

Patent Cooperation Treaty (PCT) Working Group

Sixth Session Geneva, May 21 to 24, 2013

DISCUSSION OF EXPANDED PCT 20/20 PROPOSALS

Proposals by the United Kingdom and the United States of America

BACKGROUND

1. At the fifth session of the PCT Working Group, held in Geneva from May 29 to June 1, 2012, the United Kingdom and the United States of America presented a joint proposal entitled "PCT 20/20", containing twelve proposals for further improvement of the PCT system (document PCT/WG/5/18). The proposals received varying levels of support by the Working Group (see the Summary by the Chair of the fifth session, document PCT/WG/5/21, paragraphs 27 to 29). However, many delegations felt that they could provide only preliminary views on the proposals and noted that more time was needed to carefully study the proposals, to consult with user groups and to consider the possible impact on respective national laws and practices. Following the discussions, the Delegations of the United Kingdom and of the United States of America agreed to further elaborate on the proposals and to provide more details on how to take the proposals forward, for discussion at the next session of the Working Group.

2. Taking into account the discussions and the comments received during the fifth session of the Working Group, the United Kingdom and the United States of America have prepared revised versions of the original proposals for further improvement of the PCT system. Those revised and expanded proposals have been communicated by the International Bureau, by way of a Circular (Circular C. PCT 1364, dated December 20, 2012, Annex I), to Offices of all PCT Contracting States in their capacity as a receiving Office, an International Searching and Preliminary Examining Authority and/or a designated and elected Office under the PCT, to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, as well as to certain organizations that are invited to attend meetings of the PCT Working Group as observers.

The Circular invited recipients to review and further comment on those revised proposals and, in particular, to consult with user groups on those proposals and to consider the possible impact of those proposals, if adopted, on respective national laws and practices.

3. The content of Annex I to Circular C. PCT 1364, containing the proposals by the United Kingdom and the United States of America, is reproduced in the Annex to this document.

DISCUSSION

4. To date, 31 responses to the Circular have been received, including comments from 24 national and regional Offices and 7 user groups.

5. Further, the expanded proposals were discussed at the Twentieth Session of the Meeting of International Authorities (MIA), held in Munich from February 6 to 8, 2013. A summary of those discussions is set forth in paragraphs 52-102 of the Annex to Document PCT/WG/6/3 (MIA report).

6. A brief discussion of each of the proposals, of the comments which were received in the responses to the Circular, and of the discussions held at the MIA follows.

SELF-SERVICE CHANGES (92BIS/PRIORITY CLAIMS)

7. The Expanded 20/20 proposals included specific proposals to provide WIPO's ePCT system with various features including, the elimination of much of the manual review and action required by IB personnel, the ability to automatically generate notices to applicants when certain changes are made, and the establishment of an Empowered eOwner user level who would have the ability to make any changes in the application, including withdrawals, without the need for any IB intervention.

8. The specific proposals received rather widespread support in the Circular responses. Further, as set forth in paragraph 101 of the MIA report, "there was particular interest and hope for fast progress in the PCT Working Group" on several items, including self-service changes.

9. Accordingly, these proposals have been referred to the International Bureau for incorporation into the ePCT system in the future as appropriate.

LIMITED CHAPTER I AMENDMENTS

10. The Expanded 20/20 proposals included specific proposals to amend Rules 20 and 91 to provide for 1) replacement of entire sets of description, claims, or drawings, and 2) for the renumbering of claims which were obviously misnumbered upon filing, respectively.

11. The responses to the Circular indicated fairly widespread support, especially for the proposal to amend Rule 90. The MIA report also indicates that the "Authorities were generally supportive of the principles behind the proposals." However, the MIA also agreed that the proposals were not ready to move forward to the Working Group at this time, and that it was important to ensure that the proper legal framework and procedures were established prior to implementation.

12. With respect to the proposal to amend Rule 20, the primary concern expressed in the responses to the Circular and at the MIA was that care must be taken to ensure that new matter was not introduced into the application. However, in this regard it must be noted that the only situations in which the provision would be allowed would be either where the applicant was incorporating subject matter already contained in the priority application or when the international filing date was being reset to the date of submission of the later filed description, claims, or drawings, and, as such, there should be no issue with respect to new matter.

