

WIPO



PCT/WG/1/8
ORIGINAL: English
DATE: May 15, 2008

E

WORLD INTELLECTUAL PROPERTY ORGANIZATION
GENEVA

INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)

PATENT COOPERATION TREATY (PCT)
WORKING GROUP

First Session
Geneva, May 26 to 30, 2008

TRANSMITTAL OF THE INTERNATIONAL APPLICATION,
TRANSLATIONS AND RELATED DOCUMENTS

Document prepared by the International Bureau

SUMMARY

1. The Working Group is invited to note plans by the International Bureau to offer a service whereby the receiving Office would be able (with the agreement of the International Bureau and the International Searching Authority) to transmit the search copy and other documents necessary for international search to the International Searching Authority in electronic form via the International Bureau, using the receiving Office's existing communication link to the International Bureau, for example, via the Electronic Data Interchange (EDI) system. Additionally, the International Bureau plans to offer International Searching Authorities access to the full text of international applications captured using optical character recognition (OCR).

BACKGROUND

Transmission of Documents

2. At present, the receiving Office transmits the record copy and any translation required for publication to the International Bureau in accordance with PCT Rule 22 and separately transmits the search copy and any translation required for international search to the International Searching Authority in accordance with Rule 23. The system was set up on the

assumption that each Office with a role in the PCT system would require a separate physical copy of the international application to be posted to it as quickly as possible, along with any necessary supporting documentation. Using only paper copies, this can only be achieved without undue delays if all the copies are distributed by the receiving Office.

3. At present, around 85% of record copies of international applications are received by the International Bureau from the receiving Office in electronic form; this covers international applications originally filed in electronic form, as well as applications filed on paper and scanned by the receiving Office. The remainder are converted into electronic form by way of scanning by the International Bureau. Normally, in either case, the international application is available in electronic form within 1 working day of receipt by the International Bureau.

4. However, very few search copies are sent by the receiving Office to the International Searching Authority in electronic form (except in the case where the receiving Office is the same Office as the International Searching Authority and the transmission is between different parts of the same Office, rather than to different Offices). This results in significant extra mailing costs for receiving Offices and, unless expensive overnight courier services are used, avoidable delays in receipt of the search copy by the International Searching Authority. Furthermore, the search copy will often need to be scanned by the International Searching Authority even though it might originally have been filed in electronic form, or else already scanned by the receiving Office or the International Bureau.

