

## **Meeting of International Authorities under the Patent Cooperation Treaty (PCT)**

**Twenty-Third Session**  
**Santiago, January 20 to 22, 2016**

### **PCT ONLINE SERVICES**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. PCT online services have continued to develop, offering tools for use by applicants, receiving Offices and International Authorities which should help International Searching Authorities to perform their duties more effectively. As well as direct processing functions, this includes monitoring the flow of international applications to assist the effective management of workload and earlier identification of potential problems.
2. Suggested priorities in relation to International Authorities are: (i) ensure that applicants can upload documents to the International Authority; (ii) ensure that key documents from the International Authority are available online; and (iii) evaluate eSearchCopy as a means for receiving search copies in a consistent electronic format from all associated receiving Offices.
3. International Authorities are invited to consider how they might better use the tools available and what further developments to online services might be desirable to provide a higher quality service to applicants, designated Offices and third parties at lower overall cost.

#### **CURRENT STATE OF ePCT BROWSER-BASED SERVICES**

4. ePCT now offers applicants and receiving Offices all the essential services for electronic processing with the receiving Office and International Bureau, save that priority documents which are issued by the Office of first filing on paper must still be physically transmitted to the receiving Office or the International Bureau on paper – scans by the applicant cannot be accepted. Despite this limitation, approximately 85 per cent of priority documents are received

electronically. The ePCT service, including not only the browser-based services but also services such as eSearchCopy and PCT-EDI (the SFTP-based service for routing documents and data), seeks to ensure that International Authorities receive high quality documents and information in a timely fashion.

5. The services provided directly for International Authorities are primarily concerned with transmission of documents and information for Authorities which have not fully automated the relevant processes:

(a) Authorities have live access to the International Bureau's files for the international applications for which they are competent, including both documents and bibliographic data.

(b) Authorities may allow applicants or other Offices to upload documents for their attention – documents received may either be downloaded from the browser interface (notifications are sent to indicate that the new document is awaiting attention) or transmitted in batches over SFTP in the same format as that used for documents from the International Bureau. This arrangement will shortly be extended to allow delivery of search copies using ePCT browser-based services where this is preferred to SFTP.

(c) Authorities may upload documents to the system, both for transmission of documents which are required to be sent to the International Bureau and to simply make the documents immediately available to the applicant (this result can also be achieved using more automated services over SFTP).

6. In addition, certain management reports are available, including:

(a) for receiving Offices – summary of applications filed, by type and status;

(b) for receiving Offices and International Searching Authorities – summary of international applications known to the International Bureau for which the Office is competent where the search copy appears to be outstanding; and

(c) for International Searching Authorities – summary of international applications known to the International Bureau for which the Authority is competent where the international search report is outstanding.

7. The Meeting's Quality Subgroup is invited to review the above reports and suggest improvements or further reports which may be desirable.

## **USE OF ePCT BROWSER-BASED SERVICES**

8. At the time of writing, ePCT-filing offered filing of international applications to 29 receiving Offices, 21 of which (including the receiving Office of the International Bureau) have their server hosted by the International Bureau. Several more are scheduled or expected to be added in early 2016. The service has been popular with applicants. The service has quickly become the preferred route for filing international applications at most receiving Offices which did not previously offer electronic filing, as well as some which did, accounting for over 50 per cent of filings at fourteen Offices.

9. Over 50 national and regional Offices have access to ePCT in one or more capacity as receiving Office, International Searching and Preliminary Examining Office or designated or elected Office. Around 40 of those Offices regularly use the browser-based services as part of their international phase duties. Others use it for evaluation or to assist with customer services or other forms of trouble-shooting.

10. 34 receiving Offices allow applicants to upload post-filing documents to them using ePCT. 31 of those Offices retrieve documents through the ePCT browser-based interface; the others have the documents delivered as batches through PCT-EDI. Eight International Searching and Preliminary Examining Authorities similarly allow applicants to upload documents to them.

## **USE OF eSEARCHCOPY**

11. The eSearchCopy service is now in use between 28 pairs of Offices, consisting of six International Searching Authorities and 15 receiving Offices. Moreover, the European Patent Office (which acts as International Searching Authority for 105 receiving Offices) will shortly begin pilots with the receiving Office of the International Bureau and a representative selection of receiving Offices. The aim of the pilots is to confirm that the service meets the expectations of improved quality and timeliness when used by receiving Offices of different types – geographically close or far; documents mainly e-filed or scanned from paper; search fee payment information provided by individual indications in ePCT or by batch notifications from a centralized fee handling system.