SIMPLIFY WITHDRAWAL OF INTERNATIONAL APPLICATIONS

13. The Expanded 20/20 proposals included specific proposals to allow the international application to be withdrawn without the signature of the applicants in certain very restrictive situations.

14. The proposal, while receiving significant support from the user groups which responded to the Circular, received mixed support from the Member States which responded. Further, while the Authorities which commented on the proposal at the MIA were sympathetic to the desire to simplify the signature requirements in certain situations, they also expressed concerns about the appropriate safeguards being established.

15. The United Kingdom and United States intend to take all the comments and concerns into account for future discussions on the matter.

STANDARDIZING FEE REDUCTIONS FOR NATIONAL STAGE APPLICATIONS

16. The Expanded 20/20 proposals included a specific proposal to amend Rule 49 to provide a 50 per cent national phase fee reduction for 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.

17. The proposal, while receiving significant support from the user groups which responded to the Circular, received very limited support from the Member States which responded. At the MIA significant concerns were expressed with respect to the potential effect on revenues as well as with respect to the position that national phase fees should be left entirely to the purview of the national Offices.

18. The United Kingdom and United States intend to take all the comments and concerns into account for future discussions on the matter.

INTERNATIONAL SMALL/MICRO ENTITY REDUCTION

19. The Expanded 20/20 proposals included a specific proposal to provide a new Rule 16*ter* to provide a 50 per cent and 75 per cent fee reduction in the international phase for small and micro entities, respectively.

20. Again, while receiving significant support from the user groups which responded to the Circular, the proposal received very limited support from the Member States which responded. At the MIA, all of the Authorities indicated that they were sympathetic to the desire to make the system more accessible to small and medium-sized entities. However, as was the case with the responses to the Circular, the specific proposal received very limited support. The most consistent concern expressed by the Member States and the Authorities was the fact that it would be extremely difficult to find definitions and levels of reduction which would be acceptable to all Offices concerned.

21. The United Kingdom and United States intend to take all the comments and concerns into account for future discussions on the matter.

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

22. As set forth in paragraph 101 of the MIA report, “there was particular interest and hope for fast progress in the PCT Working Group” on several items, including this one. Accordingly, this 20/20 proposal is discussed in greater detail in document PCT/WG/6/16.

MANDATORY RECORDATION OF SEARCH STRATEGY

23. This 20/20 proposal is discussed in detail in document PCT/WG/6/19.

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

24. The Expanded 20/20 proposals included a more in depth discussion of what is envisioned by collaborative searching, but did not include any specific proposals for its implementation at this time.

25. The United States Patent and Trademark Office, the European Patent Office and the Korean Intellectual Property Office have been participating in a Collaborative Search and Examination Pilot involving PCT applications. The report on Phase II of the pilot is presented in document PCT/WG/6/22.

26. The United Kingdom and United States intend to take all the comments and concerns expressed by the member States, Authorities and users, as well as the results of the pilot, into account for future discussions on the matter.

MANDATORY TOP-UP SEARCHES

27. This 20/20 proposal is discussed in detail in Document PCT/WG/6/18.

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

28. The Expanded 20/20 proposals included a more in depth discussion of what is envisioned by the Global Dossier, but did not include any specific proposals for its implementation at this time.

29. In general, the member States, Authorities and users indicated that they welcomed and supported the broad concept of a Global Dossier and that they looked forward to the development of more specific plans.

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

30. As set forth in paragraph 101 of the MIA report, “there was particular interest and hope for fast progress in the PCT Working Group” on several items, including this one. Accordingly, this 20/20 proposal is discussed in greater detail in document PCT/WG/6/17.

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

31. As set forth in paragraph 101 of the MIA report, “there was particular interest and hope for fast progress in the PCT Working Group” on several items, including this one. Accordingly, this 20/20 proposal is discussed in greater detail in document PCT/WG/6/13.