Diagram of current arrangements: Case 1 – paper transmission of search copy

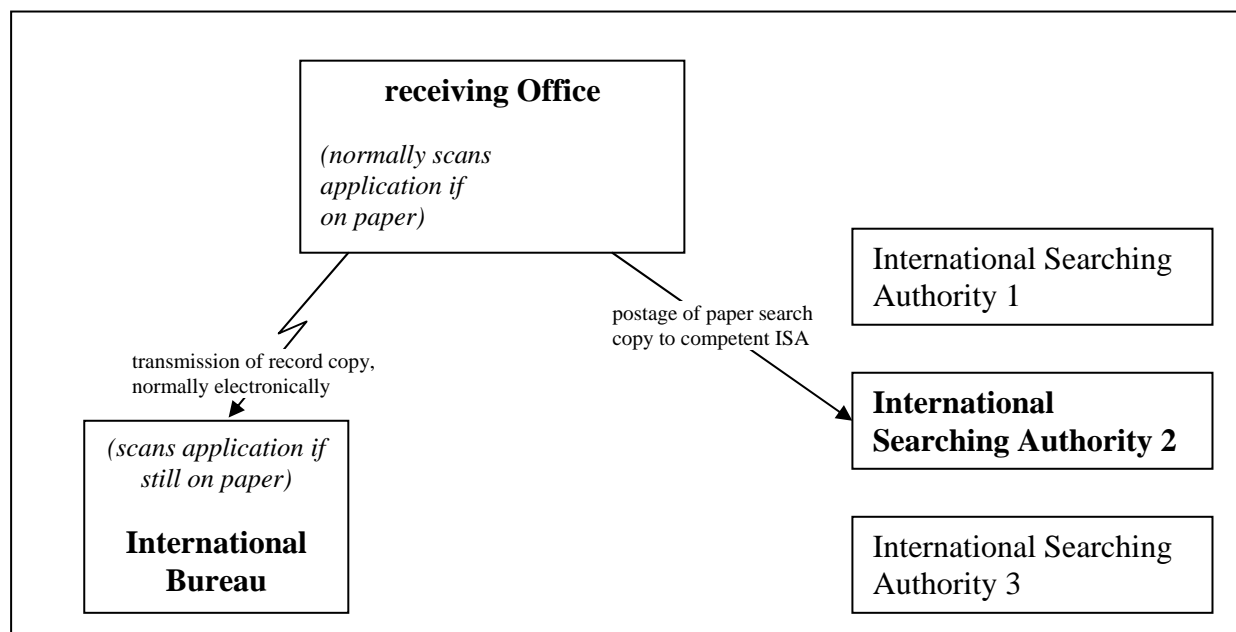
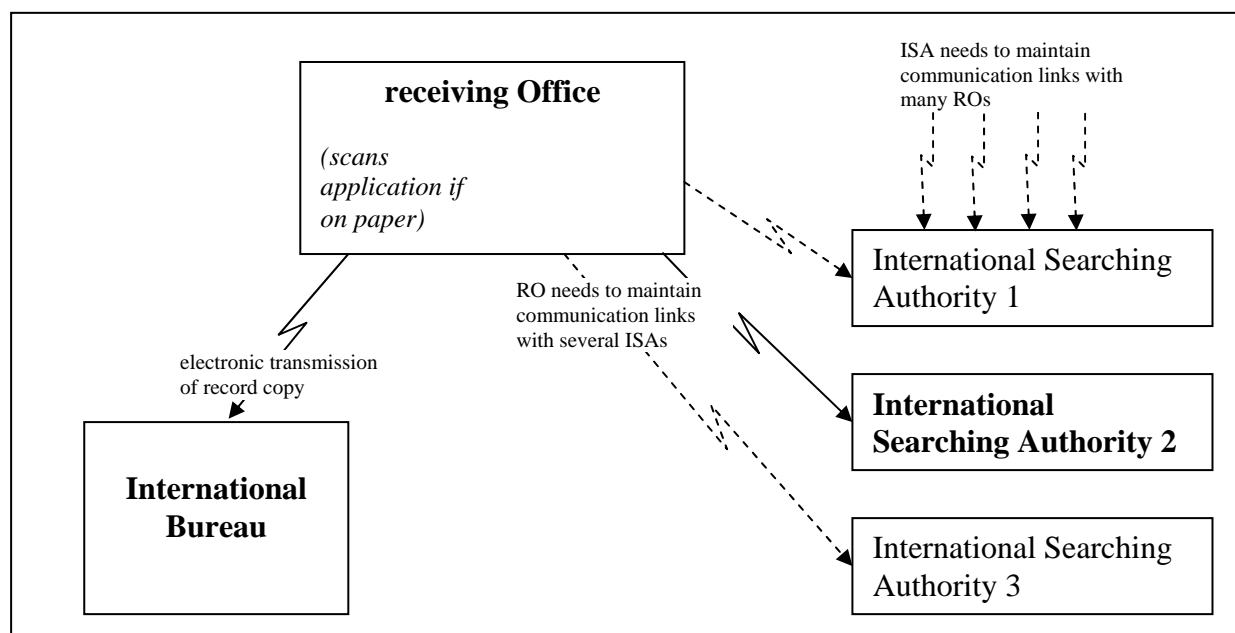


Diagram of current arrangements: Case 2 – electronic transmission of search copy

5. At its 15th session, held April 7 to 9, 2008, in Vienna, Austria, the Meeting of International Authorities (PCT/MIA) discussed the problem of international applications published without classification. It noted that a significant part of this problem was due to the International Searching Authority not receiving the search copy in sufficient time prior to the international publication date to be able to classify the international application in time. The Meeting agreed that means should be sought of providing search copies to International Searching Authorities in electronic form at an earlier stage (see paragraph 70(i) of document PCT/MIA/15/13).

