

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

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### **THE eSEARCHCOPY/PCT PAPERLESS SERVICE AT THE EUROPEAN PATENT OFFICE**

*Document prepared by the European Patent Office*

#### **SUMMARY**

1. This document describes the eSearchCopy service at the European Patent Office. A pilot program of the service with a limited group of receiving Offices ran from July 2015 to August 2016. In cooperation with the International Bureau, the European Patent Office intends to extend the service in a phased rollout to other interested receiving Offices meeting the necessary requirements.

#### **BACKGROUND**

2. 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 the 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.

3. Desiring to implement a flawless and cost-efficient mechanism to transmit search copies from 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.

4. Following this pilot, the EPO intends, in cooperation with the International Bureau, to extend this new service to any interested receiving Office meeting the necessary requirements, with a view to progressively abandoning search copy transmittal via surface mail.

### **PCT PAPERLESS CONCEPT**

5. 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.

6. 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 has 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.

7. 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.

8. 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.

### **FRAMEWORK FOR THE TRANSITION TO PCT PAPERLESS**

9. Prior to allowing a receiving Office to switch to the PCT Paperless transmittal process, it should be ascertained that such transition would not jeopardize legal certainty. Therefore, for every receiving Office interested in switching to the PCT Paperless transmittal process, the transition will be preceded by a short evaluation phase which usually lasts a couple of months.

10. 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.

11. 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 the required set of conditions. 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.

12. 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.

#### **PROGRESSIVE EXTENSION OF THE PCT PAPERLESS SERVICE**

13. The EPO and the International Bureau have already been contacted by many receiving Offices interested in joining 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. More specifically, the extension of the PCT Paperless service will follow a phased rollout per groups of around three or four receiving Offices. It follows that, in 2017, the EPO has planned to extend the PCT Paperless service to three groups which amount to a total of around 10 receiving Offices.

14. 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](mailto:international_pct_affairs@epo.org).

*15. The Working Group is invited to note the contents of the present document.*

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