

Patent Cooperation Treaty (PCT) Working Group

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PROPOSALS FOR FURTHER IMPROVEMENT OF PCT SERVICES AND PRODUCTS

Document submitted by the European Patent Office

SUMMARY

1. The PCT has proven to be a very successful system for the filing and processing of patent applications around the world. In spite of the many improvements to the PCT system made over the past 10 years (PCT Reform, PCT Roadmap), the system needs to be further adapted to keep track of the state of the art with respect to the new IT environment as well as to the challenges facing the global patent system such as the reduction of backlogs and the enhancement of the quality of search and preliminary examination work products for the benefit of applicants, third parties and patent Offices alike.

2. Noting that there is still room for further improvement of PCT services and products within the Treaty framework, the EPO hereby submits a set of proposals for consideration by the Working Group. Some of these proposals aim at offering new or better services and products to users, and others at making the system more efficient also for Offices.

- (1) Offer new or better services and products to users:
 - (a) Provide more services under Chapter II.
 - (b) Develop equal service level principle for PCT work.
 - (c) Improve timeliness with respect to international search reports.
 - (d) Contemplate collaborative search & examination under Chapter.

- (2) Make the system more efficient for Offices and more attractive for users:
 - (a) Transfer search fees and transmit search copies to the ISA via the IB.
 - (b) Recognise own PCT work products in the national phase.
 - (c) Extend PPH-PCT concept to PCT work products from all PCT Authorities.
 - (d) Make mandatory the reply to the WO-ISA when entering the national phase.
 - (e) Introduce quality metrics in Chapter 21 of the ISPE Guidelines.

(1) OFFERING NEW OR BETTER SERVICES AND PRODUCTS TO USERS

(A) PROVIDE MORE SERVICES UNDER CHAPTER II

3. The EPO is currently considering enhancing its level of service in Chapter II by finding relevant prior art published after the international search was conducted. This service would be performed within the scope of Art. 54(3) EPC, that is, the search would be restricted to European patent applications and PCT applications which have entered the European phase. Feedback from other IPEAs as to their own practice is welcome. The views of other Offices and users on this proposal would also be much appreciated.

(B) DEVELOP EQUAL SERVICE LEVEL PRINCIPLE FOR PCT WORK

4. This principle aims at providing PCT Authorities with a basis to improve efficiency and equal treatment of applicants irrespective of the procedure chosen (Paris or PCT route) to the benefit of both Offices and users. Differences without sound (legal) basis may exist e.g. as regards means of payment, access to information, online services, quality in search and preliminary examination work products etc. By comparing formalities and examination practices and procedures in place for national and PCT applications on the basis of the principle of equal service levels, awareness of differences will raise and measures can be taken to address them. Commitment to this principle will also contribute to enhance the attractiveness of the PCT route.

(C) IMPROVE TIMELINESS WITH RESPECT TO INTERNATIONAL SEARCH REPORTS

5. Rule 42.1 PCT currently sets a time limit of 3-months from the date of receipt of the search copy at the ISA. In general, receiving Offices transmit the search copies one month after filing and then the ISA establishes the international search reports at 16 months from the priority date, quite ahead of international publication at 18 months. Unfortunately, in the cases where the date of receipt of search copies at the EPO acting as ISA is later than 14-15 months, the international search report is established after 18 months and a new publication has to be effected by the International Bureau. However, it is commonly accepted that the establishment of the international search reports in time for publication at 18 months increases legal certainty for both applicants and the public.

6. The EPO thus suggests to improve the situation. First, receiving Offices could take further steps to process and transmit search copies as promptly as possible in order to avoid delays in the transmission of search copies. Also, ISAs could further increase internal awareness of the importance of meeting PCT time limits. The EPO also proposes to consider a change of Rule 42.1 PCT with a view to fix as an objective the establishment of the international search report on time for international publication at 18 months.

(D) CONTEMPLATE COLLABORATIVE SEARCH & EXAMINATION UNDER CHAPTER I

7. The EPO launched a pilot on collaborative search & examination in partnership with the USPTO and KIPO. A status report of phase II of the pilot is presented in a separate document PCT/WG/5/9. Results of this pilot will need to be carefully assessed to evaluate whether the proposal could be formally presented as a new PCT search product

(2) MAKE THE SYSTEM MORE EFFICIENT FOR APPLICANTS AND MORE ATTRACTIVE FOR USERS**(A) TRANSFER SEARCH FEES AND TRANSMIT SEARCH COPIES TO THE ISA VIA THE IB**

8. It is suggested to let the International Bureau act as a broker in the case of the transfer of search fees and transmission of search copies, at the option of the receiving Office and the ISA. The proposal would simplify flows at the receiving Office and especially at the ISA as there would be one major processing flow rather than as many flows as receiving Offices. The International Bureau would make savings on currency conversion under Rule 16.1 PCT. Also there could be some benefit on timeliness in the transmittal of search copies with a view to meet the goal to issue international search reports before 18 months.

