

Patent Cooperation Treaty (PCT) Working Group

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eSEARCHCOPY

Document prepared by the International Bureau

SUMMARY

1. The eSearchCopy service is now in regular use between a large number of receiving Offices (ROs) and International Searching Authorities (ISAs) and is functioning well. The International Bureau (IB) seeks to encourage more pairs of Offices to use this route for sending search copies.

USE OF THE eSEARCHCOPY SERVICE

2. At the time of writing, the eSearchCopy service linked 40 ROs with 16 ISAs in 98 total combinations, with several more expected to begin soon. Use of the service accounted for around 24 per cent of search copies being sent from one Office as RO to a different Office as ISA.

3. There remain 285 pairs of RO and ISA between which search copies are presently transmitted by different means. The Annex to this document lists, for each ISA, the receiving Offices which do and do not deliver search copies using the eSearchCopy service at the time of writing.

4. The following table summarizes the extent to which different ISAs receive search copies from other Offices as RO using eSearchCopy; it does not take into account international applications where the same Office acts as both RO and ISA (where it would normally be expected that the Office would arrange its own supply of data to the search systems, though the system can be configured to deliver search copies to the same Office as the ISA where this would assist the Authority's import processes). The final column, showing the proportion of

search copies delivered using eSearchCopy, is an approximation based on whether transmissions between any particular RO and ISA are now sent using eSearchCopy, weighted according to the actual numbers of search copies transmitted between those pairs in the course of 2016. There will be some minor differences in practice where there have been changes in competence of an ISA for ROs, or if patterns of usage have changed significantly for other reasons.

ISA	ROs other than self for which ISA is competent	Number of ROs sending by eSearchCopy	RO/IB sends by eSearchCopy	Proportion of search copies using eSearchCopy
AT	37	14	Yes	99%
AU	24	14	Yes	100%
BR	8	2	Yes	70%
CA	6	0		
CL	11	3	Yes	92%
CN	10	1	Yes	83%
EG	9	5	Yes	100%
EP	118	12	Yes	22%
ES	14	0		
FI	1	0		
IL	3	2	Yes	100%
IN	2	0		
JP	12	9	Yes	100%
KR	16	2	Yes	2.2%
RU	31	11	Yes	94%
SE	20	8		57%
SG	8	5	Yes	100%
TR	1	0		
UA	1	1	Yes	100%
US	23	0		
XN	5	4	Yes	100%
XV	5	5	Yes	100%

5. The largest of the remaining pairs of Offices not yet using eSearchCopy by volume of international applications transmitted are those from the United States Patent and Trademark Office (USPTO) as RO to the European Patent Office (EPO) and the Korean Intellectual Property Office (KIPO) as ISAs and from the United Kingdom Intellectual Property Office (UKIPO) as RO to the EPO as ISA. Together, those transfers represent around 60 per cent of the transmissions of search copies from one Office to another.

6. These high volume flows are already well automated. Inclusion of these flows into the eSearchCopy service is unlikely to make any significant impact on the overall performance of the PCT system in the short term, but may be a priority for some of the Offices concerned in order to allow consolidation of IT systems and related processing.

7. The biggest benefit to the PCT system as a whole in the short term is expected to come from the take-up of eSearchCopy by Offices which currently transmit search copies on paper. Noting that most record copies are transmitted to the International Bureau electronically (and that systems are in place to allow other receiving Offices to move to electronic transmission), this should significantly reduce times to the receipt of search copies, as well as reductions in costs of printing and mailing for ROs and of scanning and document classification for ISAs.

8. Additionally, enabling the transmittal of both the record copy to the IB and the search copy to the ISA in electronic form, along with subsequently filed documents, gives the opportunity to all receiving Offices that currently do not accept electronic filing the means to do so through the use of the ePCT portal system; ePCT allows electronic filing by applicants and electronic transmission to the IB of the record copy and at the same time eSearchCopy uses that same electronic file to transmit the search copy to the ISA. Where eSearchCopy is not available to an ISA, receiving Offices accepting electronic filing must use physical media to transmit search copies to that ISA, which is significantly less convenient than using eSearchCopy.

