

Patent Cooperation Treaty (PCT) Working Group

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PCT 20/20

Document submitted by the United Kingdom and the United States of America

BACKGROUND

1. Since its inception the Patent Cooperation Treaty has proved a success with applicants and offices. To applicants, the PCT offers a way of applying for worldwide patent protection, and to offices it represents the largest international regime for sharing work. As testament to its success the PCT received over 180,000 applications in 2011; nevertheless, with WIPO reporting some 1.98 million patent applications worldwide in 2010, there would still appear great scope for improvement. Given the size and scale of the PCT, even small improvements can have a great impact and are worthy of pursuit. Additionally, fees gathered from operation of the PCT system provide a high percentage of WIPO's income and improvements to the system's operation would therefore be of benefit to all.

2. We believe improvements to the PCT could be made which would realise a system that operates more effectively for applicants, national offices and International Authorities, while giving greater certainty to third parties. Through enabling better streamlining and control of costs we might hope to increase applications under the PCT.

SUMMARY

3. To realise this vision we believe improvements could be made in the following areas:

QUALITY & TRANSPARENCY

4. Further improving the quality, both real and perceived, of work done by International Authorities and increasing transparency helps to ensure that duplication does not take place at later stages by national offices.

SIMPLIFICATION

5. The PCT was drawn up in a time when modern information communication technologies were in their infancy. Current technology allows for the simplification of many administrative actions under the PCT, for the benefits of applicants, Offices and the International Bureau.

RANGE OF WORK PRODUCTS

6. While the current work products produced by International Authorities are of great benefit to national offices and applicants, by offering further and more comprehensive work products, duplication by national Offices may be further reduced.

7. We hope that this vision is compelling. The PCT 20/20¹ proposals are set forth below in summary form. While it could be of great benefit to implement these multilaterally, some changes may be more appropriately realised first on a smaller scale, even unilaterally, before gaining more widespread adoption.

PROPOSALS

8. The following proposals constitute possible steps that could be taken to improve the PCT system.

(A) SELF-SERVICE CHANGES (92BIS/PRIORITY CLAIMS) – Applicants could make corrections to bibliographic data and priority claims that would be effective immediately, providing instant feedback of the approval to the applicant.

(B) LIMITED CHAPTER I CLAIM AMENDMENTS – Permitting limited claim amendments, such as correcting misnumbered claims, prior to drawing up of the search report would be helpful to both the ISA and applicant.

(C) SIMPLIFY WITHDRAWAL OF INTERNATIONAL APPLICATIONS – Requirements for withdrawing PCT applications, such as obtaining signatures from all applicants, would be eased in at least certain situations.

(D) STANDARDIZING FEE REDUCTIONS FOR NATIONAL STAGE APPLICATIONS – National and regional Offices would offer a national stage fee reduction for national phase applications which contain only claims which were indicated as meeting the criteria of PCT Article 33 (2)–(4).

¹ 20/20 is a reference both to the year 2020 as an implementation goal, as well as to clarity of vision.

(E) INTERNATIONAL SMALL/MICRO ENTITY FEE (OR DISCOUNT) – A small entity fee would permit small businesses and independent inventors in all countries to obtain worldwide patent protection at lower cost through use of the PCT system.

(F) INTEGRATE NATIONAL/INTERNATIONAL PHASES, USE A NATIONAL FIRST ACTION ON THE MERITS FOR PCT SEARCH REPORT, REQUIRE RESPONSE TO NEGATIVE COMMENTS AT THE NATIONAL PHASE – Under this proposal, a search report and written opinion prepared by an ISA would constitute both the PCT report and a national Office action for that office. Additionally, national/regional Offices would be encouraged to require, at the time of national phase entry, a complete response to any outstanding negative indications made by the ISA/IPEA.

(G) MANDATORY RECORDATION OF SEARCH STRATEGY – To provide confidence in the quality of PCT searches, examiners would record their search strategy and make such information available to other offices.

(H) COLLABORATIVE SEARCHING (2 + OFFICES), ELIMINATE SUPPLEMENTARY INTERNATIONAL SEARCH – Examiners from multiple offices would collaborate to create a single search report. Such a report would generally be of greater quality than a report prepared by a single examiner and would be more useful upon in the national phase than current reports.

(I) MANDATORY TOP-UP SEARCHES – In order to increase the quality of PCT Reports, examiners would perform top-up searches to uncover recent documents.

