

Patent Cooperation Treaty (PCT) Working Group

Sixth Session
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IMPROVING THE TIMELINESS TO ISSUE AND PUBLISH INTERNATIONAL SEARCH REPORTS

Document submitted by the European Patent Office

1. At the fifth session of the PCT Working Group, held in Geneva from May 29 to June 1, 2012, the European Patent Office presented a proposal entitled “Proposals for Further Improvement of PCT Services and Products”, containing proposals for further improvement of the PCT system (document PCT/WG/5/20). 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 30 to 32). 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 European Patent Office 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 European Patent Office prepared a revised version of the original proposals for further improvement of the PCT system for discussion at the twentieth session of the Meeting of International Authorities that took place in Munich from February 6 to 8, 2013 (document PCT/MIA/20/11). Those revised proposals have also been communicated by the International Bureau, by way of a Circular (Circular C. PCT 1364, dated December 20, 2012, Annex II), 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, with the invitation 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. Taking note of the comments received, the European Patent Office hereby further elaborates on its proposal aiming at improving the timeliness for the establishment of search reports contained in document PCT/WG/5/20 (paragraphs 5 and 6) and PCT/MIA/20/11 (paragraphs 9 to 11).

4. It is generally acknowledged by applicants and the International Bureau that the search should be carried out in time for publication of the application (A1), so that re-publications (A2, A3) can be avoided. However, the time limit under Rule 42.1 is dependent on the time of receipt of the search copy at the International Searching Authorities, and there is no connection between the due date for the establishment of the international search report and the publication date.

5. International Searching Authorities carrying out large numbers of international searches manage their workload with a view to meet Rule 42.1 time limits. Since the time limit of three months applies irrespective of the publication date, applications received by the ISA relatively early, when publication is still far away but the three-month time limit is close to its end, have higher priority than the ones received relatively late, which are ready for publication but the official time limit is still some time away. In many instances, International Searching Authorities do not have the capacity both to respect the three months time limit and to establish all international search reports on time for the A1 publication. The result is an unnecessary number of A2 and A3 publications, causing additional work and costs for the International Bureau, and inconvenience to applicants.

6. Therefore, with the aim of improving the overall timeliness of A1 publications, the European Patent Office proposes to review Rule 42.1 with a view to meet the 18-month publication date by giving to International Searching Authorities some more flexibility to manage their workload.

7. The proposed new Rule 42.1 presented in the Annex to this document would keep the basic and pragmatic concept of differentiating international applications filed under priority from first filings. With respect to first filings, the international search report would be established within three months from receipt of the search copy at the International Searching Authority or nine months from the international filing date, whichever time limit expires later. This means that international search reports will generally be established nine months after the international filing date, unless the search copy was received at the International Searching Authority after three months from the international filing date. In that respect there is no change from the current practice. As far as international applications filed under priority are concerned, the international search report would be established within three months from receipt of the search copy at the International Searching Authority or 17 months from the international filing date, whichever time limit expires later. As a result, international search reports will generally be established 17 months from the priority date, sufficiently in advance for the International Bureau to publish them together with the international application at 18 months from the priority date. Having an earlier time limit, e.g. 16 months, would make no change with the current practice and hence fail to address the issue at stake.

8. Current WIPO statistics indicate that the average time in transmitting international search reports to the International Bureau was 16.4 months from the priority date in 2011, the shortest over the past decade. 69 per cent of international search reports were received within 17 months in 2012 to be compared with 68.3 per cent in 2011, and even 67 per cent in 2010. Such figures are certainly encouraging. The European Patent Office plays a role in this improvement since in 2012 some 89 per cent of international search reports were established by the European Patent Office within 17 months, and this figure even reaches 93 per cent

where the European Patent Office was also the receiving Office. However, too many international search reports are still not established on time to ensure A1 publication and the European Patent Office believes that there is room for further improvement. The proposed new Rule 42.1, along with continuous efforts by receiving Offices to promptly transmit search copies to International Searching Authorities, will ensure that even more international search reports are ready for A1 publication for the benefit of applicants, the International Bureau, and the public in general.

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

[Annex follows]

Proposed Amendment of Rule 42.1 (Timeliness in Establishing the International Search Report)

1. Current text:

Rule 42 **Time Limit for International Search**

42.1 Time Limit for International Search

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be three months from the receipt of the search copy by the International Searching Authority, or nine months from the priority date, whichever time limit expires later.

2. Proposed new Rule 42.1:

Rule 42 **Time Limit for International Search**

42.1 Time Limit for International Search

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be:

(a) where no priority has been claimed in accordance with Rule 4.10, three months from the receipt of the search copy by the International Searching Authority, or nine months from the ~~priority~~ international filing date, whichever time limit expires later; or

(b) where a priority has been claimed in accordance with Rule 4.10, three months from the receipt of the search copy by the International Searching Authority, or 17 months from the priority date, whichever time limit expires later.

[End of Annex and of document]