32. *The Working Group is invited to comment on the proposals set out in the Annex to this document.*

[Annex follows]

EXPANDED PCT 20/20 PROPOSALS

Proposals by the United Kingdom and the United States of America

(reproduced from Circular C. PCT 1364, dated December 20, 2012, Annex I)

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

1. 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 of their identity, 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.

2. Currently, WIPO is developing its ePCT online private file inspection and management system. As currently being implemented, the system would provide for two levels of users, eOwners and eEditors, who would be able to perform certain functions online through the ePCT system. Such actions will initially include withdrawal of the international application, correction of priority claims and changes to persons, names and addresses under Rule 92*bis*, with further actions becoming available in subsequent releases of the ePCT system. However, as planned, the actions would only be effective following manual review and action by IB personnel.

3. It is proposed that the IB establish the ePCT system so that certain functions, when performed by the eOwner, become effective when performed without further review. Such functions would include correction of priority claims and corrections to names and addresses under Rule 92*bis*. Further, with regard to the addition or deletion of applicants under Rule 92*bis*, we would propose that the ePCT system be developed such that when such a change is requested by the eOwner, the system would automatically send out the notices to all of the applicants notifying them of the requested change which are currently sent out manually by the IB in accordance with processing under Section 422*bis* of the Administrative Instructions.

4. Finally, it is proposed that the ePCT system be modified to provide for a user which would have the highest level of authority, an Empowered eOwner, for whom powers of attorney had been filed by all of the applicants. Such a user would have the ability to make any changes in the application, including withdrawals, without the need for any IB intervention.

(B) LIMITED CHAPTER I AMENDMENTS

5. As originally presented, this proposal called for allowing amendments to be made to claims during Chapter I in certain situations, e.g., misnumbered claims, obviously incorrect claim dependencies, multiple claim sets, etc. 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 by correcting errors which present handling problems for the ISA and often result in an ISA work product that does not cover the scope of the invention intended by the applicant.

6. After further consideration, it is now proposed to limit the types of errors that may be corrected through Chapter I amendment to (a) those directed to obviously misnumbered claims (i.e., applications containing multiple claims having the same number or claims which are not consecutively numbered) and (b) those directed to multiple claim sets (i.e., applications where the submission of an entire set of claims under Rule 20.3(b) results in the application containing more than one set of claims). Additionally, the proposal has been further modified with regard to the latter type of error, so as to also provide for amendment of the application in situations where a submission under Rule 20 also results in multiple descriptions and/or multiple sets of drawings.

7. With regard to obviously misnumbered claims, it is hereby proposed that Rule 91 be amended to provide that in those situations where there are multiple claims having the same number or claims which are not consecutively numbered, the claims may be renumbered provided that (i) the renumbering does not affect any of the claim dependencies or (ii) it is obvious to the competent authority, where the rectification requires the renumbering of any claim dependencies, that nothing else could have been intended other than the proposed renumbering, and further provided that the request for renumbering is submitted to the ISA prior to the date upon which it has begun to draw up the International Search Report.

8. It is also proposed that Rule 20 be amended to allow applicants to correct situations where an application contains, as the result of a submission under Rule 20.3(b) of an entire element and/or a submission under Rule 20.5(b), (c), or (d) of an entire set of drawings, multiple elements or multiple sets of drawings. Specifically, it is proposed that a new Rule 20.6bis be provided whereby, at the time of submission of an entire element(s) or set of drawings under Rule 20, applicant could request that the earlier submitted entire element(s) or entire set of drawings be replaced by the later submitted entire element(s) or entire set of drawings. Such a provision would prevent needless processing on the part of the RO and the ISA, and would prevent confusion on the part of third parties at the time of publication by only publishing the description, claims, and drawings which applicant intends to pursue.

9. Therefore, it is proposed that Rules 20 and 91 be amended as below.

Rule 20 International Filing Date

Rule 20.6bis Replacement of an Entire Item Set Forth in Article 3(2)

Where a subsequent submission by the applicant would result in the international application containing multiple versions of an item set forth in Article 3(2), or in the case of the claims or drawings, multiple sets of the item, the applicant may include with such submission a request to replace, in its entirety, the previously submitted item or entire set of the item with the version of that item or entire set of the item included in the subsequent submission with the effect that the replaced item or entire set of the item shall be considered not to have been included in the international application.

