

# WIPO



PCT/WG/2/11

ORIGINAL: English

DATE: April 24, 2009

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

PATENT COOPERATION TREATY (PCT)  
WORKING GROUP

Second Session  
Geneva, May 4 to 8, 2009

THREE TRACK PCT SYSTEM

*Document prepared by the Republic of Korea*

## SUMMARY

1. Major IP offices in the world currently face a common challenge, namely an increasing backlog due to the growing number of patent applications. To cope with this challenge, the offices have launched work-sharing projects such as the Patent Prosecution Highway (PPH). The adoption of new work-sharing projects has merits. However, at the Korean Intellectual Property Office (KIPO), we think the PCT should play a vital role in enhancing work-sharing between offices. Accordingly, the International Bureau's PCT Development Roadmap is timely. We believe the Roadmap will make a significant contribution to the development of the PCT.

2. KIPO's proposal contains measures that could encourage more applicants to use the PCT. The measures attempt to meet various needs of applicants and should eventually alleviate the workload of designated offices. KIPO hopes that this proposal is incorporated into the Roadmap and discussed in detail among offices.

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## BACKGROUND

3. Informal consultations with PCT users in Korea reveals that different groups of PCT users see benefits in different aspects of the PCT system. Unfortunately, the PCT does not fully meet the needs of all users, especially those who seek faster protection of their rights. As a result, international applications are often filed via the Paris route and the PPH.
4. Due to the rapid advancement of technologies, more applicants are demanding a faster patent process so that they can lead the market.<sup>1</sup> To meet this demand, many offices have adopted an accelerated examination system. In some cases, offices have introduced new examination tools, such as the super-accelerated examination system. More offices are also adopting the PPH, which is the preferred method of applicants who want fast patent protection abroad.
5. In view of this trend, the PCT should reflect the strong demand of users who seek expedited decisions on their patent applications.
6. One idea in the Roadmap is that international applications with positive examination results should be given the incentive of an accelerated examination in the national phase. We think this is a very useful idea but doubt whether it would fully satisfy the needs of applicants who seek fast patent protection abroad. Under the current PCT system, for example, it usually takes nine months to receive an international search report (ISR), even if an international application is filed as a first filing. An international preliminary examination (IPE) takes even longer, namely 28 months from the priority date.
7. Some users seek to obtain examination results as soon as possible from the office of first filing (OFF) by requesting an accelerated prosecution; they then try to expedite the patent process at the office of second filing (OSF) by using the PPH. Unfortunately, in contrast to national patent systems, the current PCT system has no accelerated examination procedure. We believe therefore that the PCT needs an optional accelerated procedure.

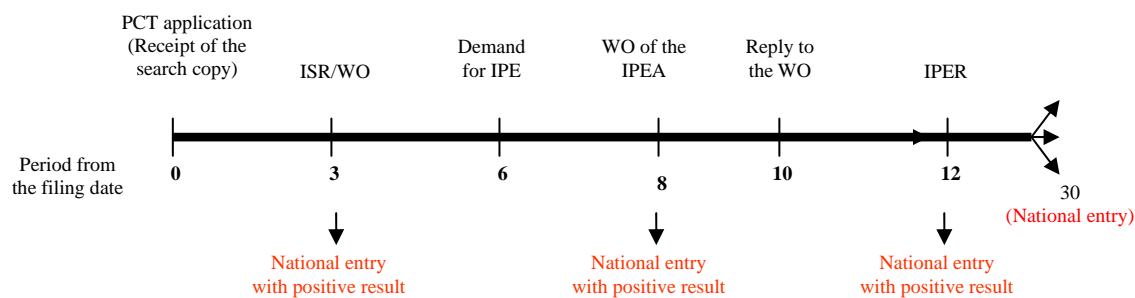
## INTRODUCTION OF AN ACCELERATED PROCEDURE

8. KIPO would like an optional accelerated procedure to be included in the PCT so that applicants can obtain patents more quickly. Our proposal for the optional accelerated procedure includes the following recommendations: that international searches be conducted within three months of the date on which the search copies are received; that international preliminary examinations be requested within three months of the date on which the ISR and written opinions are transmitted; and that international preliminary examinations be completed within six months of the commencement of the examination, regardless of the priority date.

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<sup>1</sup> At KIPO, accelerated examinations constituted 8.7% of all applications in 2008. That is up from 3.0% in 2004 and 0.8% in 2000.

9. Under the proposed accelerated procedure, applicants should receive the ISR and written opinions within three months of the international filing date and the international preliminary examination report (IPER) within 12 months of the international filing date. One way of implementing the proposed procedure is to simplify the regulations for the time limit of the existing PCT procedure. That would enable the procedure to be introduced with minimal change to the international legal framework. The table in section 10 compares the current regulations with the proposed regulations.



