the documents themselves; its services based on this file and these copies simplify and make less expensive access to patent documents.

16. It is to be expected that, as a result of consideration of this matter by the WIPO Permanent Committee for Development Co-operation Related to Industrial Property, new initiatives will be taken in intergovernmental co-operation to provide developing countries with the assistance and services they may request in the examination of patent applications. It is certain that additional resources will be needed. But it does not appear likely, at this stage, that consideration of the practical problems in depth will lead to proposals for the establishment of new international institutions in addition to, or in substitution for, what already exists in the framework of WIPO, and what already exists, or is being planned or strengthened, at the national and regional levels.

Conclusions

In summary:

(i) the mechanisms for solving the problems confronting developing countries in the field of patent examination exist in the framework of the World Intellectual Property Organization (WIPO) and are already used by several of them;

(ii) what is needed is to facilitate the access of the developing countries not yet using these mechanisms through strengthening them;

(iii) WIPO is very actively engaged in facilitating the access of the developing countries to the existing mechanisms and in constantly improving such mechanisms.