6. One of the issues in delivering search copies in electronic form is the significant time and effort involved in setting up and reliably maintaining a link between two Offices suitable for the secure communication of international applications which have not yet been published: Offices use a wide variety of communications protocols, which need to be carefully tested whenever either party makes any changes. Since most receiving Offices permit applicants to choose from more than one competent International Searching Authority, transmitting search copies electronically will require more than one such communication link to be maintained, in addition to the communication link which is required with the International Bureau. As well as the cost of maintenance, this limits the speed with which any individual Office can implement changes to systems without risking cutting off communications with one or more of its partner Offices.

7. The International Bureau has already set up electronic communication links with a large proportion of PCT Offices, including all of those which act as International Searching Authorities, and is committed to maintaining them for communication of documents to and from receiving Offices and designated Offices. The same systems are ready for communications with International Authorities, even though these communication links are currently used for a much smaller proportion of documents than is the case for communications with those Offices in their other capacities. In particular, all but 3 of the

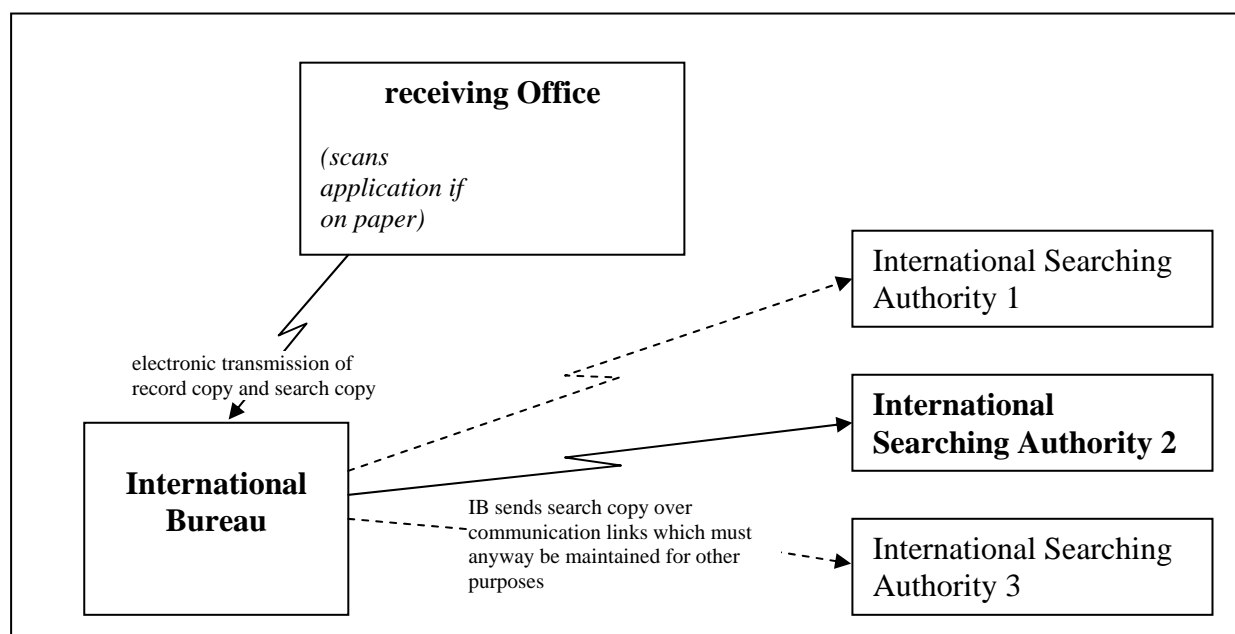
Offices acting as International Authorities have accounts on the EDI system, which is presently used for a large majority of PCT electronic data exchange.

FORWARDING OF SEARCH COPY AND RELATED DOCUMENTS USING INTERNATIONAL BUREAU SYSTEMS

8. The International Bureau intends to offer an optional service whereby the receiving Office can (with the agreement of the International Bureau and the International Searching Authority) transmit the search copy and other documents necessary for international search to the International Searching Authority in electronic form via the International Bureau, using the receiving Office's existing communication link to the International Bureau via the EDI system. This would allow more timely delivery of search copies and elimination of mailing costs, without the associated expense of maintaining individual secure communication links with every International Searching Authority which is competent for the particular receiving Office.