Rule 91 Rectification of Obvious Mistakes in the International Application and Other Documents

Rule 91.1bis Renumbering of Claims

If the application contains multiple claims having the same number or claims which are not consecutively numbered, the applicant may request rectification of the numbering of the claims if:

(i) the renumbering does not affect any of the claim dependencies; or

(ii) in the situation where the rectification requires the renumbering of any claim dependencies, it is obvious to the competent authority that nothing else could have been intended than the proposed renumbering.

Rule 91.2 Requests for Rectification

(a) Subject to paragraph (b), Aa request for rectification under Rules 91.1 – 91.1bis shall be submitted to the competent authority within 26 months from the priority date. It shall specify the mistake to be rectified and the proposed rectification, and may, at the option of the applicant, contain a brief explanation. Rule 26.4 shall apply *mutatis mutandis* as to the manner in which the proposed rectification shall be indicated.

(b) Any request for rectification under Rule 91.1bis must be submitted to the International Searching Authority prior to the date upon which it has begun to draw up the International Search Report.

(C) SIMPLIFY WITHDRAWAL OF INTERNATIONAL APPLICATIONS

10. 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.

11. Specifically, it is proposed that the application be allowed to be withdrawn by the agent who filed the application within a very strict time limit, e.g., within one (1) week of the international filing date without the signature of the applicants. Additionally, we would propose that the application could be withdrawn by any of the applicants or by any agent of record without obtaining the signatures of all applicants provided that the notice of withdrawal includes a self-certification statement whereby the person signing the notice certifies that he has the authority to act on behalf of all of the applicants.

12. As a further option, it is proposed that Rule 90*bis*.5 could be amended to provide a verification mechanism similar to that provided with respect to changes in the person of the applicant in Section 422*bis* of the Administrative Instructions, as below:

Rule 90*bis*.5 *Signature*

(a) Any notice of withdrawal referred to in Rules 90*bis*.1 to 90*bis*.4 shall, subject to paragraphs (b) and (c), be signed by the applicant or, if there are two or more applicants, by all of them. An applicant who is considered to be the common representative under Rule 90.2(b) shall, subject to paragraph (b) and (c), not be entitled to sign such a notice on behalf of the other applicants.

(b) An application may be withdrawn without the signatures of all of the applicants if a notice of withdrawal is filed by the person(s) who signed the request within one (1) week of the receipt date of the initial application papers.

(c) Except as provided in paragraph (b), if a notice of withdrawal is filed without the signatures of all applicants, the withdrawal shall be effective provided that:

(i) it is signed by one of the applicants or the agent who filed the application,

(ii) the request contains an address in accordance with Rule 4.4(c) which would allow the International Bureau to individually contact and notify each applicant of the filing of the notice of withdrawal, and

(iii) none of the applicants objects in writing to the withdrawal within one month from the date of such a notification under (ii).

(D) STANDARDIZING FEE REDUCTIONS FOR NATIONAL STAGE APPLICATIONS

13. 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)-(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)–(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. A notice of incompatibility would be provided for those offices whose national law is inconsistent with this proposal.

14. Specifically, it is proposed to amend Rule 49.1 by including new paragraphs (d) and (e) as below:

49.1 Notification

(a) - (c) No change

(d) The amount of the national fee provided in accordance with paragraph (a)(ii) shall be subject to a reduction of at least 50% for an application which contains or is amended to contain, prior to the start of national phase processing, only claims which sufficiently correspond to claims which were indicated as meeting the criteria of PCT Article 33 (2)–(4) in the Written Opinion of the International Searching Authority or the International Preliminary Examination Report.

(e) If, on [...], paragraph (d) is not compatible with the national law applied by the designated Office, the paragraph shall not apply in respect of that Office for as long as it continues not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [...]. The information received shall be promptly published by the International Bureau in the Gazette.