9. The receiving Office would transmit the record copy to the International Bureau which would in turn prepare and transmit the search copy to the ISA on behalf of the receiving Office. The matter is already under consideration by the International Bureau (Circular C. PCT 1332). It could be envisaged to provide for a legal basis in the PCT to offer this service to Offices. A similar process could be implemented for search fees which would be transferred by the receiving Office in its currency to the International Bureau, then converted by the International Bureau into the ISA currency, and transferred to the ISA. A pilot for the transfer of search fees by the USPTO acting as receiving Office to the EPO acting as ISA via the International Bureau will be launched soon. There also it could be envisaged to provide for a legal basis in the PCT to offer this service to Offices.

(B) RECOGNISE OWN PCT WORK PRODUCTS IN THE NATIONAL PHASE

10. One essential recommendation endorsed by the PCT Working Group in 2010 was that "Offices which act as International Authorities should recognize the quality of their own work and not routinely conduct more than a "top-up" search when an international application for which they acted as International Authority enters their national phase" (paragraph 170(a), document PCT/WG/3/2, referred to in document PCT/WG/4/3, p.12).

11. The EPO believes that this principle should be given the highest priority. By recognising their own PCT work products, Offices ensure that they are at least of a similar quality as their national work products. In 2011, the 2011 Trilateral collaborative metrics study on international search reports may be used as a tool to assess the quality and thus the re-utilisation of PCT work products in the national phase. PCT work products of a higher quality may be more easily relied upon by designated Offices. No supplementary searches should be needed upon entry into the national phase before the Office that performed the international search. This policy brings savings for both the users and Offices. All in all, it also makes the PCT a more comprehensive, efficient and attractive patent system.

12. The EPO ensures that its PCT work products are of the same quality as its EPC work products. The need for a supplementary European search upon entry into the European phase is thus waived if the EPO performed the international search, and a 50% reduction on the examination fee is granted if an IPER was issued by the EPO as IPEA.

(C) EXTEND PPH-PCT CONCEPT TO PCT WORK PRODUCTS FROM ALL PCT AUTHORITIES

13. The EPO believes that all PCT work products should benefit from the acceleration scheme and other advantages provided under PPH bilateral agreements irrespective of the PCT Authority that actually established these work products. The EPO implemented a PCT-PPH pilot programme with the USPTO and the JPO since 2010. Consideration could be given in the future to extend the pilot programme to other interested PCT Authorities.

(D) MAKE MANDATORY THE REPLY TO THE WO-ISA WHEN ENTERING THE NATIONAL PHASE

14. Since April 2010, where the WO-ISA or, where applicable, the IPER or the SISR explanations was/were negative, the applicant is required to respond within a 6-month time limit to the communication issued by the EPO as designated Office. For further information with respect to this procedure, please see Notice from the EPO dated 29 June 2010 concerning communications under amended Rule 161 EPC, OJ EPO 2010, 406, and Decision by the Administrative Council dated 26 October 2010, OJ EPO 2010, 634).

15. The EPO is of the view that this procedure could be implemented by other designated Offices in order to enhance efficiency in the processing of PCT applications in the national phase. It is also in the interest of users that the basis for national phase prosecution is sound.

(E) INTRODUCE QUALITY METRICS IN CHAPTER 21 OF THE ISPE GUIDELINES

16. One essential element of the PCT is the quality of search and preliminary examination work products. At the last MIA, there was consensus that quality metrics were seen as an essential tool to implement further improvements in the quality of PCT work products (see report of the MIA in document PCT/WG/5/3). The experience gained by the EPO and other patent Offices in the last years made it possible to envisage that quality metrics be considered under Chapter 21 of the International Search and Preliminary Guidelines.

(3) PCT IS SET AS A PRIORITY AT THE EPO

17. The EPO is committed to further enhance the quality of its products and services under the PCT. To that effect, the EPO launched a series of measures with a view to improve its online services to its PCT users (RO-EP pilot project under the IT Roadmap) and to ensure the establishment of international search reports on time for international publication, in close cooperation with receiving Offices and the International Bureau. The principle of equal service level will be implemented at all levels of the procedure to ensure equal treatment of applicants under both the PCT and the EPC. In addition, consideration is given on additional measures to enhance the quality of PCT products, e.g. by introducing top-up searches in Chapter II as proposed in the present document, and to facilitate entry into the European phase.

18. *The Working Group is invited to consider the proposals set out in this document.*

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