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Meeting of International Authorities under the Patent Cooperation Treaty (PCT)

**Twentieth Session
Munich, February 6 to 8, 2013**

PROPOSALS TO STRENGTHEN THE PCT

Proposals by the European Patent Office

1. At the fifth session of the PCT Working Group, held in Geneva from May 29 to June 1, 2012, the European Patent Office presented a proposal entitled “Proposals for Further Improvement of PCT Services and Products”, containing proposals for further improvement of the PCT system (document PCT/WG/5/20). The proposals received varying levels of support by the Working Group (see the Summary by the Chair of the fifth session, document PCT/WG/5/21, paragraphs 30 to 32). However, many delegations felt that they could provide only preliminary views on the proposals and noted that more time was needed to carefully study the proposals, to consult with user groups and to consider the possible impact on respective national laws and practices. Following the discussions, the Representative of the European Patent Office agreed to further elaborate on the proposals and to provide more details on how to take the proposals forward, for discussion at the next session of the Working Group.

2. Taking into account the discussions and the comments received during the fifth session of the Working Group, the European Patent Office has prepared a revised version of the original proposals for further improvement of the PCT system. Those revised proposals have been communicated by the International Bureau, by way of a Circular (Circular C. PCT 1364, dated December 20, 2012, Annex II), to Offices of all PCT Contracting States in their capacity as a receiving Office, an International Searching and Preliminary Examining Authority and/or a designated and elected Office under the PCT, to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, as well as to certain organizations that are invited to attend meetings of the PCT Working Group as observers, with the invitation to review and further comment on those revised proposals and, in particular, to consult with user groups on those proposals and to consider the possible impact of those proposals, if adopted, on respective national laws and practices.

3. The content of Annex II to Circular C. PCT 1364, containing the proposals by the European Patent Office, is reproduced in the Annex to this document. It is the intention of the European Patent Office to take any comments received in response to the present document and in response to Circular C. PCT 1364 into account in the preparation of further refined proposals, with a view towards presenting them for consideration at the sixth session of the Working Group, tentatively scheduled to be held in May 2013.

4. *The Meeting is invited to comment on the proposals set out in the Annex to this document.*

[Annex follows]

ANNEX

PROPOSALS TO STRENGTHEN THE PCT

*Proposals by the European Patent Office**(reproduced from Annex II to Circular C. PCT 1364)***SUMMARY**

1. The EPO submitted at the last PCT Working Group meeting a set of proposals aimed at offering new or better services and products to PCT users, and at making the system more efficient also for patent offices.
2. The present document further elaborates on proposals which would require some form of regulatory changes in the PCT framework. The EPO intends to submit the Rule change proposals at the next PCT Working Group meeting in May 2013.
3. The PCT has proven to be a very successful system for the filing and processing of patent applications around the world. In spite of the many improvements to the PCT system made over the past 10 years, the system needs to be further adapted to keep abreast of new IT environments and to meet the challenges facing the global patent system, in particular the need to reduce backlogs and enhance the quality of search and preliminary examination work products, for the benefit of applicants, third parties and patent offices alike.
4. Noting that there is still room for further improvement of PCT services and products within the Treaty framework, the EPO submitted a set of proposals (PCT/WG/5/20) for consideration at the 5th session of the PCT Working Group (Geneva, May 29 to June 1, 2012). Some of these proposals aimed at offering new or better services and products to users, and others at making the system more efficient also for offices.
5. The PCT Working Group provided preliminary views on the proposals set out in the document. While noting that more time was needed to study the proposals carefully, consult with user groups and consider the possible impact on national law, all delegations which took the floor on the matter generally welcomed the initiative taken by the EPO. On that basis, the EPO agreed to further elaborate on the proposals.
6. The present document further elaborates on those proposals which would require some form of regulatory changes, be it in the Regulations under the PCT, in the PCT International Search and Preliminary Examination (ISPE) Guidelines or in the PCT Receiving Office (RO) Guidelines. The EPO intends to submit the proposals for Rule change at the next PCT Working Group meeting in May 2013.

INTRODUCE OPTIONAL TOP-UP SEARCHES IN CHAPTER II

7. At the latest session of the PCT Working Group, the United States of America and the United Kingdom submitted a proposal (PCT/WG/5/11) to amend Rule 66 to make top-up searches compulsory in Chapter II. Some concerns were expressed about the obligatory character of the proposed amendment, and it was noted that recommendations in the PCT ISPE Guidelines might be an alternative. The EPO is in favour of such a flexible approach, giving International Preliminary Examination Authorities the option to introduce top-up searches. A set of proposed amendments to the PCT ISPE Guidelines is enclosed as Appendix I.

