

Patent Cooperation Treaty (PCT) Working Group

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TOP-UP SEARCHING AND ACCELERATED PROCESSING

Document prepared by the United Kingdom

SUMMARY

1. The United Kingdom Intellectual Property Office would like to invite the Working Group to consider the following proposals:
 - (i) incorporating a top-up search into the international preliminary examination procedure; and
 - (ii) offering the option of accelerated processing in the international phase for an additional fee.

BACKGROUND

2. In 2009, the United Kingdom (UK) Intellectual Property Office (IPO) conducted a public consultation on improving the PCT system¹. The results of that consultation were presented to the Working Group at its third session in June 2010². The consultation indicated support from UK users for various initiatives, many of which have already been taken forward as part of the work to improve the functioning of the PCT system that was endorsed by the PCT Working Group in 2010, e.g. third party observations and collaborative international search and examination.

¹ See <http://www.ipo.gov.uk/consult-2009-pct.htm>.

² See document PCT/WG/3/5.

3. Two initiatives that were supported by UK users but have not yet been progressed by the Working Group are: (i) incorporating a top-up search into the international preliminary examination procedure; and (ii) offering the option of accelerated processing in the international phase.

TOP-UP SEARCH AS PART OF INTERNATIONAL PRELIMINARY EXAMINATION

4. The idea of incorporating a top-up search into the international preliminary examination (IPE) procedure was included in the PCT Roadmap³ that the International Bureau (IB) presented to the Working Group at its second session in 2009. The idea received some support amongst the Working Group but, as yet, has not been taken any further.

5. The UK's view is that it would be beneficial for International Preliminary Examining Authorities to perform a top-up search as part of the IPE procedure to uncover any prior art not available at the time of the international search, particularly "secret" prior art (i.e. documents published on or after the priority date of the international application, but having an earlier priority date). Bringing such documents to the applicant's attention in the international phase would give the applicant the opportunity to amend the application during the international phase to overcome any new prior art. This could lead to a quicker grant and cost savings for the applicant in the national phase. Performing a top-up search in the international phase could also reduce duplication of work by eliminating the need for further top-up searching in the national phase in those jurisdictions where publication occurs at 18 months from the priority date, and increasing the likelihood of the application being put in order for grant before it enters the national phase.

6. In line with Rule 64.3 of the Regulations under the PCT, any "secret" prior art found as a result of the top-up search would not be considered part of the prior art for the purposes of international preliminary examination, but would be mentioned in the international preliminary examination report in the manner set out by rule 70.10. Such documents could then be considered in the national phase of those States where they are citable as prior art.

7. We note that the USPTO already performs top-searches for international applications undergoing international preliminary examination in order to provide the most complete international stage work product. We would like to encourage other international authorities to consider whether they could adopt a similar practice (if they do not do so already).

ACCELERATED PROCESSING OPTION IN THE INTERNATIONAL PHASE

8. The idea of introducing an option for accelerated processing in the international phase was suggested by the Korean Intellectual Property Office (KIPO) in their paper "Three Track PCT System", presented at the second session of the Working Group in 2009⁴. The Working Group expressed general support for further discussions on the subject, but the idea has not been pursued any further as yet.

9. UK users have indicated they would like the PCT system to be as flexible as possible to accommodate the needs of different applicants. It follows that they are strongly in favor of the introduction of an accelerated processing option in the international phase and would be prepared to pay a fee for such a service.

³ See document PCT/WG/2/3.

⁴ The idea was suggested as part of a "three track" system encompassing accelerated, normal and deferred search options, see PCT/WG/2/11.

10. Many national offices, including the UK, offer accelerated processing services for national applications. For example, the UK IPO offers accelerated search, publication and examination. These services are free but the applicant must provide adequate reasons to justify a request for accelerated search or examination. We also offer the following specific acceleration services:

- (a) Green Channel – allows acceleration of patent applications where the invention has an environmental benefit;
- (b) PCT(UK) Fast Track – allows accelerated processing of international applications entering the UK national phase if the international application has received a positive International Preliminary Report on Patentability; and
- (c) Patent Prosecution Highway (PPH) – allows accelerated examination if the claims of the application have been found to be acceptable by JPO, USPTO or KIPO.

11. The UK IPO's accelerated services are well used by applicants and there is clearly a demand for similar accelerated options in the international phase. Although early publication may be requested under the PCT (Article 21(2)(b) and Rule 48.4), there is currently no mechanism for applicants to request acceleration of the international search or preliminary examination. The UK is therefore in favor of introducing such a mechanism under the PCT to allow applicants to request acceleration of any of international search, international publication and international preliminary examination. The timescales for the accelerated services would need to be agreed amongst the International Authorities, although we suggest that the timescales proposed by KIPO in its 2009 paper⁵ could be used as a starting point. We propose that the accelerated services should carry a fee as this would help to control the number of requests and would allow international authorities to cover any increased costs associated with offering the services.

12. In addition to the benefits for applicants, offering accelerated processing under the PCT could help to reduce national backlogs and duplication of work by removing the need for applicants to file a parallel national application in addition to a PCT application in order to obtain a quick search or a quick grant.

13. We would therefore like to encourage International Authorities to consider whether they could offer accelerated processing of international applications.

14. *The Working Group is invited to consider the proposals in this document.*

[End of document]

⁵ See paragraphs 8-10 of PCT/WG/2/11.