

# WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES  
UNDER THE PATENT COOPERATION TREATY (PCT)

Seventeenth Session  
Rio de Janeiro, February 9 to 11, 2010

INPUT INTO THE STUDY ON THE FUTURE OF THE PCT

*Document prepared by the International Bureau*

## SUMMARY

1. As agreed by the Working Group at its second session, the International Bureau will prepare a study on the future of the PCT for consideration by the Working Group at its next session. This study will outline the background of the need to improve the functioning of the PCT system, identify existing problems and challenges facing the PCT system, analyze the causes underlying the problems and identify possible options to address the problems and evaluate the impact of those proposed options. Circular C. PCT 1196 requested information from States, Offices and other interested parties to assist in assessing the various needs and the impact of different possible measures which might be taken to address those needs. The International Authorities are invited to provide further information and comment on some of these matters, especially on issues which are strongly related to the work of International Authorities, as set out below.

## BACKGROUND

2. The sixteenth session of the Meeting and the second session of the PCT Working Group considered memoranda by the Director General (documents PCT/MIA/16/9 and PCT/WG/2/3, respectively) inviting International Authorities and Member States to consider what should be done to help the PCT meet the expectations of Member States, applicants seeking to protect their inventions and other interested parties.

3. The second session of the Working Group concluded with the agreement that work should continue on improving the PCT, in accordance with the following principles and approaches (paragraphs 94 to 96 of document PCT/WG/2/14):

“94. The Meeting agreed that the relevant PCT bodies should continue their work to improve the PCT. The Meeting agreed that the PCT system can and should function more effectively, within the existing legal framework of the Treaty provisions,

“– to deliver results which meet the needs of applicants, Offices and third parties in all Contracting States;

“– without limiting the freedom of Contracting States to prescribe, interpret and apply substantive conditions of patentability and without seeking substantive patent law harmonization or harmonization of national search and examination procedures.

“95. The Meeting agreed that the relevant PCT bodies should discuss ways in which the objective set out in paragraph 94, above, could be achieved,

“– taking an incremental approach;

“– in a member-driven process, involving broad-based consultations with all stakeholder groups, including regional information workshops;

“– taking into account the recommendations contained in the WIPO Development Agenda;

“– taking into consideration the topics addressed in the draft roadmap proposed by the International Bureau in document PCT/WG/2/3, subject to the discussions set out in the Working Group’s report, taking note of certain concerns expressed by Contracting States, and taking note of any other topics which Contracting States may wish to address in order to achieve the objective set out in paragraph 94.

“96. The Meeting agreed that the work set out in paragraph 95, above, should be informed by an in-depth study factoring in, but not limited to, the following elements:

“– outlining the background of the need to improve the functioning of the PCT system;

“– identifying the existing problems and challenges facing the PCT system;

- “– analyzing the causes underlying the problems;
- “– identifying possible options to address the problems;
- “– evaluating the impact of the proposed options;
- “– defining and clarifying concepts, such as ‘duplication of work’, ‘unnecessary actions’ etc.”

4. Since the second session of the PCT Working Group, there have been significant advances towards some of the goals expressed in the Director General’s memoranda:

(a) All International Authorities have either stated their intention not to repeat search work performed by them in the international phase when an international application for which they were International Searching Authority enters the national phase, or else have begun reviews of their procedures for establishing international search reports.

(b) Several notices of incompatibility with certain PCT Regulations have been withdrawn and the International Bureau has received enquiries from Offices who are in the process of reviewing such notifications of incompatibility and even reservations under the Treaty itself to determine whether they are still required.

(c) The Trilateral Offices (European Patent Office, Japan Patent Office, United States Patent and Trademark Office) have agreed to begin pilot projects under which PCT work products will be used for the purposes of work sharing under the so-called bilateral Patent Prosecution Highway<sup>1</sup> (“PPH”) arrangements.

#### NEXT STEPS

5. The third session of the PCT Working Group, to be held in June 2010, will discuss the study by the International Bureau referred to in paragraph 96 of document PCT/WG/2/14.

6. In order to assist the International Bureau in the preparation of that study, it has sent out a Questionnaire in November 2009 (Circular C. PCT 1196), requesting information and views from Offices, Contracting States and other interested parties on the future of the PCT system. During the present session of the Meeting of International Authorities, the International Bureau will report orally on the responses which have been received to the Questionnaire sent out by way of Circular C. PCT 1196 and give a summary of any themes and conclusions which seem likely to be included in the study requested by the Working Group.

7. As agreed by the Working Group at its second session, the study, besides outlining the background of the need to improve the functioning of the PCT system, identifying the existing problems and challenges facing the PCT system, and analyzing the causes underlying the problems, will also identify possible options to address the problems and evaluate the impact of those proposed options.

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<sup>1</sup> <http://www.trilateral.net/news/Conference2009/pct-pph.pdf>

8. Some of these possible options will be based on areas of work set out in the draft roadmap contained in document PCT/WG/2/3. Others may be based on comments or new proposals made by Contracting States, for example, in response to the Questionnaire sent out by way of Circular C. PCT 1196.

