

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

Twenty-Fifth Session
Madrid, February 21 to 23, 2018

FUTURE DEVELOPMENT OF THE PCT

Document prepared by the International Bureau

SUMMARY

1. It is intended to present a review of the “PCT Roadmap” and related issues to the PCT Working Group with a view to considering whether any further guidance is required to ensure that the various lines of work ongoing to further develop the PCT System are mutually supportive and appropriate to the current needs of the system. While the review is not expected to include significant recommendations concerning the directions of work related to the operation of the International Authorities, the Meeting is invited to raise issues which may be appropriate to take into account in the review.

BACKGROUND

2. In 2010, the PCT Working Group endorsed a series of recommendations to improve the functioning of the PCT system (“PCT Roadmap recommendations”), based on a study prepared by the International Bureau (document PCT/WG/3/2) and related submissions from PCT Contracting States (documents PCT/WG/3/5 and 13). The discussions by the Working Group are outlined in the report of the session (document PCT/WG/3/14 Rev., paragraphs 14 to 137).

3. While a variety of specific recommendations were endorsed, the essential underlying theme of the PCT Roadmap, as emphasized in document PCT/WG/5/3, was the need to review what the Treaty was trying to achieve for the benefit of all interested parties – applicants, national Offices and third parties and civil society more generally – and to encourage relevant

players within the system to take steps to meet these aims more effectively. For the most part, this was not a matter of changing the Treaty or Regulations, but of taking administrative and technical steps to improve the implementation of what was already mandated.

4. In addition, on the occasion of the publication of the three millionth PCT application, the Director General issued a memorandum¹ entitled “The PCT System — Overview and Possible Future Directions and Priorities”, intended to provide “food for thought” on broad directions and priorities for possible future work aimed at further improving the System.

5. Paragraphs 80 and 81 of that memorandum contained the following summary:

“80. The past 15 years have seen enormous improvements to the PCT system driven by changes to the legal framework. However, the further progress which can be driven by such changes is limited. The key to future improvements lies in putting renewed emphasis on the “Cooperation” aim which underpins the Treaty. No doubt, changes to the legal framework will continue to play a supportive role. However, in the view of the International Bureau, it is now mainly up to the Contracting States and the national and regional Offices which perform roles under the Treaty to put further life into that “Cooperation” aim with a view towards making the PCT system fully effective as the tool to support innovation, investment and development that those same Contracting States designed it to be.

“81. Key issues to be addressed in this context include:

- the need for Offices to perform their assigned roles in a timely way and to the quality necessary to allow other Offices and the public at large to trust in the work performed by them, even though this might involve costs for which the main benefits are received by others;
- the need for Offices to accept closer public scrutiny of their work;
- the need for IT systems to be developed with a view towards sharing usable information with others more effectively and to common standards, even though that may increase initial development costs and lengthen development timetables;
- the need to convince applicants, and to set incentives accordingly, to ensure that applicants play a more effective part in the “cooperation”;
- the need to provide training and assistance necessary to ensure that Offices from all Contracting States are able and willing to perform their roles effectively.”

ISSUES

6. The International Bureau intends to present a document to the eleventh session of the PCT Working Group in June 2018, reviewing the implementation of the PCT Roadmap recommendations. The document would consider whether the directions of work implied by the outstanding recommendations, or by other work ongoing in the context of the PCT Working Group or Meeting of International Authorities, are still appropriate to the development of the PCT System to meet today’s challenges.

7. In line with the comments set out in the memorandum referred to in paragraphs 4 and 5, above, it is currently expected that the document would suggest that work is generally heading in the right direction as far as issues relating to the operation of the International Authorities are

¹ Available from the WIPO website at: <http://www.wipo.int/pct/en/3million>

concerned. There is, however, potential for further improvement in areas such as the information that is available to examiners when performing international search and preliminary examination, the quality and consistency of work products, and the transmission of data in formats that can be processed by IT systems in an optimal manner.

8. Specifically, the main issues are:

- (a) timely delivery of search copies in formats which can be used effectively (eSearchCopy and more general work on full text application bodies);
- (b) improving the quality of information available to International Authorities to assist international search and preliminary examination (including improvement of the definition, scope and availability of the PCT minimum documentation);
- (c) ensuring that the quality framework required of International Authorities translates into increasing quality of reports (a variety of lines of work in the quality subgroup);
- (d) improving the consistency of international search reports, written opinions and preliminary examination reports (further lines of work in the quality subgroup);
- (e) delivering the results of international search and examination in formats which are useful to the applicant, designated Offices and third parties, both directly and through patent information service providers (mainly development and implementation of IT standards, particularly those working towards delivery of reports and related information in XML format).

9. While work at International Authorities may be heading in the right direction, a further question to consider is whether it is going far and fast enough to meet the needs of designated Offices. These Offices are facing increasing workloads and need greater certainty that their national examinations are being properly assisted by a high quality international search reports and written opinions which are consistent and fit for purpose. In addition, specific standards may need greater consideration in order to ensure that Offices and applicants are able to prepare data in a format which can easily be used for later processing. Authorities are therefore invited to identify areas where existing cooperation could be intensified or redirected, and consider what new directions for collective action should be explored as part of the review of the PCT System.

10. The Meeting is invited to comment on issues relating to the work of the International Authorities which might be improved through additional, different or better directed collective action.

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