## **OPPORTUNITIES AND PRIORITIES**

### ePCT Scheduled Developments

12. A wide variety of minor improvements are intended for the coming year, However, the key developments of ePCT browser-based services by the International Bureau in 2016 will be:

- (a) an overhaul of the “look and feel” of the browser application to provide a design which is easier to use, more consistent and more attractive;
- (b) a new identity and access management system, allowing applicants (and potentially Office users) to log in with authentication systems which are easier to use than the current digital certificates, but still at least as secure;
- (c) improved workflow arrangements for receiving Offices to make more clear what further processing is required and ensure that nothing is overlooked;
- (d) better use of machine-readable information to deliver improved services, including use of citation information from international search reports transmitted in XML format to give applicants and designated and elected Offices more effective access to cited documents, including patent family members and non-patent literature.

13. In addition, the International Bureau is developing an initial set of web services to evaluate opportunities and interest. These could be used for near-real time machine-to-machine interactions with applicants (through patent management systems) or Offices. They would complement, rather than replace the browser-based and periodic batch services which make up the current communication services. The primary target is the effective automation of services where action, or at least acknowledgement of receipt, is urgent, or other efficiencies can be gained by direct use of data from another system, automated acknowledgement or real time data checks. Other possibilities include centralization of some common technical services to reduce development and maintenance costs and ensure consistent results across different Offices.

### eSearchCopy

14. A number of improvements to the eSearchCopy service have been made following feedback from the participating Offices, notably extending the range of documents made available and improving the associated data to allow Offices to import the information into their systems automatically more effectively. Further improvements in the near future will include the

availability of OCR text of application bodies which were not filed in XML format and further improvements to the bibliographic data required by International Searching Authorities. The process has also highlighted technical issues which cannot be addressed in the short term, but which will help shape the course of future more general development work.

15. The eSearchCopy service has not yet been running for long enough to evaluate its effectiveness in practice. However it offers the opportunity of significant benefits for International Searching Authorities in that they can receive all the documents usually associated with search copies in a consistent electronic format. This eliminates postal delays and the need for scanning and indexing incoming documents in a way which requires a single import process which applies to all receiving Offices. Given that a majority of International Searching Authorities are competent for more than 10 receiving Offices, this in itself may represent a considerable saving.

<b>ISA</b>	<b>Number of ROs for which Office is competent as ISA</b>	<b>Proportion of Search Copies from Other Offices as RO</b>
AT	28	100.0%
AU	20	41.9%
BR	7	11.7%
CA	4	11.6%
CL	12	21.0%
CN	10	1.4%
EG	5	27.3%
EP	105	57.0%
ES	15	28.2%
FI	2	0.6%
IL	4	22.7%
IN	3	46.9%
JP	11	1.0%
KR	16	53.4%
RU	32	67.8%
SE	19	14.4%
SG	4	2.0%
US	20	4.4%
XN	5	1.6%

*Table 1: Sources of Search Copies for International Searching Authorities*

### Effective Use of ePCT

16. Just as important as the technical developments by the International Bureau is the extent to which Offices use the new opportunities to communicate more efficiently and to deliver better overall services to end users, including third parties and designated Offices.

17. For this purpose the International Bureau suggests that it should be a priority for International Authorities to allow applicants to upload documents to them electronically in order to allow fast and clear responses and eliminate the need for scanning paper. Clearly those International Authorities which have their own electronic document management systems will wish to allow this through their own, local services. However, as shown in Table 1, most International Authorities handle a significant proportion of applications which are filed through receiving Offices other than their own. Consequently, ePCT should also be an option to allow for applicants who do not have accounts with any online services operated directly by the International Authority.

18. Further, applicants should be able to access as much documentation as possible online, including Forms and documents which are not required to be sent to the International Bureau. Particularly important candidates for this type of treatment include:

- (a) written opinions of the International Preliminary Examining Authority (PCT/IPEA/408);
- (b) invitations to pay additional fees due to lack of unity of invention (PCT/ISA/206 or PCT/IPEA/405);
- (c) documents cited in the course of the international search or preliminary examination (these would not be made available on PATENTSCOPE, but would be readily available to the applicant or designated Office in accordance with Article 20(3) without additional work or mailing costs for the International Authority);
- (d) other invitations to pay fees, request rectification, furnish documents, correct defects or specify a competent International Authority.

