

Meeting of International Authorities Under the Patent Cooperation Treaty (PCT)

**Twenty-Fourth Session
Reykjavík, February 8 to 10, 2017**

STATUS REPORT ON THE eSEARCHCOPY/PCT PAPERLESS SERVICE AT THE EUROPEAN PATENT OFFICE

Document prepared by the European Patent Office

BACKGROUND

1. At present, most receiving Offices transmit the record copy to the International Bureau (IB) in accordance with Rule 22 and separately transmit the search copy to the International Searching Authority (ISA) in accordance with Rule 23. The vast majority of record copies of international applications for which the European Patent Office (EPO) was selected as ISA are sent by the receiving Offices to the IB in electronic form via PCT Electronic Data Interchange system (PCT-EDI) or ePCT. However, with the exception of a few receiving Offices, this is not the case for the search copies received by the EPO in its capacity as an International Searching Authority, for which the current practice is the paper-based (or CD-based) transmittal.

2. Desiring to implement a flawless and cost-efficient mechanism to transmit search copies from PCT receiving Offices to the EPO as ISA via the IB, the EPO and the International Bureau carried out a pilot program, based on the eSearchCopy service, on the electronic transmittal of search copies via the IB (called "PCT Paperless" at the EPO) between July 2015 and August 2016. The aim of this pilot was to assess the feasibility of such new electronic transmittal process of search copies where the EPO acts as ISA with a limited number of receiving Offices of different sizes and in different geographical locations and to determine the conditions for extending this new service to more receiving Offices. The pilot was successful and the service is now operational with the receiving Offices of the following Contracting States: Israel, Italy, Spain, Japan, Norway and Finland, as well as with the IB as receiving Office.

3. Following this pilot, the EPO intends, in cooperation with the International Bureau, to offer this new service (called “PCT Paperless service” at the EPO) to any interested receiving Office meeting the necessary requirements, with a view to progressively abandoning the search copy transmittal via surface mail.

PCT PAPERLESS CONCEPT

4. For search copies to be transmitted electronically via the IB, the receiving Office must send the record copy package (an electronic bundle of documents including the record copy and a number of accompanying items) together with any document not contained in that package but which must be in the search copy package (in particular, if applicable, the translation for the purposes of international search under Rule 12.3) to the IB by electronic transfer (PCT-EDI or ePCT). In addition, the receiving Office must inform the IB that the search fee has been paid by the applicant. The latter is important in order to ensure that search fees relating to search copies received by the EPO as ISA have been paid

5. After having checked that the EPO as ISA is competent to carry out the international search and upon receipt of the translation for the purposes of international search under Rule 12.3, if required, and of the indication that the search fee had been paid by the applicant, the IB promptly makes the prepared search copy batch (a copy of the electronic record copy package and any accompanying documents received from the receiving Office) available to the EPO as ISA on behalf of the receiving Office over a secure private communications network (TriNet). The prepared search copies are in the WIPO Minspec data exchange format and their transmission is carried out, if possible, in daily batches.

6. Subsequent documents which were not sent with the record copy package but were received by the receiving Office at a later point in time shall also be forwarded by the receiving Office to the IB via PCT-EDI or ePCT and thereafter by the IB to the EPO as ISA over the same secure private communications network (TriNet), and under the above mentioned conditions.

7. Hereinafter the electronic search copy transmittal process via the IB is also referred to as “the PCT Paperless transmittal process” and any reference to the paper-based transmittal of search copies should be understood as a reference to their CD-based transmittal where the latter corresponds to the current transmittal process.

MAIN BENEFITS

FURTHER IMPROVEMENT OF EPO’S TIMELINESS AS AN INTERNATIONAL SEARCHING AUTHORITY

8. In 2015, 89.8 per cent of the international search reports drawn up by the EPO were published with the international application 18 months after filing (A1 publication) and 67.4 per cent were established within the time limit under Rule 42.1 (three months from the receipt of the search copy by the ISA, or nine months from the priority date, whichever expires later). These figures could be further improved with the PCT Paperless transmittal process. This new workflow will avoid postal delays so that search copies are received more quickly. This will have the result that international search reports can be established earlier and published in good time by the IB. This will be beneficial to both applicants and third parties.

IMPROVEMENT OF THE SERVICE OFFERED TO RECEIVING OFFICES

9. Many receiving Offices have expressed an interest in switching over to electronic transmittal of search copies. In 2015, 93.6 per cent of international applications were filed in electronic form. This is the result of a significant growth over the last five years (78.3 per cent in 2010). In the vast majority of cases, receiving Offices currently have to print electronically received documents in order to send the search copies via surface mail to the EPO as ISA. The

PCT Paperless transmittal process will enable the EPO to meet their demand for a more efficient transmittal process, since the receiving Offices will make significant savings on printing and mailing costs.

STREAMLINING OF THE TRANSMITTAL PROCESS

10. Switching over to electronic transmittal of search copies would also streamline the transmittal process as there would eventually be one main processing flow with the EPO as ISA based on electronic transmittal using a common electronic platform, instead of having as many flows as receiving Offices.

FRAMEWORK FOR THE TRANSITION TO PCT PAPERLESS

11. Prior to allowing a receiving Office to switch to the PCT Paperless transmittal process, it should be ascertained that such transition would not jeopardize the legal certainty. Therefore, for every receiving Office interested in switching to the PCT Paperless transmittal process, the transition will be preceded by an evaluation phase.

12. During the evaluation phase, the electronic transmittal of search copies via the IB will be carried out in parallel to the paper-based (direct) transmittal from the receiving Office to the EPO as ISA so as to evaluate the PCT Paperless transmittal process against the paper-based one, in terms of timeliness, data quality, traceability, completeness and consistency of the received documents and of the existence of a problem-solving process.

13. The transition to the PCT Paperless transmittal process is subject to a positive assessment of the above metrics by the EPO and the International Bureau. In practice, this assessment will be positive only if the receiving Office meets a set of specified requirements. If the evaluation is positive, the receiving Office will be informed about the date as of which the PCT Paperless transmittal process will become the standard transmittal process and, thus, the paper flow can be stopped.

14. The planning and timeline of the evaluation phase (e.g. how many documents will need to be evaluated for a conclusive assessment and/or how long the evaluation will last) will depend of the size of the receiving Office measured on the basis of the number of the search copies transmitted annually to the EPO as ISA. The EPO will inform the receiving Office accordingly.

PROGRESSIVE EXTENSION OF THE PCT PAPERLESS SERVICE

15. The EPO and the International Bureau have already been contacted by many receiving Offices interested in using the PCT Paperless service. Due to the time and work needed to implement this service for each receiving Office, the EPO is not able to offer this new service to all interested Offices at once. Therefore, the extension of this new service will be carried out progressively.

16. More specifically, the extension of the PCT Paperless service will follow a phased rollout per groups of three to four receiving Offices. Several criteria are taken into consideration by the EPO for the constitution of these groups, such as, for instance, ensuring a balance between European Patent Convention (EPC) and non-EPC Contracting States, having at least one medium to high volume receiving Office (more than 100 search copies per year) in each group, giving priority to receiving Offices with no incompatibility with new Rule 23*bis*, giving priority to receiving Offices having a higher XML filing volume, and taking consideration of the geographical distance from the receiving Office to the EPO.

17. For the time being, the EPO has planned to extend the PCT Paperless service to three groups which amount to a total of around ten receiving Offices in 2017.

18. Any receiving Office interested in using the PCT Paperless service is welcome to send a request to the EPO at the following e-mail address: international_pct_affairs@epo.org.

19. The Meeting is invited to note the contents of the present document.

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