(E) INTERNATIONAL SMALL/MICRO ENTITY REDUCTION

15. Economic research indicates that small and micro entities (or businesses) can be a significant driver of job creation. Part of the growth of small and micro 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 and micro entities. A reduction in PCT fees for all small and micro entity applicants worldwide would facilitate the growth of small businesses by reducing the cost of international filing and processing. A small/micro entity reduction would permit small businesses worldwide to make greater use of the PCT system, and increasing the PCT system's accessibility to small businesses would also help to build support for the PCT and patenting systems worldwide. As with proposal (D), a notice of incompatibility would be provided for those offices whose national law is inconsistent with this proposal.

16. It is understood that arriving at an agreed upon definition of what constitutes a small or a micro entity may be difficult. However, the benefits for applicants worldwide that would be achieved by providing such reductions would be substantial and well worth the effort that it would take to come to such an agreement. Therefore, it is proposed that the Rules be amended to include new Rule 16~~ter~~ which would provide that all international stage fees be reduced (a) by an amount of 50% for any applicant which meets the to be determined definition of a small entity and (b) by an amount of 75% for any applicant which meets the to be determined definition of a micro entity.

Rule 16~~ter~~ Small/Micro Entity Fee Reduction

Rule 16~~ter~~.1 Amount of Reduction

(a) Any fee payable to a receiving Office, an International Searching Authority, an International Preliminary Examining Authority, or the International Bureau shall be subject to a reduction in the amount of:

(i) 50% for any applicant who has established themselves as a small entity in accordance with the Administrative Instructions;

(ii) 75% for any applicant who has established themselves as a micro entity in accordance with the Administrative Instructions.

(b) If, on [...], paragraph (a) is not compatible with the national law applied by the Office or Authority concerned, the paragraph shall not apply in respect of that Office or Authority for as long as it continues not to be compatible with that law, provided that the said Office or Authority informs the International Bureau accordingly by [...]. The information received shall be promptly published by the International Bureau in the Gazette.

(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

17. Integration of the national and international phases would reduce duplication of work, make the international work product 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.

18. As originally set forth, this proposal envisioned three types of integration of the national and international phases.

- 1) Selection of an ISA would also be deemed a national phase entry in that Office, whereby the international search report and written opinion would constitute both the international work product and a national office action for that office.
- 2) Requiring, at the time of national phase entry, a complete response to any outstanding negative indications made by the ISA/IPEA.
- 3) Where a national first action on the merits has been issued by the ISA in its capacity as a national office in a parent application or family member, that the ISA adopt that as the ISR/WO where the claims are the same, thus reducing the burden on the ISAs and encouraging applicants to file international applications in the best form possible.

19. It is understood that full implementation of these proposals would be one of the longer term goals of the 20/20 Plan due to the fact that they would require significant changes to national practices and laws, and further that there may be some legal impediments within the PCT itself. However, it is believed that the benefits that would be achieved would be significant and are thus worth pursuing. Some options that should be considered are:

- Amending Rules 43, 43*bis* and 51*bis* to provide for the implementation of items 2 and 3 above. Such provisions would necessarily also include a notice of incompatibility for those offices whose national law is inconsistent with this proposal.
- Provide that any ISA that adopts items 1 or 3 above would waive its national search and exam fees or its international search fee, respectively.
- Encourage offices to adopt these provisions unilaterally.

20. Regarding the third bullet above, it is noted that the EPO has already implemented item 2 with regard to its regional phase filings where it acted as the ISA, SISA, or IPEA in the international phase. Additionally, the U.S. is looking at its practices and procedures with an eye towards similar unilateral implementation of item 2 in its national phase applications.

(G) MANDATORY RECORDATION OF SEARCH STRATEGY

21. 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 national offices to make use of a search performed by the international authority, it would be beneficial for the national office to have access to the search logic used by the authority. For example, an examiner in the national office would not necessarily need to repeat the search done by the first examiner. In addition, the examiner in the national 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. Consideration could be given to establishing a uniform format for posting such search strategies so that examiners can easily understand and review the work of other examiners without spending unnecessary time analyzing the particular unique layouts of search strategy results.

22. This proposal was presented at the 2011 Meeting of International Authorities by representatives of the Canadian Intellectual Property Office (CIPO) for consideration and adoption by the Authorities. At the time it received support from a majority of the Authorities, with one Authority expressing concerns. CIPO indicated that it would reconsider and modify its proposal in light of the comments received. Recently CIPO has indicated that discussions are continuing in the context of the MIA Quality Sub-group to find consensus on the specifics regarding the sharing of search strategies.

