



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

Resolution of the Executive Committee, Rome, Italy, May 1960

“Reform of the examination procedure in the United States”

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, assembled at its Executive Committee held in Rome, Italy, May 1960, ratified the following Resolution passed at its Rome Congress, from 2 to 7 May 1960:

Considering that the invention prior examination procedure practised by the United States comprises a number of very precise rules for the formulation of claims, the observance of which by foreign Patent Agents is a source of serious difficulty, misunderstanding and high expense which very often discourage patent applicants;

That matters would be simplified between the American examiner and the foreign applicant if application of these rules was not insisted upon during the first phase of examination, devoted solely to discussing priorities discovered by the examiner and determining the patentable characteristics of the invention, the claims being put into regulation form only after basic agreement between the two parties;

Considering that the necessity for attaching materially the oath of the inventor to the text of the filed documents very often prevents a foreign inventor from entrusting preparation of the specification and claims to an American specialist, owing to the short time generally available before expiration of the Union-stipulated time limit, so that specification and claims have to be prepared abroad, to the detriment of their quality and the effectiveness of the work of the American examiners;

Passed the resolution:

- 1) That the obligation to make claims in regulation form should be deferred until agreement has been reached between the examiner and the applicant as to the new, patentable characteristics of the inventions;
- 2) That the oath may be filed as a separate document, if necessary within a certain time after filing the application, so as to permit a foreign inventor to entrust the preparation of the specification and claims to an American specialist.