INCORPORATE PCT METRICS IN THE PCT ISPE GUIDELINES

8. At the last PCT Working Group meeting, the proposal from the EPO to incorporate metrics in the PCT ISPE Guidelines was supported by many delegations. The aim of this exercise is to retrieve figures and statistics from International Authorities, processed in a standardised manner. The EPO suggests to first gain experience on the proposed "PCT Metrics Framework" tabled at the MIA Quality Sub-Group before implementing this principle in the PCT ISPE Guidelines.

IMPROVE TIMELINESS FOR ESTABLISHMENT OF INTERNATIONAL SEARCH REPORTS

9. It is important for applicants and the International Bureau alike that the search is carried out in time for publication of the application, so that A2 and A3 publications can be avoided. However, the time limit under Rule 42.1 is dependent on the time of receipt of the search copy at the International Searching Authorities, and there is no link between the due date for the establishment of the international search report and the publication date.

10. International Searching Authorities carrying out large numbers of international searches have a high workload and organise it to meet Rule 42.1 time limits. Since the time limit of three months applies irrespective of the publication date, applications received by the ISA relatively early, when publication is still far away but the three-month time limit is close to its end, have higher priority than the ones received relatively late, which are ready for publication but the official time limit is still some time away. ISAs do not have the capacity both to respect the legal time limit and to have the searches ready in time for the A1 publication in all cases. The result is an unnecessary number of A2 and A3 publications, causing additional work and costs for the International Bureau, and inconvenience to applicants.

11. Therefore, with the aim of improving the overall timeliness of A1 publications, the EPO proposes to introduce into Rule 42.1 a link between the 18-month publication date and the time limit for establishing the international search report and the written opinion by the ISA (proposed amendment enclosed in Appendix II). As a result of this change, the time limits for second filings would no longer be determined by the time of receipt of the search copy but by the publication date, resulting in many more searches, if not almost all, being ready for A1 publication. In order for international search reports to be established in time for international publication at 18 months from the priority date, it is suggested to set the time limit at 17 months, which leaves sufficient time for the transmission of the international search report to the International Bureau and the necessary technical preparations for publication.

CLARIFY PRACTICE ON AUTHORISING INCORPORATION BY REFERENCE OF MISSING PARTS

12. Since 1 April 2007, subject to notifications of incompatibility submitted by a number of receiving and designated Offices, PCT applicants have been allowed under Rule 20 PCT to "incorporate by reference", for international filing date purposes, not just parts of the description, claims or drawings but also texts which on the face of it appear to be a description and a claim or claims, where these elements are not otherwise contained in the international application.

13. Since 1 July 2009, new paragraphs 205E and 205F of the PCT RO Guidelines have provided detailed indications as to the way receiving Offices should process requests for incorporation by reference. In particular, paragraph 205F provides for the sequential placing of each of the subsequently filed elements before the originally filed elements. This topic was considered by the Meeting of International Authorities in 2009. By then, Authorities were of the view that it was too premature to provide for detailed procedures concerning the incorporation by reference of missing elements or parts in international applications. The remedy of incorporation by reference had only recently been added to the Regulations, and Offices were still in the process of developing practices and gaining experience as to how best to implement the new provisions.

14. Over the last few years, the EPO as International Searching Authority has noticed that some receiving Offices are applying paragraph 205F in such a way that applicants are allowed to actually file a new application which is unrelated to what was originally filed. In such cases, it is unclear what ought to be searched by the International Searching Authority. In particular, the EPO has been experiencing cases in which it performed the international search on the basis of the application as filed (search copy) and then received, after the international search was established, a communication from the receiving Office allowing the incorporation by reference of a whole new description, set of claims and drawings as a missing part, although they were unrelated to the application as originally filed. The EPO as International Searching Authority was then requested to perform the search again, this time on the basis of the new description, set of claims and drawings.

15. Confirmation of incorporation by reference of a part under Rule 20.6(a) is subject to compliance with Rule 4.18. Rule 4.18 in turn provides that, where a part of the description, claims or drawings referred to in Rule 20.5(a) is not otherwise contained in the international application but is completely contained in the earlier application, that part is, subject to confirmation under Rule 20.6, incorporated by reference. Rule 20.5(a) indicates that an entire element may not qualify as a missing part. As a result, the incorporation by reference, as a missing part, of a whole new description, set of claims and drawings which are otherwise unrelated to the international application as filed is not covered by Rule 4.18.