23. We hope that other offices and users would take the opportunity in responding to this circular to share their thoughts on making search strategies available, and the usefulness thereof, so as to help the Authorities as they consider the matter further.

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

24. 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. It is proposed that a procedure modeled on this pilot be formally developed in the PCT system.

25. As with item (F), it is understood that full implementation of this proposal would be another of the longer term goals of the 20/20 Plan due to the fact that it would require significant changes to PCT practice and would involve significant logistical issues to be resolved. As noted above, the current pilot involves collaboration between three offices. However, it is understood that some logistical issues could be simplified if the collaboration was limited to two offices per application. Numerous logistical issues would also be overcome with the implementation of PCT 20/20 Item (J) "Development and Implementation of the Global Dossier and Incorporation of said System into The PCT".

26. Overall there are several issues to be considered with respect to how a collaborative search system would be established in the PCT system, the first of which being whether it would be implemented as a standard procedure for all applications or only if chosen by applicant. As originally envisioned, the decision on whether or not an application was subjected to collaborative search was to be left to applicant. However, making it a standard part of PCT processing would have some advantages as well (e.g., uniformity of treatment, increased quality for all applications, etc.). If the decision on whether an application is to undergo collaborative search and examination is left to the applicant, then it is suggested that consideration should be given to providing possible incentives in the national phase in order to encourage applicants to select collaborative search and examination.

27. There are also several options foreseen with regard to how the choice of searching authorities could be implemented.

- Applicant Driven: Under this option, the selection of searching authorities would be entirely at applicant's discretion. Applicant would select the primary authority from those authorities which are competent based on the Receiving Office and would then select the secondary authorities from all of the remaining authorities.
- Group Method: Under this option the authorities would be grouped together in a set manner (e.g., based perhaps on common languages) and applicant would select which preset group of authorities they wished to have process their application.
- Authority Driven: Under this option each Authority would enter into collaborative search agreements with other Authorities and applicants would simply choose the primary authority from those which were competent for their RO. The primary authority would then decide which other authorities would serve as the secondary authorities based on various criteria, e.g., language, field of art, workloads, etc.

28. All of the above options have various advantages and disadvantages, and other options or variations may also be envisioned.

29. When discussed at the Fifth Session of the PCT Working Group, there was some concern over the added cost of collaborative search to applicants. For the purposes of the current pilot, the cost of the additional work is being borne by the participating authorities themselves. However, if implemented as a permanent part of the PCT system, additional search fees would need to be charged to compensate the secondary authorities for the work performed. While exact amounts cannot be estimated at this time, it is hoped that the additional search fees charged would be approximately half, or less, of an authority's usual search fee, in view of the fact that the work performed by the secondary authorities would be less than that performed by the primary authority.

(I) MANDATORY TOP-UP SEARCHES

30. The original “Draft Roadmap for the Development of the 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.

31. In addition to presenting the 20/20 Plan to the Fifth Session of the PCT Working Group, the United Kingdom and the United States of America presented documents in support of making top-up searches a mandatory part of the Chapter II procedure (see PCT/WG/5/11 and PCT/WG/5/11ADD). The document by the United States of America (PCT/WG/5/11ADD) included a specific proposal to amend PCT Rule 66 to require that top-up searches be performed during Chapter II examination. The proposal again was met with general support from a large number of delegations. However, a number of delegations indicated that, in spite of the fact that the matter had been under discussion for more than three years, they would need to hold discussions with their users to get their reaction to the proposal.

32. Therefore, the proposal to amend Rule 66 is hereby presented again in the hope that offices will take this opportunity to raise the matter with their users and provide further comment in response to this circular.

