

Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

Twenty-Ninth Session
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PCT ONLINE SERVICES

Document prepared by the International Bureau

SUMMARY

1. The online services delivered by the International Bureau to support the operation of the PCT are functioning well and offer the opportunity for applicants and Offices to use and administer the system effectively. Recent development has focused primarily on delivery of changes required to support Rule changes (notably the implementation of WIPO Standard ST.26 for sequence listings) and the consolidation and modernization of underlying services.
2. Future priorities include increasing the use of XML for search reports, written opinions and application bodies; optimizing services and interfaces for national Offices, particularly in their roles as International Authorities; and completing services to allow secure and efficient delivery of communications from Offices to applicants in order to phase out the use of paper and email as delivery mechanisms.

SEARCH COPIES

3. The eSearchCopy system now provides all search copies where the International Searching Authority is not the same Office as the receiving Office. Search copies are, on average, delivered 9.8 days after the receipt of the record copy: 8.8 days where no translation is required to be provided by the applicant for international search or 21.7 days where a translation is required and is received from the applicant for forwarding to the ISA as part of the search copy. The International Bureau is working on its own internal procedures to eliminate delays due to record copy processing issues and also with receiving Offices to further improve the performance concerning processing of search fee information and translations.

4. The implementation of the eSearchCopy system has recently been improved to provide search copies via ePCT M2M services, in addition to the legacy PCT-EDI batch delivery. This enables Authorities to obtain the latest documents and data available from the International Bureau from the moment the search copy is available, including checking in real time for new documents as required, for example, at the moment the examiner begins work on the application.

SEARCH REPORTS AND WRITTEN OPINIONS

5. Over 85 per cent of international search reports and almost as many written opinions are now received in XML format from nine International Authorities. Other Authorities are working towards this goal. Four International Authorities are using ePCT to prepare the reports.

6. It has taken many years of effort to reach the point where these reports are delivered with the data in a sufficiently consistent, high quality format to be used effectively. Delivering the best XML requires a new approach from both developers and examiners to ensure that the data is entered in such a way as to properly encode the meaning, rather than relying on display factors to convey meaning in ways that may be lost either through rendering in a different format or following translation. The International Bureau thanks the International Authorities for the work put into developing the necessary systems at individual Offices, as well as in providing feedback to the International Bureau to make the ePCT interfaces more efficient. It is hoped that future developments in report creation systems at Offices further improve the capture of meaning in a consistent manner. The results permit a significant improvement in the efficiency of official translations and the delivery of on-demand machine translation into any of the 10 PCT languages of publication through PATENTSCOPE.

7. The International Bureau hopes that the remaining International Authorities can move to delivery of XML reports in the near future.

8. The existing standards for XML search reports and written opinions permit a good degree of data reuse between processing stages in the international phase. However, given the low use of Chapter II, this is of limited value. Moreover, attempts to optimize the interfaces for preparing the reports has highlighted certain points where closely related data would need to be entered twice due to slight variations in requirements. As part of the China National Intellectual Property Administration's Proposal to Promote the Improvement of the International Search Report and the Written Opinion (document PCT/MIA/29/7), consideration could be given as to whether rationalization of the requirements of Forms PCT/ISA/203, 206, 210, 220 and 237, and PCT/IPEA/408 and 409 would be likely to deliver benefits commensurate with the effort that would be required. Such an effort should consider the consistency of the requirements between these forms (noting the different definitions of relevant prior art for Form PCT/ISA/210 compared to that for the other forms) and the extent to which their contents are easily imported to begin national phase examination, as well as for better exchange of national phase processing information.

9. Though not all data is yet available, the International Bureau is identifying the requirements for a database to be populated with information from these other reports (such as third party observations). Such a database would aim to support further added value services, including real-time "characteristics of international search reports" analysis and assisted preparation of lists of relevant prior art and background art required in some national phases (such as the United States "information disclosure statements").

EPCT SERVICES FOR INTERNATIONAL AUTHORITIES

10. As noted above, the International Bureau provides online services for International Authorities, notably including arrangements for receipt of eSearchCopies and other documents (including subsequently filed documents submitted by applicants through ePCT for the International Authority); preparing international search reports, written opinions and

international preliminary reports on patentability in XML format; task allocation; and production of administrative forms. This allows a complete service to be managed, provided that all staff concerned have WIPO Accounts, set up with the appropriate access rights.

