

June 15, 2011

Mr. Francis Gurry  
Director General  
World Intellectual Property Organization  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

**RE: Comments on “Development of a request for indication for licensing purposes in PCT applications” (WIPO Circular C. PCT 1305)**

Dear Mr. Director General:

These comments are submitted on behalf of the American Intellectual Property Law Association (“AIPLA”) to the World Intellectual Property Organization concerning the “Development of a request for indication for licensing purposes in PCT applications.”

AIPLA is a national bar association whose approximately 16,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of trademark, copyright, patent, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA applauds the International Bureau for proposing a new PCT licensing feature as described in Circular C. PCT 1305. AIPLA believes the feature could be of special benefit to business entities in developing countries and to start-up enterprises in all countries, and it wishes to express its full support for the proposal. In particular, AIPLA believes that the ability of third parties to access the licensing feature on the PATENTSCOPE database and to structure licensing searches on the basis of IPC class and/or key words in the description or abstract is especially helpful. AIPLA also wishes to make the following comments:

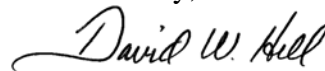
1. Although it is appropriate to indicate availability for licensing as part of the bibliographic information published on PATENTSCOPE, the fact that an invention is available for licensing will not be known to the public until the application is published. As PCT applications may be published early at the request of applicants, it would be helpful if the International Bureau made clear that applicants who wish to take early advantage of the licensing feature can request early publication of their applications, and that such early publication would include the indication of availability for licensing.

In that regard, we suggest consideration be given to including such a reminder on proposed new form PCT/IB/382 or, perhaps, even including a request for early publication as a part of that form.

2. The Circular proposes that the laws of some Member States “have set certain incentives in relation to licensing agreements,” and it urges those Member States “to extend such benefits to [the] request for indication of availability for licensing purposes.” It is not clear how such extension of benefits would work in practice, and it would therefore be beneficial if the International Bureau could provide clarification. For example, would the indication of availability for licensing purposes automatically apply in the national phase of the Designated Offices, or would applicants be required to take additional steps in order have it continue to apply?
3. Under the International Bureau’s proposal, availability for licensing will be indicated during the international phase, while the application is still pending. While license agreements are entered into with respect to pending applications, often times licensing arrangements are finalized after the patents issue. The inclusion in PATENTSCOPE of thorough and complete national phase data is therefore crucial to the success of the International Bureau’s proposal because it will permit third parties to track whether applications available for licensing are being pursued in the national or regional patent rights phases. AIPLA therefore requests that the International Bureau encourage those countries that have not yet made their national phase data available on PATENTSCOPE to do so as rapidly as possible.

AIPLA appreciates the opportunity to provide these comments and thanks you in advance for your consideration of our views.

Sincerely,



David W. Hill  
AIPLA President