Rule 66
Procedure Before the International Preliminary Examining Authority

[66.1ter Top-up Searches](#)

[Prior to the establishment of the Written Opinion of the International Preliminary Examining Authority under Rule 66.2 or the International Preliminary Examination Report under Rule 70, the International Preliminary Examining Authority shall perform a top-up search to identify any additional prior art that may be relevant under Rule 64 which has been published or has become available to the said Authority for search subsequent to the date on which the international search report was established.](#)

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

33. The development and implementation of the Global Dossier and incorporation of said system into the PCT is another one of the long-term proposals of the 20/20 Plan, especially given the fact that the concept was first proposed by the USPTO only within the past year and is still in its earliest stages of development with many of the specifics to be finalized as the system's implementation is established.

34. The Global Dossier is a transformative concept currently in development within the IP5 framework, in cooperation with WIPO, which will provide a 21st century, all-stakeholder-inclusive electronic environment. First proposed by the USPTO in November 2011, and further developed jointly with the Japan Patent Office in early 2012, the Global Dossier concept was endorsed at an IP5 and WIPO heads-of-offices meeting in June 2012, as a forward-looking way to advance the international patent system, providing stakeholders tremendous cost savings through new efficiencies, while improving patent quality through advanced work-sharing mechanisms.

35. The advantages which are envisioned from Global Dossier include: facilitation of preplanned cross-filings; one-portal management of cross-filed applications; elimination of the need to file duplicate documents in multiple offices (e.g., priority documents, prior art citations, etc.); and cost savings through the use of modern machine translation tools. Among IP offices, it will provide tremendous work-sharing leverage not only through information exchange, but also examiner collaboration—activities adding to patent quality worldwide.

36. Many of the ideas included in Global Dossier are not new—indeed some are already under review and development as IP5 Foundation Projects and as pilots in other fora. The Global Dossier initiative gives cohesion to them, providing a unified outcome with clear benefits to all stakeholders in the patent system. It gives the IP5 Offices and WIPO a new opportunity to consolidate, conclude, or re-mission current IT initiatives, and will reduce IT development costs and provide usable results for stakeholders quickly.

37. 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.

38. A brief video on the Global Dossier can be found at:
<http://helix-1.uspto.gov/asxgen/GlobalDossier.wmv>

(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

39. 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. 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.

40. Under the PPH program, an applicant receiving a favorable Written Opinion or International Preliminary Report on Patentability from an International Authority would be able to request that a corresponding national phase entry or a national application receive expedited processing and examination provided that all claims in the national phase application sufficiently correspond to the claims which received a positive indication in the Written Opinion or International Preliminary Report on Patentability. The national office would then use the international phase work products to streamline patent processing.

41. To date, the Patent Prosecution Highway (PPH) has been shown to significantly speed up the examination process for corresponding applications filed in participating countries by allowing examiners to reuse search and examination results. Some of the proven benefits of the PPH include: accelerated examination, a significantly higher allowance rate, a decreased cost of prosecution resulting from the fact that PPH cases generally have fewer actions prior to allowance, and reduced pendency.

42. Given the clear benefits provided by the PPH system it is proposed that the PPH be formally integrated into the PCT through the amendment of the regulations to include new rules 52*bis* and 78*bis*. As with proposals (D) and (E), a notice of incompatibility would be provided for those offices whose national law is inconsistent with this proposal.

Rule 52*bis*

Expedited Processing and Examination Before the Designated Office

Rule 52*bis*.1 Request and Requirements

(a) Any application which contains or is amended to contain, prior to the start of national phase processing, only claims which sufficiently correspond to claims which were indicated as meeting the criteria of PCT Article 33 (2)–(4) in the Written Opinion of the International Searching Authority, at the request of the applicant, shall receive expedited processing and examination as set forth in the Administrative Instructions.

(b) In addition to submission of a request under paragraph (a), in order to receive expedited processing and examination, the designated Office may also require that applicant submit:

(i) a fee,

(ii) copies of any references cited by the International Searching Authority, unless otherwise immediately available to the designated Office,

(iii) a claims correspondence table demonstrating the correspondence between the claims to be examined by the designated Office and those which were indicated as meeting the criteria of PCT Article 33 (2)–(4) by the International Searching Authority.

(c) If, on [...], paragraph (a) and (b) are not compatible with the national law applied by the designated Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [...]. The information received shall be promptly published by the International Bureau in the Gazette.

