

## **Patent Cooperation Treaty (PCT) Working Group**

**Eleventh Session  
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### **SYSTEMS TO ASSIST NATIONAL PHASE ENTRY**

*Document prepared by the International Bureau*

#### **SUMMARY**

1. The International Bureau seeks feedback on directions for the development of systems which could be supported by Offices and applicants to assist national phase entry. Options include either restarting work on the browser-based service discussed by the Working Group in previous sessions, or offering improved machine interfaces for third party patent management software, or a combination of both. For any arrangement to be useful, it will require designated Offices to commit to importing the necessary bibliographic data in a consistent machine-readable format, preferably accompanied by associated documents.

#### **BACKGROUND**

2. In document PCT/WG/7/12, the International Bureau outlined a concept for using ePCT to trigger national phase entry. The proposal was based on the fact that most of the information required to enter the national phase is already contained in the International Bureau's databases.

3. Transcribing information manually from the international application into national forms, to be again transcribed into national Offices' systems, involves significant unnecessary work for both applicants and Offices. Each stage brings a risk of introducing errors, which can be difficult and expensive to spot and correct. Further possibilities for error might occur from Offices basing their actions on data from the International Bureau's data feeds and accidentally overlooking deliberate changes which appear in a submitted form.

4. ePCT offers a free, multi-lingual environment which allows the agent for the international phase to share information securely with trusted partners anywhere in the world. It also allows draft actions to be prepared by one person and reviewed by others before submission. The access model is very flexible; an “eOwner” (normally, the person who originally filed the international application or someone to whom that role has been explicitly passed) gives appropriate levels of rights to other account holders according to the needs of a specific application. Consequently, collaborations can be set up between patent attorneys, translation professionals and paralegals within a single firm or anywhere else in the world, based on their trusted relationship in relation to one or more specified international application, without affecting access to other international applications.
5. The proposals in document PCT/WG/7/12 envisaged national phase entry requests being prepared by supplementing the data already available in the International Bureau’s database with further documents and data, such as:
  - (a) the name and address of the agent responsible for the relevant national phase;
  - (b) any required translations or transliterations of the title of the invention and other names and addresses; and
  - (c) translations or amendments for the purposes of the national phase.
6. Using a common drafting portal in this way would eliminate the need to re-enter data which had previously been supplied in the international phase. A national phase agent could add the necessary documents and data in a way which would allow the applicant or international phase agent to verify that their requirements were met and correct any errors or misunderstandings before the national phase agent transmitted the package containing the documents and data to the designated Office, preferably together with the payment of any national fees.
7. While a number of designated Offices expressed interest in beginning a pilot, it did not appear that many designated Offices would commit to accepting the receipt of such packages from ePCT as a normal part of their workflow. Moreover, representatives of agents expressed concern that the system would encourage applicants to make national phase entries for themselves, bypassing the local agents and risking loss of rights by failing to properly take into account the local procedural requirements and substantive drafting issues, or by using poor quality and unverified translations.
8. Some functions were made available in the ePCT Demo environment to demonstrate the concept of adding, sharing and reviewing documents and data prior to delivery of a package. However, in view of the limited support from Offices and agents, further development of the system towards commencing a realistic pilot has not been given significant priority.
9. In the meantime, there have been further developments, both within ePCT and in the broader patents IT context:
  - (a) The International Bureau has developed a number of web services, which it is testing with selected applicants and Offices with a view to allowing providers of patent management software to interact securely with the International Bureau (see especially paragraph 6 of document PCT/WG/11/9).
  - (b) The netting pilot offers the possibility that the International Bureau may become able to handle payments of fees due to other Offices (see document PCT/WG/11/4).

- (c) The Committee on WIPO Standards has begun work on a task to prepare recommendations for web services on IP information and documentation (see document CWS/5/15).
- (d) At the Meeting of Intellectual Property Offices on ICT Strategies and Artificial Intelligence, which took place in Geneva from May 23 to 25, 2018, Offices discussed the possibility of developing common application programming interfaces (APIs) which encourage third party software providers to develop interfaces to exchange data more effectively with a wide range of Offices (see paragraphs 57 to 60 of document WIPO/IP/ITAI/GE/18/3).
- (e) In the normal case of national phase entry from a published international application, some Offices now use data from PATENTSCOPE web services to pre-populate a web form on their own website for requesting national phase entry.
- (f) A significant proportion of international search reports are now delivered in XML format, offering the possibility of adding services to meet national requirements going beyond pure national phase entry, concerning disclosure of prior art.

## **NEXT STEPS**

10. The International Bureau continues to consider that there are benefits for applicants and Offices alike in eliminating the need for applicants to re-enter data which has already been provided in the international phase when entering the national phase. To be beneficial, any such arrangements need to:

- (a) be usable for a significant number of designated Offices;
- (b) eliminate the need for either applicants or Offices to transcribe information which has previously been provided to the International Bureau;
- (c) assist applicants and agents in different countries in working together effectively; and
- (d) minimize the risk of incorrect data being used by Offices as a result of trying to combine electronic data feeds with forms containing information, for example, when information in the forms supersedes equivalent information in the data feeds and consequently requires manual transcription by the Office.

11. One option for work in this area would be to resume development of the functionality which has been begun in ePCT, as described in paragraph 8, above. This approach would have the benefit that there would be no need for agents in different countries to ensure that their patent management software was compatible. The ePCT system is web-based, freely available to anyone and has 10 interface languages. It would also have the benefit of ensuring that a single data package standard would be implemented at all participating designated Offices. Depending on the corresponding services implemented by designated Offices, it should also have the benefit of significantly improving the centralized information available to the applicant concerning the current state of national phase processing for the application.

12. A second option would be to concentrate more on providing services for export of data into users' patent management software with a view to populating their local software with the necessary information to prepare according to local standards. The service already offers the possibility of exporting XML data containing almost all of the international phase bibliographic information which could be relevant. This approach would have the benefits of being straightforward to implement for the International Bureau, but it would rely on multiple vendors

of patent management software setting up services to import the data. Moreover, it would be unlikely to deliver consistent, machine-readable data to designated Offices, unless the arrangement was part of a larger process of standardization of national Office data import standards.

13. These two options are not mutually exclusive. Most of the centralized work for the second option has already been done. The further work by the International Bureau would essentially be limited to reviewing the existing data feeds to ensure that they are complete (the main elements known to be missing relate to Chapter II processing) and that the pilot machine interfaces which have been implemented for automatic extraction of the data by patent management systems are appropriate and suitable for adoption as a long-term, stable feature of the system. Many national agents might prefer the second option if it were well supported by third party software. On the other hand, also having the centralized service would provide an option open to agents lacking support in their own software and also give a “reference implementation” which could serve to assist developments by others.

*14. The Working Group is invited to comment on the appropriate direction of further work relating to assisting national phase entry.*

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