9. It should also be noted that a pilot is under way for transferring search fees from the USPTO as RO to the EPO as ISA via the IB and it is intended to extend this pilot to a number of additional ROs and ISAs in the course of 2017 (see document PCT/WG/10/6). If this pilot is successful, it has significant potential synergies with the eSearchCopy system, ensuring that data is collected in a timely and consistent manner for both purposes, allowing further improvements to timeliness and accuracy of search copy processing, reductions in administrative costs for ROs and ISAs and a greater ability for the IB to manage costs caused by variations in exchange rates.

MEASURING THE EFFECTIVENESS OF THE SERVICE

Timeliness of Receipt of Search Copy

10. An analysis made in mid-December 2016 compared the time from the international filing date to the date of receipt of the search copy for the 50 last search copies sent between the two Offices prior to the use of eSearchCopy with the most recent 50 search copies sent by using the eSearchCopy service (or all relevant search copies for international applications of either type filed on or after January 1, 2014, where this number is lower).

11. For all of the pairs involved save six, the average time to receipt of the search copy had reduced. For those with more than 20 search copies, the reduction in average time ranged from two days to over a month (some larger figures appeared for pairs with lower numbers, but the statistical fluctuations make the comparisons less relevant). This is in addition to any internal efficiencies which can be achieved by the ISA because the copies are delivered in electronic form with their document types consistently coded so that there is no need for manual scanning and document classification before the search copy can be forwarded to the examiner.

12. Also importantly, the fact that the International Bureau has a better view of the overall picture and is able to follow up on apparent anomalies at an earlier stage means that the number of international applications where the time for delivery of the search copy is greater than three months from the international filing date appears to have dramatically reduced. The problem of search copies being lost in the post and only being delivered much later (in some cases over a year later) after follow-up by either the applicant or the International Bureau is also essentially eliminated.

13. Of those pairs of Offices where the average time for transmission increased, the main issue appears to be around delivery of translations for the purpose of international search. Changes have been made to address this both in IT systems and in practices at the International Bureau and it is expected that significant improvements will be seen in the course of 2017. Other issues are still being investigated but appear to be due mainly to transitional problems for individual receiving Offices which should no longer be relevant or else technical problems which have now been resolved. In the longer term, as well as making further improvements to the ePCT system for clarity and ease of use, it is intended to offer additional training and improved reporting services to help ensure that ROs do not overlook essential actions to trigger the forwarding of the search copy, particularly in relation to notification of the payment of the search fee, which is the most common reason for delay in release of the search copy.

14. Furthermore, as an integral part of the “PCT Paperless” project at the EPO to move to the use of eSearchCopy (see document PCT/WG/10/13), the EPO has assessed, by means of a parallel run with paper search copies, the timeliness of receipt for each receiving Office. In each case, the EPO has been sufficiently satisfied with the timeliness to move to production use of the service.

Quality of Search Copies

15. The International Bureau does not have the data to measure the actual quality of search copies as received by examiners before and after use of the eSearchCopy service. However, as part of its pilot of the service, the EPO has conducted quality evaluations and found that, in general, the quality of search copies is equal to or better than those previously received on paper. It was noted that various long-standing issues around quality of search copies remain to be resolved, most notably concerning drawings with small text or including color and greyscale, but these have in some cases been improved and at least not made worse by the alternative service.

16. Following feedback from several ISAs, the international Bureau has made a number of improvements to the bibliographic data packages that are being delivered by the system, and is in the process of implementing the delivery of translations for the purposes of search with the sections of the application body indexed, and the delivery of an early OCR of page image applications to assist examiners.

