

Patent Cooperation Treaty (PCT) Working Group

**Fifth Session
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AVAILABILITY OF WRITTEN OPINION BY THE INTERNATIONAL SEARCHING AUTHORITY AS OF THE DATE OF INTERNATIONAL PUBLICATION

Document prepared by the International Bureau

SUMMARY

1. The International Bureau supports the proposal by the United Kingdom to make the written opinion of the International Searching Authority publicly available from the date of international publication. However, the International Bureau considers that it may be better to make the document available on PATENTSCOPE (and related systems for national Offices, such as PADOS) as a separate item, rather than including it as part of the international publication itself, for the reasons outlined in this document. This document also considers the possible impact of the proposal by the United Kingdom on the timing of the translation of written opinions into English and related costs.

PROPOSAL BY THE UNITED KINGDOM

2. In document PCT/WG/5/10, the United Kingdom proposes the deletion of PCT Rule 44~~ter~~ and the addition of text to Rule 48.2 to require the written opinion of the International Searching Authority to be included as part of the international publication, in addition to the international search report.

3. The deletion of PCT Rule 44~~ter~~ in isolation can be implemented quickly and without any significant cost, simply by changing the document type code definitions within the International Bureau's systems to make the written opinion of the International Searching Authority visible as long as the relevant international application had been published. Once this had been done, there would be no additional manual processing required on individual international

applications. The document would automatically become available to the public through PATENTSCOPE. It would also be available to Offices for automated retrieval through PATENTSCOPE Web Services or PADOS.

4. On the other hand, the amendment to Rule 48.2 as proposed by the United Kingdom would result in more significant changes to the International Bureau's IT systems used to prepare the international publication, which would take longer to prepare and test. Moreover, the creation of the international publication would require a small amount of additional manual processing work on each international application, which would have a noticeable cumulative ongoing cost (estimated at around 200,000 Swiss francs each year) since it would apply to all international applications which are not withdrawn before international publication.

5. As such, the Working Group should consider whether the public interest would be sufficiently well met by the availability of the written opinion on PATENTSCOPE without specifically including it as part of the international publication.

CONSIDERATIONS RELATING TO TRANSLATION

6. The proposal by the United Kingdom does not include an amendment of Rule 48.3 to require the translation, for the purposes of international publication, of the written opinion into English. Nevertheless, given the potential for comparison with the international search report (which is included as part of the international publication, accompanied by a translation into English), it is worth clarifying, on the one hand, what the effect of the proposal by the United Kingdom would be and what, on the other hand, the effect would be if Rule 48.3 were amended to require the translation, for the purposes of international publication, of the written opinion of the International Searching Authority.

7. According to the proposal by the United Kingdom, the translation of the written opinion would continue to occur, in most cases, at the end of the international phase in relation to the international preliminary report on patentability (Chapter I of the PCT). The exceptions would continue to be that:

(i) any designated Office may request an immediate translation of the written opinion of the International Searching Authority (or alternatively, a Chapter II report if one has been established) if the international application enters the national phase early (Rules 44*bis*.2(b), 44*bis*.3(d), 72.2*bis* and 73.2(b)); and

(ii) where international preliminary examination is demanded, no Chapter I report is established and the Chapter II report is translated instead (Rules 44*bis*.1(a) and 72.1).

8. Changing this arrangement to provide a translation into English at an earlier point in time would be extremely costly. In effect, there would be a one-off cost of translating 1 year's worth of written opinions established in languages other than English in addition to those which were already being done, in order to bring the availability of translations forwards from 30 months from the priority date to 18 months from the priority date. This would amount to around 13 million Swiss francs. It would require around 3 years of transitional arrangements in order to allow the International Bureau to commission and monitor the number of additional translations necessary to bring the date of availability forwards without severely risking the quality of the translations.

9. In addition, there would be recurring additional costs of at least 1 million Swiss francs each year from a variety of sources. The most significant factor would be that two reports would need to be translated for international applications where international preliminary examination was demanded, despite the fact that only the later one would be of real significance to designated Offices.

10. Other factors, while smaller, might still be of significant cost depending on the details of the implementation, such as:

(i) Assuming that the written opinions and their translations formed part of the international publication, rather than being made available separately through PATENTSCOPE, as suggested above, there would be a very large increase in republications. This is because a significant number of international search reports and written opinions are presently received by the International Bureau in the last few weeks before publication, when there may still be time to prepare a translation of the international search report for inclusion in the “main” international publication, but it would be impossible to prepare a translation of the written opinion, which is generally significantly longer and more complex, containing more “free text”.

(ii) The continuing large rate of increase in international applications in languages other than English means that increased volumes of translations to be prepared by the International Bureau would be required earlier. Also, with less time between international filing and the time by when the translation would be due and thus less time to confirm the volumes of translation which will be required from different languages into English, it will be more difficult and expensive to manage contracts with outsourcing companies, as well as the numbers and skills of staff needed to ensure the quality of the outsourced work.

11. There is also a strong risk that bringing translation forward to be ready by the time of international publication would reduce the quality of translation, since the International Bureau would not wish to forward copies of unpublished international applications to contractors working on the translation of the written opinion, reducing their ability to check the context of the opinion's content.

12. Consequently, the International Bureau considers that, irrespective of whether the written opinion is included as part of the international publication or made available separately through PATENTSCOPE (as suggested above), the approach in the proposal by the United Kingdom is correct and translations should only be produced at the end of the international phase or on specific request following early national phase entry. Clearly, the benefit to third parties of such an arrangement is not as great as having translations made at the time of international publication. However, the simple availability of the written opinions will be an improvement over the information currently available and the limited additional benefit of early translation would not justify the high costs involved.

13. *The Working Group is invited:*

(i) *to consider whether written opinions should be made available on PATENTSCOPE at the time of international publication, but as a separate item, rather than being part of the international application itself;*

(ii) *to comment on the considerations relating to the timing of translations of written opinions set out in paragraphs 6 to 12, above .*

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