Rule 78bis **Expedited Processing and Examination Before the Elected Office**

Rule 78bis.1 Request and Requirements

(a) Any application which contains or is amended to contain, prior to the start of national phase processing, only claims which sufficiently correspond to claims which were indicated as meeting the criteria of PCT Article 33 (2)–(4) in the International Preliminary Examination Report, at the request of the applicant, shall receive expedited processing and examination as set forth in the Administrative Instructions.

(b) In addition to submission of a request under paragraph (a), in order to receive expedited processing and examination, the elected Office may also require that applicant submit:

(i) a fee,

(ii) copies of any references cited by the International Searching Authority and the International Preliminary Examining Authority, unless otherwise immediately available to the elected Office,

(iii) a claims correspondence table demonstrating the correspondence between the claims to be examined by the elected Office and those which were indicated as meeting the criteria of PCT Article 33 (2)–(4) by the International Preliminary Examining Authority.

(c) If, on [...], paragraph (a) and (b) are not compatible with the national law applied by the elected Office, those paragraphs shall not apply in respect of that Office for as long as they continue not to be compatible with that law, provided that the said Office informs the International Bureau accordingly by [...]. The information received shall be promptly published by the International Bureau in the Gazette.

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

43. At present, Rule 44*ter* requires the written opinion of the International Searching Authority (WO/ISA) 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.

44. Both the United Kingdom and the International Bureau submitted documents for consideration by the Fifth Session of the PCT Working Group. The United Kingdom document proposed that Rule 44*ter* be deleted and that Rule 48.2 be amended to enable the WO/ISA to be made part of the international publication at 18 months. The IB document indicated that, for logistical reasons, it would prefer that the WO/ISA be made available on PATENTSCOPE at the time of publication instead of being included as part of the international publication itself. (This could be effected by deleting Rule 44*ter* with no amendment to Rule 48.2.) The United Kingdom proposal as modified by the suggestion from the International Bureau received widespread support. However, certain delegations, while expressing support, raised concerns that (a) the availability of the WO/ISA containing negative indications could be prejudicial against applicants and (b) Article 38 (Confidential Nature of the International Preliminary Examination) prevents the WO/ISA being made available when the application is published. Certain offices also indicated that they would need to consult with their users.

45. Regarding the first concern, it was pointed out that the ISR, which would contain similar negative indications, would already be available to the public upon international publication. It was also noted that a procedure was in place for applicants to submit informal comments to the International Bureau rebutting the results of the ISR and WO/ISA, and the International Bureau indicated that such comments could similarly be made available on PATENTSCOPE.

46. Regarding the second concern, it was pointed out that while later being accepted as part of the examination process, the WO/ISA is initially issued as part of the search process and therefore does not form part international preliminary examination file and is not subject to the confidentiality requirement of Article 38. However, in an effort to eliminate any perceived Article 38 impediment, the United States of America suggested that the issue could be dealt with via either an amendment to Rule 94 (to provide that the filing of an application in itself is an expressed waiver of the Article 38 requirement as far as it pertains to the WO/ISA), or by providing that the WO/ISA be made available at the expiration of the period for filing a Demand if no Demand has been filed.

47. At the end of the discussion the United Kingdom indicated that it would take into consideration the comments made and the concerns raised and would bring a renewed proposal to the next session of the Working Group after offices have had a chance to consult further with their users.

48. Therefore, the proposal to make the WO/ISA publicly available at the time of international publication is hereby presented again in the hope that offices will take this opportunity to raise the matter with their users and provide further comment in response to this circular. In particular, it is proposed that:

- Rule 44*ter* is deleted to allow the WO/ISA to be made available upon international publication, and Contracting States agree that Article 38 does not apply.
- If agreement cannot be reached regarding Article 38, it is proposed that Rule 94 be amended to provide that the filing of an application in itself is an expressed waiver of the Article 38 requirement as far as it pertains to the WO/ISA.
- Alternatively, if agreement cannot be reached with respect to (i) or (ii) above, it is proposed that the WO/ISA is made available after 22 months from the priority date if no Chapter II demand has been filed.

[End of Annex and of document]