9. A third party observation system was one of the concrete suggestions set out in document PCT/WG/2/3 which gained widespread support as one possible additional feature which could help in addressing the problems and challenges facing the PCT system. A draft proposal on this subject is set out in document PCT/MIA/17/2, and International Authorities are invited to comment on that proposal to assist the International Bureau in the preparation of the study and refining the proposal for possible presentation to the PCT Working Group.

10. Some other issues and possible options are set out below, for which the International Bureau believes that it requires further information from International Authorities before it can present a useful commentary or set of proposals to the Working Group. It should be noted that this list of issues should not be considered exhaustive. International Authorities are invited to introduce further issues which they consider important to ensuring that the PCT meets the needs of all interested parties and which they consider would benefit from discussion by the Meeting, even if these issues have also been addressed in their response to Circular C. PCT 1196.

#### Making International Search and Preliminary Examination More Useful

11. Work in this area has been going on for some time in the Meeting of International Authorities and elsewhere, for example, in the work relating to establishing quality management systems for International Authorities and seeking to ensure that the PCT minimum documentation helps to ensure that the scope of international searches is sufficiently broad as to be of use to applicants, third parties and designated Offices.

12. Document PCT/MIA/16/3 set out a variety of further questions which could be considered in this area. The main areas which were considered of immediate interest by the sixteenth session of the Meeting were:

(a) Giving adequate opportunity for dialog in Chapter II proceedings by guaranteeing at least one written opinion and opportunity to respond prior to establishment of a negative international preliminary report on patentability, provided that the applicant had made a meaningful amendment or argument in response to the written opinion of the International Searching Authority. This would encourage the use of Chapter II in the case where the applicant saw a positive benefit in entering the national phase with a “clean” international preliminary report on patentability, for example to gain the full benefits of a PPH arrangement or where this could otherwise reduce the amount of parallel national processing likely to be needed (as opposed to the case where the system was used solely to “buy time”, which was the reason for modification of the time limit in PCT Article 22(1)).

(b) Introducing “top-up” searches. This was initially raised in the context of conducting such a search as part of any Chapter II proceedings, but was also considered in the context of delaying the main international search, at least in some cases, to a time when most of the “secret prior art” would already be available. The latter approach has clear benefits for Offices in allowing a fuller international search to be conducted in a single action, but also drawbacks because it would mean that no search information would be available at the time of

international publication to support the appraisal of international applications, which is important to third parties and to some applicants. Furthermore, delaying the international search would also create difficulties for supplementary search and international preliminary examination within the existing international phase, which most Member States which have expressed an opinion consider should not be further extended.

(c) Introducing third party observations (see document PCT/MIA/17/2).

13. Document PCT/MIA/16/3 also asked whether the definition of prior art for the purpose of the international search and whether the required contents of international preliminary reports on patentability could be improved to help applicants, designated Offices and others to determine whether the international application would meet the requirements of the individual national laws of PCT Contracting States. No action was considered to be required at the time, but this issue will need to be reviewed again in the context of any further information from Contracting States on the extent to which international reports are presently found to be useful.

#### Collaborative Search and Examination.

14. In the sixteenth session of the Meeting (document PCT/MIA/16/15, paragraph 29) and the second session of the Working Group (document PCT/WG/2/14, paragraphs 61 to 64), several Offices welcomed the proposals for trials of collaborative international search and preliminary examination work as a meaningful step towards improving the quality of the international search which was worth further exploration. On the other hand, some Offices expressed the concern that this would not be efficient and effective, for example, because it would significantly increase initial costs of the application and might reduce the incentive for any individual Authority to perform its search to the very highest standards. These Offices generally considered that resources would be better used on improving technical facilities for searching documents in languages with which the examiners of the main International Searching Authority are not familiar.

15. Furthermore, a number of Contracting States expressed concerns about the possibility that there would be pressure to accept the results of such a search and examination as binding in the national phase. It should be emphasized that, in accordance with PCT Articles 25(5) and 33(1), no international report can be binding on a Contracting State in matters of substantive law. The aim could and should only be to improve the quality of reports to a point where national Offices have a greater degree of confidence in issues (especially relevant prior art) having been reliably identified which could affect the patentability of the claimed invention under their national laws.

16. Given the expense to the applicant and the resources which would be involved in conducting a collaborative international search and/or preliminary examination of an international application, the International Bureau believes that such an approach, even if found to be practical and useful in trials, should, at least initially, only be implemented formally in the system as an option for applicants in cases where they believe that it would be useful. It should not be considered as the "standard" way of using the PCT since this would make the system less accessible to some applicants and would probably increase the overall burden for Offices.