17. For ROs uploading record copies through the ePCT browser-based service, the system provides warnings in many cases where there are likely to be problems with a scanned document and offers the RO the ability to see the results of any conversions before the record copy (which will also be used as the eSearchCopy) is transmitted. This allows the possibility of seeking to make improvements in scanned paper at source. The hosted e-filing service also offers the opportunity for those Offices still only accepting paper filings to move to e-filing (and subsequent participation in the eSearchCopy service) without local development and maintenance costs, eliminating the need for local scanning.

NEXT STEPS

18. The IB is taking steps to update the eSearchCopy system in preparation for the entry into force, on July 1, 2017, of the new PCT Rule 23*bis*. This activity will see a number of additional document types being transmitted through the system in support of the new requirement for receiving Offices to generally transmit to the ISA any documents relating to the results of earlier search that are available to that receiving Office.

19. The IB would like to encourage receiving Offices and International Authorities which do not currently use the eSearchCopy service to evaluate it and to make efforts towards supporting it as a means of receipt of search copies. The IB would like to decommission its legacy systems for transmitting search copies from RO/IB to ISAs as soon as possible. This would both reduce maintenance costs for the parallel systems currently being supported and allow the IB to concentrate efforts on a single service which can be effectively monitored to ensure that search copies are delivered to ISAs quickly and accurately from all ROs for which the ISA is competent.

20. The Working Group is invited to note the contents of this document.

[Annex follows]

ANNEX

ROUTES OF SEARCH COPIES

The following table shows the ROs which do and do not use eSearchCopy to deliver search copies to each ISA at the time of writing. The ROs are listed in descending number of search copies sent to the ISA in 2016.

ISA	ROs delivering using eSearchCopy	ROs not delivering using eSearchCopy
AT	IB ZA IN KR DZ BR SG KE CO DJ EG MA MX OM	VN AE AO AP BB BH CU GE GH GT KP LC LR LS LY MG OA PE ST SY TT ZM ZW
AU	US IB NZ SG MY KR IN ZA TH BN ID KE OM PH	AE GH LC LK LR NG PG VC VN ZW
BR	IB CO	PE AO CU GT PA ST
CA		IB AG BZ NG SA VC
CL	IB MX CO	PE EC SV CR CU DO GT PA
CN	IB	TH IN KP KE AO GH IR LR ZW
EG	SA IB OM DJ EG	KW QA SD SY
EP	IB JP FI SE AT IT IL ES NO ZA NZ DJ	US GB FR DE NL TR DK IN PL CZ CH HU RU BR GR BE SG PT MY MA UA HR SI IE IS BG RO SK RS TH EG PH GE SM QA TN AM ID SA CL EE CU CY OA BA KZ LT LU LV MD MK OM VN AG AL AO AP AZ BB BH BN BW BY BZ CO CR DO DZ EA EC GH GT HN IR KE KG KH KW LA LC LK LR LS LY MC ME MG MN MT MW MX NG NI PA PE SC SD ST SV SY TJ TM TT UZ VC ZW
ES		MX IB PE CL CO DO PA CR CU EC GT HN NI SV
FI		IB
IL	US IB	GE
IN		IB IR
JP	US IB TH SG MY KR PH ID BN	KH LA VN
KR	IB NZ	US SG MY AU PE PH TH CL ID LK MN MX SA VN
RU	US IB BG AZ EA SA LV CO ID LT MA	UA KZ BY RO GE MD VN UZ AM CU IR KG KP MG MN OA SY TJ TM ZW
SE	NO FI DK BR IN KE MA MX	IB AP BB GH IS LK LR MG OA TT VN ZM
SG	US IB JP ID MX	KH TH VN
TR		IB
UA	IB	
US		IB IL IN BR NZ CL TH MX EG ZA PH OM PE BB BH DO GE GT LC PA QA TT VC
XN	NO DK IB SE	IS
XV	HU PL CZ IB SK	

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