9. The exact technical details of how this system will operate have yet to be finalized. However, it is hoped to begin a trial arrangement shortly involving certain receiving Offices uploading a package containing the search copy and related documents using EDI in a manner such that it is automatically transmitted to the International Searching Authority. This would require no changes to the legal framework since the International Bureau would be acting simply as a direct equivalent to the postal service.

Diagram of proposed optional service



10. Following a successful trial, the service would be offered to any pairs of receiving Offices and competent International Searching Authorities wishing to use such an arrangement. However, to assist in development, the Working Group is invited to comment on whether many Offices are likely to find such a system beneficial and whether there are particular features which would be considered necessary.

11. For the longer term, consideration is being given to whether arrangements could be made which would allow the receiving Office, rather than having to transmit two copies of the international application (the record copy and the search copy), to only transmit one copy of the application (the record copy) to the International Bureau, which in turn would prepare the search copy on the basis of the record copy and transmit it to the International Searching Authority. The issues to address include the following:

(a) Although the record copy and the search copy should be identical, save for the case where a translation is provided for search under Rule 12(3), the accompanying documents are different. This is not an issue where the component documents of a package (request, originally filed application, translations for different purposes, copies of information relating to earlier searches, etc.) are fully indexed by the receiving Office and the portions relevant to the different Offices can be automatically identified, but many scanned record copies are received by the International Bureau as an unindexed block of pages, which need to be manually separated into the different documents before they could be forwarded – since the International Bureau cannot guarantee to perform this action the same day that the data is received, this would significantly reduce the speed advantage sought.

(b) If the record copies do not contain at least the minimum bibliographic information in machine readable form which is required for correct routing of the search copy, the documents could not be processed until all the data had been manually entered by the International Bureau. Again, this would significantly reduce the speed advantage sought.

(c) The search copy is often sent later than the record copy because of delays relating to receipt of the search fee or of translations required for the purpose of search. Since it is neither permitted nor desirable to delay the transmission of the record copy pending receipt of these items, it would be necessary for the receiving Office to send the confirmation of receipt of the search fee and translations as later packages and the International Bureau's systems would need to decide whether to send the various components to the International Searching Authority separately, or only when all of them had arrived and been assembled into a single package.

12. The International Bureau is also looking at whether it could provide a similar service for receiving Offices which send record copies to the International Bureau on paper. However, although paper copies are usually scanned within 1 working day from receipt by the International Bureau, the indexing of the pages and entry of the bibliographic information essential to routing only takes place at a later stage, so at present it would not be possible to guarantee the speed advantage sought by this arrangement.

ADDITIONAL RELATED SERVICES

OCR Text

13. Some International Searching Authorities have expressed a desire for full text versions of search copies of international applications in order to assist with the international search. At present, the International Bureau performs an initial “rough” OCR process of the text of the description, claims and abstract (where the international application is filed in English, French, German, Russian or Spanish, and, as of January 2009, where it is filed in Portuguese). This process is currently done in batches each weekend following the issue to the applicant of the Form confirming receipt of the record copy and the image corrections (for skew and

margin deficiencies – see paragraphs 17 to 19 of document PCT/WG/1/5) which are performed on that copy at the same time (typically 1–2 weeks after receipt of the record copy). While this OCR is performed only to assist the work of the translators at the International Bureau and is not of the quality which is published later together with the international application, it may be sufficient for the purposes of the International Searching Authority.

14. For those International Searching Authorities which agree to receive documents in this manner, it may be possible to offer these OCR texts to assist the international search. Though they would frequently not yet be available at the time that the search copy is transmitted, they would normally be available by the time that the search copy is actually received by an examiner.

Late Search Copies

15. As noted in paragraph 5, above, a significant number of international applications are currently published without classification because, by the time that the international publication is prepared, the search copy has still not been received by the International Searching Authority. Independent of any arrangement to send the search copy by a type of arrangement as proposed in this document, it is proposed to make the record copy available to International Searching Authorities by a similar arrangements so that they can provide classifications on request for international applications for which they have not yet received the search copy.

16. The Working Group is invited to comment on the value and requirements of a service to electronically route search copies using existing communication links between the International Bureau and the receiving Offices, and between the International Bureau and International Authorities.

[End of document]