10. The details of the proposed accelerated PCT procedure are as follows:

Related regulations	The current PCT system	The accelerated PCT system
Time Limit For International Search (Rule 42.1)	Three months from the receipt of the search copy or nine month from the priority date	Three months from the receipt of the search copy <del>or nine month from the priority date</del>
Time Limit for Amendment of the Claims before the IB (Rule 46.1)	Two months from the date of transmittal of the ISA or 16 months from the priority date	Two months from the date of transmittal of the ISA <del>or 16 months from the priority date</del>
Time Limit for Making a Demand (Rule 54bis.1)	Three months from the date of transmittal to the applicant or 22 months from the priority date	Three months from the date of transmittal to the applicant <del>or 22 months from the priority date</del>
Start of International Preliminary Examination (Rule 69.1)	In possession of the demand, fee, ISR etc.	Ditto
Time Limit for International Preliminary Examination (Rule 69.2)	28 months from the priority date, six months from the starting time of the IPE or six months from the date of receipt of the translation	<del>28 months from the priority date</del> , six months from the starting time of the IPE or six months from the date of receipt of the translation
Time Limit for the reply to the WO of the IPEA (Rule 66.2)	Normally two months after the date of notification	Ditto
Written opinion in Chapter II	-	Issuance of at least one WO in Chapter II in the case of a negative IPRP

11. Users and offices can expect the following benefits from the accelerated PCT procedure:

Benefits for users:

(a) The accelerated PCT procedure and subsequent accelerated examination in the national phase will satisfy the need for early protection of applicants' rights.

(b) Applicants in developing countries or least developed countries may have no opportunity to use the PPH via the Paris route because the substantive examination capacity of those countries may be minimal. The accelerated PCT procedure will enable those applicants to get patents faster in the national phase through the PCT.

Benefits for offices:

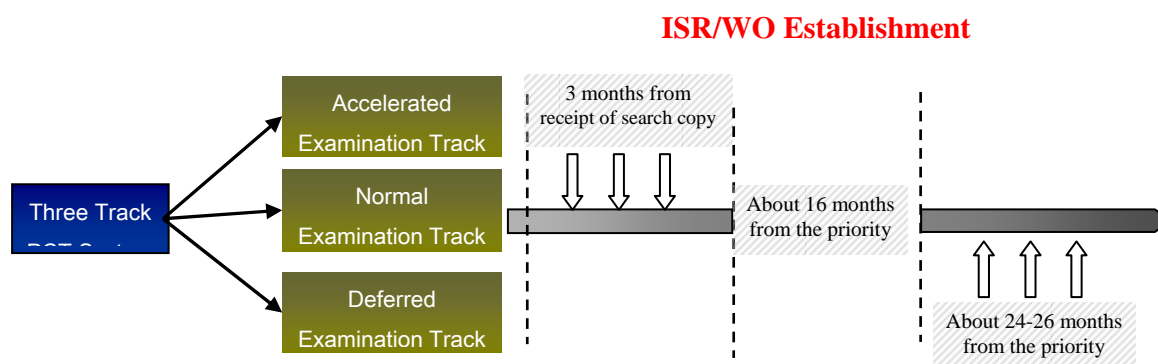
(c) The accelerated procedure will encourage applicants to file a PCT application as a first filing, which in turn will help reduce parallel applications and prevent unnecessary duplication of work.

(d) By encouraging more applicants, especially non-PCT applicants, to use the PCT system, the accelerated procedure can expand the work-sharing between offices, which is the *raison d'être* of the PCT system.

### THREE OPTIONS FOR APPLICANTS

12. We propose a three-track PCT system with regard to the time limits of the ISR and IPER. Under this system, applicants can choose one of the three examination tracks: accelerated, normal, or deferred. The accelerated examination track refers to the accelerated procedure outlined above. The normal examination track refers to a regular examination under the current PCT system. The deferred examination track refers to the option proposed by Japan (PCT/WG/2/8). That option includes the establishment of the ISR/WO after the international publication as well as the possible introduction of a system for third party observation.

13. With more user options, the proposed three-track PCT system is expected to attract more applications to the PCT. It will result in the increased number of patent applications supplied with the PCT ISR, thereby reducing the workload of the designated offices. Applicants can choose a suitable PCT track in accordance with their patent strategies, the life-cycle of their inventions, the commercial viability of their inventions, and so on.



## INCORPORATION OF KIPO'S PROPOSAL INTO THE ROADMAP

12. We hope that our proposal will be fully discussed among the offices and eventually incorporated into the Roadmap. We suggest that the section titled "Three options for applicants" be incorporated into the "Area of Work" section, as described in below:

### “Three options for applicants

“The PCT could be more responsive to the needs of a wide range of users: different sectors have significantly different needs and see different benefits from different aspects of the PCT. It is important therefore to offer various types of examinations tailored to the particular needs of users. In addition to the normal examination process, users with a more urgent need to acquire a patent could benefit from the accelerated examination, while users who wish to have high quality examinations could take their time with a deferred examination. Under the proposed three-track PCT system, applicants would choose one of the three tracks and the International Authorities would then carry out the examination in accordance with the user's selection.

### “Milestone

“The International Bureau, in cooperation with the offices, will collect feedback from users about the proposed three-track PCT system. On the basis of the feedback, discussions will be held at the MIA and the WG with regard to ways of adopting the proposed three-track PCT system.”

*13. The Working Group is invited to consider the proposals contained in this document.*

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