17. It is understood that some International Authorities are interested in conducting a live pilot of procedures for working together. This could be done under the PCT by any group or groups of International Authorities without any changes to the Rules or specific decisions from the Assembly, provided that the end work products remain the responsibility of the International Authority designated by the applicant and, where the work is carried out on international applications which have not yet been published, the applicant gives his permission for the application to be shared with the other Authorities. Any pilot projects should provide insights on the ways in which a formal system in the future could be integrated into and made useful under the Treaty, and give a useful evaluation of possible procedures and what would be needed to support them. The following paragraphs contain some preliminary considerations for making such trials appropriate and effective.

18. *In relation to effect*, it should be clear that the international search and international preliminary report on patentability have the same effect as if they had been established by the main International Authority which was competent in accordance with Rule 35 or Rule 59. On the other hand, it needs to be made clear either on the reports themselves or in a way which can otherwise be made clear to interested designated Offices that the report was in fact produced in collaboration with specified other Authorities, so that they are able to evaluate what difference in quality and scope can be perceived compared to a typical report.

19. *In relation to ensuring appropriate participation:*

(a) It seems likely that a sufficient number of applicants would strongly welcome their applications being used as part of such a trial, provided they were not required to pay any additional international search fees and were able to nominate the specific applications which would be used (noting that it is likely that the collaboration would introduce at least some delay, which might result in difficulty meeting the normal time limits for international search under Rule 42). To maximize the chances of getting sufficient participants to allow a meaningful study, it might be worth International Authorities considering participating in any such trial as being a development investment and not to require additional fees to be paid at that stage.

(b) Both in order to reduce the overall cost of the trials and to ensure that they can be evaluated properly, there should be some attempt to select international applications which are reasonably likely to enter the national phase in all of the Offices participating in the trial, as well as at least one or two others. On the other hand, it would also be desirable for the trials to take place in a range of different subject matter areas (which may face different searching problems) and from different applicants in different original languages.

20. *In relation to the aims and conduct of a trial:*

(a) Any trial should aim to evaluate at least the following:

(i) the extent to which a collaborative approach between Offices can produce an increase in quality of final report;

(ii) the difficulties which are found in working together in different ways and whether technical solutions could be put in place to overcome them effectively;

(iii) the likely cost of such an approach, so that this can be evaluated against the benefits to applicants and to designated Offices (including both the Offices which act as part of the collaboration in their role as International Authority and to other Offices).

(b) If multiple trials are conducted, they should ideally be set up in different ways and attempt to assess the pros and cons of different styles of collaboration.

(c) In order to properly distinguish this process from supplementary international search, the procedure should be set up so that all International Authorities participating in the trial make their contribution before the final report is established. Different trials might adopt different processes, such as largely consecutive processing with interaction only to the extent of viewing draft reports and asking specific questions before the final report is established by a single examiner, or else a highly interactive process with discussion between examiners even before any search is actually started.

21. *In order to produce results from the trial* which can be of broad interest to all International Authorities and designated Offices:

(a) Any trial should include Offices with a good range of different official languages.

(b) At least one trial should be between Offices of significantly different size and in significantly different time zones.

#### Accessibility of International Search and Preliminary Examination.

22. The PCT system already offers a major benefit to small inventors who seek international protection in that it significantly delays the need to pay all of the costs of using the individual national systems, including official fees and representation and translation costs. Moreover, the system has, since 1999, offered fee reductions as additional assistance for certain applicants from developing and least developed countries.

23. Nevertheless, there have been many calls to make the system more accessible to certain types of applicants, including those from developing countries, SMEs and universities. The International Bureau has been asked to present a study to the next session of the PCT Working Group on fee issues. Depending on feedback received, including responses to Circular C. PCT 1196, comments from the Meeting and any additional informal comments, the International Bureau would also like to offer proposals or discussion papers on other ways of making the system more accessible to applicants who cannot currently easily use it, whether because of costs or other barriers. Such discussions may need to cover both the direct costs and accessibility of the international phase, but also costs, activities and barriers at the national level.

24. Suggestions are welcome on how improvements might be achieved. Some examples of possible areas for consideration include:

(a) The level and availability of fee reductions, both in the international filing fee and in International Authorities' fees.

(b) The range of International Authorities competent to act as International Searching Authority or International Preliminary Examining Authority in any particular case – this has an effect on languages which can be used as well as fees and perceptions of quality.

(c) Ways to allow a greater range of languages of filing by applicants with direct support of such languages by International Authorities with the necessary language skills amongst their examining staff.

(d) The type of training on PCT and patents matters which is made available in particular countries with the assistance of the International Bureau or other international partners, including activities to develop the capacities of national Offices and institutions to provide high quality assistance to inventors and investors from their States.

#### Other Matters

25. Comments are also welcome on any other issues which are considered relevant to appropriate ways of developing the PCT to meet the current needs of applicants, Contracting States, Offices, third parties and other interests. These could be matters which require international action, or else ones which can be addressed directly by individual Contracting States, Offices or applicants, yet might benefit from international discussion.

*26. The Meeting is invited to comment on the possible options designed to address the problems and challenges facing the PCT system set out in this document.*

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