(J) DEVELOPMENT AND IMPLEMENTATION OF THE GLOBAL DOSSIER AND INCORPORATION OF SAID SYSTEM INTO THE PCT – Applicants would file a single application, and thereafter the movement and duplication of documents would be minimized or even eliminated by the creation of a “one-stop” portal for all stakeholders.

(K) FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT, FAST TRACK OF NATIONAL PHASE APPLICATIONS, IMPROVE REUSE OF PCT WORK AT THE NATIONAL PHASE – A PPH type system would be formally integrated into the PCT. Offices would fast track national phase applications which presented only claims which received a positive report.

(L) MAKING THE WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY AVAILABLE TO THE PUBLIC AFTER INTERNATIONAL PUBLICATION – To enable national offices and third parties to view the content of the written opinion of the ISA before an application enters the national phase, the written opinion would become available upon international publication.

9. The above proposals are discussed in greater detail in the document PCT 20/20 which is attached hereto as an Annex.

10. *The Working Group is invited to consider the proposals contained in the Annex to this document.*

[Annex follows]

PCT 20/2020

1. The Regulations and procedures under the Patent Cooperation Treaty (PCT) have undergone a number of modifications during the recent past. During the early 2000s, “PCT Reform” resulted in the first major changes to the PCT in 15 years. More recently, the World Intellectual Property Organization (WIPO) developed a “Roadmap for the Development of the Future PCT” which proposed additional modifications to the system. Many of the proposals in the Road Map have been implemented, and some are still under consideration. However, further modifications could be made to improve the quality of search and examination, to improve the efficiency of filing and processing of PCT applications and to reduce application costs, both in the national and international phases. The following proposals are offered with these goals in mind.

A. SELF-SERVICE CHANGES (92BIS/PRIORITY CLAIMS)

2. Under Rule 92*bis*, changes to the person, name, residence or address of an applicant, agent or inventor must be by way of request to the Receiving Office (RO) or the International Bureau (IB). An RO will request the IB to record any change it receives and approves. The current procedure typically results in a substantial delay between the date applicants file the request and the date the change is recorded by the IB. Complicating Rule 92*bis* corrections is the fact that authorities are not uniform with respect to the need for a power of attorney in effecting 92*bis* changes. This leads to applicant confusion, forum shopping, and in some cases conflicting decisions (where an applicant submits the request to both the RO and IB). Processing of priority claim corrections is also subject to delay, which may result in a WOISA not accurately reflecting the relevant date for prior art purposes. The aforementioned problems may be minimized through the provision of an online self-service feature whereby applicants, after verification, could make certain corrections that would be effective immediately, providing instant feedback of the approval to the applicant (similar to the USPTO ePetition feature). A self-service feature would eliminate delay and errors that occur through processing of written requests and would make the process more efficient for both applicants and authorities.

B. LIMITED CHAPTER I CLAIM AMENDMENTS

3. Occasionally, claims containing inadvertent errors are filed in international applications. These errors include: misnumbered claims, obviously incorrect claim dependencies, multiple claim sets, etc. The PCT does not currently provide an adequate mechanism to allow applicants to correct such errors. In addition, such errors present handling problems for the ISA and often result in an ISA work product that does not cover the full scope of the invention intended by the applicant. Accordingly, permitting limited claim amendments in certain instances prior to drawing up of the search report by the ISA would be helpful to both the ISA and applicants. It is possible that such “amendments” could be specifically provided for in PCT Rule 91.

² 20/20 is a reference both to the year 2020 as an implementation goal, as well as to clarity of vision.

C. SIMPLIFY WITHDRAWAL OF INTERNATIONAL APPLICATIONS

4. Applicants frequently attempt to withdraw international applications after filing for a variety of reasons, e.g., the application was inadvertently electronically submitted twice, the wrong application parts were uploaded electronically, an application was filed to preserve a Paris Convention priority period prior to confirmation from the client, etc. To effect withdrawal of the application, PCT Rule 90.5 requires that all applicants sign the withdrawal (either directly or through an agent to whom a power of attorney is of record). Obtaining signatures from all applicants in sufficient time to obtain a refund of previously paid costly international and search fees is difficult, particularly in cases having a number of applicant-inventors. To help such applicants, the procedure for withdrawing an international application could be eased, at least in certain situations, for example, by allowing the first-named applicant to withdraw the application.