19. While the benefits for local applicants could generally be achieved by providing these documents through a local file inspection service, as previously noted, most Authorities deal with a significant number of applicants from other States. Perhaps more importantly, some of these documents (especially copies of cited documents) may be relevant to designated Offices. Consequently, once again, it is important that they should become available through ePCT.

20. It should be emphasized that International Authorities would not need to provide these documents using the ePCT browser-based interface. They could be transmitted using PCT-EDI with the appropriate document codes and would automatically be made available to applicants and designated Offices privately through ePCT, or on Patentscope for the general public, depending on the nature of the document.

#### XML Documents

21. As referred to in paragraph 12(d), above, the International Bureau has begun to receive international search reports and written opinions of the International Searching Authority in XML from a number of International Authorities. The International Bureau would strongly welcome the availability of international search reports, written opinions and international preliminary reports on patentability in XML or text format from more International Authorities. The International Bureau intends to approach the International Authorities not already providing or testing XML reports with a view to identifying the relevant obstacles and looking for appropriate ways to overcome them.

22. In addition, an import system has been built into ePCT-filing to allow applicants to attach application bodies in Microsoft Word documents, the contents being converted to Annex F XML (with warnings where difficulties are encountered) and the original document remaining on file as a pre-conversion format document in accordance with Section 706 of the PCT Administrative Instructions. It is hoped that work in this area will encourage more applicants to file in full text formats in the future, improving the quality of information reaching the International Authorities.

#### **TECHNICAL AND LEGAL CHALLENGES**

23. The online services already available have transformed the administration and greatly enhanced the efficiency of the PCT system. The further developments and broader use of the services mentioned in paragraphs 12 to 22, above should deliver significant further improvements.

24. However, various challenges will need to be addressed by Contracting States as a whole, not only by the International Bureau, if the PCT system is to deliver its maximum potential for increased administrative efficiency and delivery of timely, accurate information. These include:

- (a) *Centralized payment* – Truly effective service for clients around the world would permit payments using the same service as that through which documents are submitted.

This is a particular priority for ePCT-filing, but could also be relevant to additional fees in relation to unity of invention, demands for international preliminary examination, national phase entry and suchlike. For most currencies, taking the fees by credit card using ePCT would be relatively simple. However, issues arise concerning timely and cost-effective payment of fees from the International Bureau to the Office concerned, as well as concerning who is responsible for the significant credit card transaction fees involved. These issues are being studied as a follow-up to the “netting” and “hedging” proposals discussed by the PCT Assembly in relation to document PCT/A/47/5 Rev.

(b) *Digital signatures* – Various actions could be made more efficient or even fully automated if online actions could be reliably verified as having been signed by an authorized person. However, most documents and actions are submitted by paralegals on behalf of the authorized person (be that the agent or an inventor or applicant whose signed declarations are being submitted). Furthermore, the current system of access control is concerned primarily with ensuring that people using the service have the right to access the information, rather than clearly identifying eligibility to take actions on the file. An arrangement is needed to allow the application of digital signatures which meets the expectations of Contracting States, while being practical for use by agents in the real world.

(c) *Color drawings* – The International Bureau is still working to identify an effective way forward on allowing the filing and international phase processing of color drawings. While a workable interim solution may be found, seems likely that a proper solution may require a move to full text processing of applications (separating out individual images from the surrounding text), wider acceptance of color drawings in the national phase and further consideration of the implications for priority documents.

(d) *Effective distribution of responsibilities* – The possibilities for effective processing have been changed by the introduction of real time, remote access to a central file, providing the ability for applicants and national Offices to enter data which can be directly used by other parties and the ability for Offices in one State to communicate in timely fashion with applicants in other parts of the world. In some cases, this might involve simply further automating services provided by the International Bureau or national Offices which can be reliably performed on the basis of information entered by another Office. In other cases, amendments to the Regulations or modifications of the Administrative Instructions may be necessary to give authority to the International Bureau or to receiving Offices and International Authorities to take actions that are currently under the competence of a different Office. Proposals along these lines may be brought to the next session of the PCT Working Group.

*25. The Meeting is invited to note the developments in PCT online services, to comment on the proposed priorities and to identify other issues which should be given priority in PCT online services to assist the work of International Authorities.*

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