11. Several International Authorities are working with the International Bureau to make the interface for creation of reports more efficient in the hope that this will assist in allowing all Authorities to move to the delivery of reports in XML format, including any subsequent corrected versions. The improvements include both the entry, manipulation and validation of data manually on-screen and support for improved import of citation information from examiners' search tools.

ELIMINATING PAPER COMMUNICATIONS

12. Since early in the COVID-19 pandemic, the International Bureau has ceased to send communications on paper, moving instead to email communication. In parallel, ePCT users have for many years been able to be notified of the availability of documents in the ePCT system and securely download them from there. Such a service can also be automated using web services and a few test users have set up automatic links to their patent management systems, ensuring that documents are downloaded immediately and data and addresses are checked and synchronized.

13. With effect from January 1, 2022, Circular C. PCT 1631 promulgated modifications to the PCT Administrative Instructions (notably Sections 102 and 709) allowing for such services to be offered as an official means of communication of documents to the applicant, entirely replacing paper and email, provided that this is requested by the applicant. Work is ongoing on systems in order to make such services practical and reliable for official delivery of documents via ePCT from both the International Bureau and from national Offices in their capacity as receiving Offices or International Authorities.

14. Some International Authorities have been working to ensure that all documents to be delivered to applicants are available through ePCT, ready for when the service is available. Notably, the European Patent Office now delivers copies of almost all citations (excluding only a few for which they do not have the necessary licence to supply copies to the applicant) to ePCT, where they are held securely, without being made available to the general public through PATENTSCOPE.

FULL TEXT PROCESSING

15. The International Bureau continues to support the move towards full text processing of applications. From July 1, 2022, sequence listings must be in the XML-based WIPO Standard ST.26 format. Moving on, an XML-based format should be used for the application body at all stages. The aim is that:

(a) applicants should be able to submit full text formats of their application bodies in the international application as filed and for any corrections, rectifications and amendments and see immediately how this will be presented in the published application, or as amendments annexed to an international preliminary report on patentability (Chapter II); and

(b) designated Offices and third parties should see full text versions of the application showing all accepted corrections, rectifications and amendments clearly marked up to distinguish between original and modified content, similar to the "Replacement sheet" markings of the current system, but at the level of paragraphs and drawings, rather than pages.

16. While some national Offices have been processing applications in WIPO Standard ST.36 format for many years (or, more recently, ST.96), based on a variety of systems that allow applicants to create the necessary application bodies, the International Bureau believes that support for the extraction of data from uploaded DOCX files will provide the most effective solution for applicants. A variety of technical issues and applicant concerns remain to be addressed before this is universally accepted and fully effective. WIPO Standard ST.36 (and any system that will be used by Offices to create typeset publications, rather than merely reproducing the images of sheets filed) allows only a small subset of the formatting options available in a word processor. However, applicants continue to be concerned that differences in formatting (as well as the potential for actual errors in conversion) may affect the assessment of the content deemed to be present on the international filing date. As such, it may be appropriate to revise PCT Rule 11 to reflect the needs of XML processing, emphasizing aspects of content, rather than appearance (such as requiring the use of Unicode-compliant fonts and emphasizing that specific fonts, colors and sizes may not be included and will not be taken into account).

17. To allow effective processing throughout the international and national phases, it is very important that conversions are consistent. For example, an application filed to one Office as receiving Office and amendments considered by a second Office as International Preliminary Examining Authority should result in directly comparable results. As a result, the processing system could effectively identify real changes in the substantive content between the two versions without the confusion of highlighting differences that are a product of the different conversion tools.

18. The same should also apply to comparison of applications with priority documents. As such, it would be highly desirable to agree a new standard for priority documents that could contain not only PDF images of applications filed, but original content in DOCX or XML format. This would be particularly important for priority documents containing sequence listings, where visual comparison of the content of earlier and later applications based on a PDF view will usually be almost impossible. The DAS system and other electronic priority document exchange systems currently accept only PDF format for priority documents, but the services can be adapted if a suitable business benefit is identified. For this, it would be important that the new standard was effective to allow fully automated processing of priority documents equally from any source with a full understanding of the status of different files if multiple versions were included (such as XML and rendered images), and including options for additional material such as XML bibliographic and citation data.

NEXT STEPS

19. These issues will be further developed in documents for the PCT Working Group. Comments are invited on any priorities that should be taken into account in the further development of online services, and especially on particular aspects of full text processing that affect the current or future processes of international search and preliminary examination.

20. The Meeting is invited to comment on the issues set out in this document.

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