D. STANDARDIZING FEE REDUCTIONS FOR NATIONAL STAGE APPLICATIONS

5. The Patent Prosecution Highway (PPH) has shown that work sharing, or work leveraging, has tangible benefits for both Offices and applicants. However, the benefits of PPH may not be viewed as a sufficient incentive by some applicants to ensure that only claims meeting the criteria of PCT Article 33(2) to (4) are presented in the national stage. Accordingly, it is proposed that national and regional Offices be encouraged to offer a national stage fee reduction for national phase applications which are presented with only claims which were indicated as meeting the criteria of PCT Article 33 (2) to (4) by an ISA or IPEA. Such a fee reduction would, in the aggregate, be quite substantial and incentivize applicants to only present claims in their national stage applications that satisfy the PCT requirements of novelty, inventive step and industrial applicability. This would effectively reduce the cost of pursuing patent protection through the PCT by providing the benefits seen today in PPH, e.g. reduced actions per disposal, higher allowance rate, and reduced rate of appeal.

E. INTERNATIONAL SMALL/MICRO ENTITY FEE (OR DISCOUNT)

6. Economic research indicates that small entities (or businesses) are primary significant driver of job creation. Part of the growth of small entities is based upon internationalization of their business. For all innovators, patent protection can be a useful tool to protect investments. Patenting in international markets is, however, a costly endeavor. This presents a special challenge for small entities. A PCT small entity fee (or discount) would facilitate the growth of small businesses by reducing the cost of international filing and processing. A small entity fee would permit small businesses to make greater use of the PCT system. Increasing the PCT system's accessibility to small businesses would also help to build support for the PCT and patenting systems internationally. A notice of incompatibility could be provided for those offices whose national law is inconsistent with this proposal.

F. INTEGRATE NATIONAL/INTERNATIONAL PHASES, USE A NATIONAL FIRST ACTION ON THE MERITS FOR PCT SEARCH REPORT, REQUIRE RESPONSE TO NEGATIVE COMMENTS AT THE NATIONAL PHASE

7. Integration of the national and international phases would reduce duplication of work, make the international work products a more accurate predictor of national phase outcome and likely enhance the importance of (and therefore quality of) the international search and examination since it would be binding on at least the national/regional Office acting as the ISA/IPEA.

8. Integration of the national and international phases can be achieved through actual integration or effective integration. Actual integration could be implemented where the selection of an ISA is also a national phase entry in that Office. When the ISA then prepares the international search report and written opinion, it is both the international work product and a national Office action for that office. Effective integration can be implemented by encouraging the national/regional Offices to require, at the time of national phase entry, a complete response to any outstanding negative indications made by the ISA/IPEA.

9. It is further proposed that, where a national first action on the merits has been issued in a parent application or family member that the ISA adopt that as the ISR/WO where the claims are the same. This would reduce burden on the ISAs and encourage applicants to file international applications in the best form possible.

G. MANDATORY RECORDATION OF SEARCH STRATEGY

10. When performing automated searches of the prior art, examiners prepare a set of search queries to discover the most relevant prior art. The search terms and related logic used are generally preserved in the application file. In order for other offices to make use of a search performed by the international authority, it would be beneficial for the second office to have access to the search logic used by the authority. For example, an examiner in the second office would not need to repeat the search done by the first examiner. In addition, the examiner in the second office would be able to confirm that a proper search had been performed by the first examiner, thus building confidence and promoting work sharing. Accordingly, not only should it be mandatory for examiners to record search strategy, but such strategy should be made available to other offices.

H. COLLABORATIVE SEARCHING (2 + OFFICES), ELIMINATE SUPPLEMENTARY INTERNATIONAL SEARCH

11. The United States Patent and Trademark Office (USPTO), the European Patent Office (EPO) and the Korean Intellectual Property office (KIPO) have been participating in a Collaborative Search and Examination Pilot involving PCT applications. In this pilot, an examiner from one office is the principal examiner who performs a preliminary search on a PCT application. The search results are then forwarded to examiners in the other two offices (peer examiners) who review the work, supplement it if it is felt necessary, and provide their comments to the principal examiner. The principal examiner then prepares a final search report incorporating the comments of the peer examiners. While this process involves some additional work by the principal examiner, the work performed by the peer examiners is substantially less than they would normally do. Thus, examiners do less work than they normally would in 2/3 of the applications. In addition, at the end of the first phase of the pilot, participating examiners felt that the quality was so high that substantially no additional searching would be needed in the national/regional phase at least in the collaborating offices. A procedure modeled on this pilot could be formally developed in the PCT system.

12. A Supplementary International Search (SIS) system was recently instituted in the PCT system. Use of SIS has been substantially less than hoped for. In fact, as of the end of March 2012, only 119 supplemental international searches had been requested worldwide. If a Collaborative Search System is developed, it is envisaged that SIS could be curtailed.

I. MANDATORY TOP-UP SEARCHES

13. The original “Draft Roadmap for the Development of the Future PCT” included as one of its milestones the proposal that “international preliminary examination includes ‘top-up’ searches to find ‘secret prior art’ by July 2011.” While this Roadmap Milestone received significant support in both the MIA and the PCT Working Group, to date it still has not been adopted as a mandatory element of the Chapter II process. “Top-up” searches are already performed by many offices and are seen as a necessary step of examination in order to provide the most complete international stage work product. The adoption of this proposal by all authorities would increase the quality of, the confidence in, and the reusability of the Chapter II work product. As such, “top-up” searches should be made a mandatory part of the Chapter II examination process.

J. DEVELOPMENT AND IMPLEMENTATION OF THE GLOBAL DOSSIER AND INCORPORATION OF SAID SYSTEM INTO THE PCT

14. This past year the USPTO proposed the development of a Global Dossier system. This concept, similar to WIPO’s proposed ePCT system, is still in its earliest stages of development, with many of the specifics to be finalized as the system’s implementation is established. In general, under the system applicants would file a single application regardless of the number of national patents ultimately sought, and thereafter the movement and duplication of documents would be minimized or even eliminated by the creation of a “one-stop” portal for all stakeholders in the merits of a particular invention. Under the Global Dossier the applicant would be required to file the application specification once and only once. Cross-filing would be facilitated in the system. By menus, the applicant could choose countries or regions in which to cross-file under the Paris or PCT routes, or both, depending on the filing strategy. The exact timing of the cross-filing(s) could be preselected at initial filing. For example, a filer could preselect PCT to be initiated at twelve months, at which time the preselected ISA and RO would be notified electronically by the system, and the required fees would be charged and disbursed.

15. By incorporation of such a system into the PCT, the filing of applications would be greatly simplified for users. Some examples of the advantages such a system would provide are: allowing for “reference filings” in accordance with the Patent Law Treaty; and eliminating the requirements for priority documents.

K. FORMAL INTEGRATION OF THE PATENT PROSECUTION HIGHWAY INTO THE PCT, FAST TRACK OF NATIONAL PHASE APPLICATIONS, IMPROVE REUSE OF PCT WORK AT THE NATIONAL PHASE

16. As detailed in documents such as the PCT Roadmap, there has been a renewed effort to make more effective use of the PCT in order to, *inter alia*, reduce duplication of work and provide a more accurate, higher quality search and patentability opinion at the international phase. The Patent Prosecution Highway (PPH) has shown that work sharing, or work leveraging, has tangible benefits for both Offices and applicants. It is proposed to formally integrate the PPH system into the PCT. Specifically, it is proposed that, at applicant’s option, national and regional Offices be required to fast track (or make special) national phase applications which are presented with only claims which were indicated as meeting the criteria of PCT Article 33 (2)–(4) by an ISA or IPEA. This would effectively reduce the cost of pursuing patent protection through the PCT by providing the benefits seen today in PPH, e.g. reduced actions per disposal, higher allowance rate, and reduced rate of appeal.

17. In order to further reduce duplication of effort, it is proposed that the national Offices be encouraged to increase reuse of the work done at the international phase.

L. MAKING THE WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY AVAILABLE TO THE PUBLIC AFTER INTERNATIONAL PUBLICATION

18. At present, Rule 44*ter* requires the written opinion of the International Searching Authority and the international preliminary report on patentability (Chapter I) to remain confidential until 30 months from the priority date, unless the applicant has entered the national phase early before any designated Office (in which case the Office may request access to the written opinion) or unless earlier access by a designated Office (or others) is requested or authorized by the applicant. By making the written opinion available upon international publication (18 months from priority), national offices would be able to utilize the international work products in processing equivalent national applications (without consent from the applicant), reducing duplicative work. This change would promote transparency within the PCT process, as well as bring the PCT into line with many other national systems which make similar documents available upon national publication.

[End of Annex and of document]