16. The EPO is thus of the view that current Rules do not provide for the practice described in paragraph 12, and thus suggests to provide further guidance to receiving Offices, in the PCT RO Guidelines, to the effect that they should not authorise the incorporation by reference, as a missing part, of a whole new description, set of claims and drawings which are otherwise unrelated to the international application as originally filed. A set of proposed amendments to the PCT RO Guidelines is enclosed as Appendix III.

[Appendix I follows]

Appendix I

Proposed Amendments to PCT ISPE Guidelines (Top-Up Searches in Chapter II)

1. To be added in the general overview Chapter 3, e.g. after 3.21 as a new paragraph

3.21bis Additional Search for further Relevant Prior Art

The International Preliminary Examining Authority may, at its discretion, perform during Chapter II proceedings a search in order to find further relevant prior art, in particular prior art documents which have been published after the ISR was established and which could become relevant in subsequent national and/or regional proceedings ("top-up search").

It is left to the discretion of each IPEA to decide on the scope of such top-up searches.

2. To be inserted in 19.12, regarding what the basis for examination should be:

19.12 The international preliminary examination is carried out in accordance with Article 34 and Rule 66. A written opinion will normally have been established on the application by the International Searching Authority. Usually this is considered as the first written opinion of the International Preliminary Examining Authority (see paragraph 3.18 for the exceptions to this). The examiner performing the international preliminary examination, if he has not already done so during the international search, studies the description, the drawings (if any), and the claims of the international application, including any amendments and observations which may have been filed, and, if the International Preliminary Examining Authority has opted to perform a top-up search, any further relevant prior art found (see paragraph 3.21bis). He then determines whether a further written opinion (or a first written opinion in the exceptional case where a written opinion of the International Searching Authority has either not been prepared or else is not treated as the first written opinion of the International Preliminary Examining Authority) is required.

3. To be inserted in 19.15, which deals with cases where a further written opinion may be issued:

19.15 Assuming that the written opinion of the International Searching Authority is treated as the first written opinion of the International Preliminary Examining Authority, as noted above no further written opinion need be issued before the international preliminary examination report, even if there are objections outstanding. However, where the applicant has made a credible attempt to overcome or rebut the objections in the written opinion of the International Searching Authority, but failed to satisfy the examiner that all the relevant criteria are met, or where the International Preliminary Examining Authority has opted to perform a top-up search and has found further relevant prior art (see paragraph 3.21bis), a further written opinion may, at the discretion of the International Preliminary Examining Authority, be issued if there is sufficient time available to establish the international preliminary examination report prior to expiration of the time period set in Rule 69.2 for establishment of the international preliminary examination report.

[Appendix II follows]

Appendix II

Proposed Amendment of Rule 42.1 (Timeliness in Establishing the International Search Report)

4. Current text:

Rule 42 Time Limit for International Search

42.1 *Time Limit for International Search*

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be three months from the receipt of the search copy by the International Searching Authority, or nine months from the priority date, whichever time limit expires later.

5. Proposed new Rule 42.1:

Rule 42 Time Limit for International Search

42.1 *Time Limit for International Search*

The time limit for establishing the international search report or the declaration referred to in Article 17(2)(a) shall be:

(a) where no priority has been claimed in accordance with Rule 4.10, three months from the receipt of the search copy by the International Searching Authority, or nine months from the priority international filing date, whichever time limit expires later; or

(b) where a priority has been claimed in accordance with Rule 4.10, three months from the receipt of the search copy by the International Searching Authority, or 17 months from the priority date, whichever time limit expires later.

[Appendix III follows]

Appendix III

Proposed Amendments to PCT RO Guidelines (Clarify Practice Regarding Incorporation by Reference)

205D. **Negative Finding.** Where the receiving Office finds that not all the requirements of Rules 4.18 and 20.6(a) have been complied with or that the part concerned is not completely contained in the earlier application or that the alleged missing part does not qualify as a missing part under Rule 4.18 in conjunction with Rule 20.5(a) (e.g. where both the description (and drawing(s) if any) and claims submitted as missing part are unrelated with the elements originally filed), the receiving Office issues Form PCT/RO/114 accordingly and treats the subsequently furnished sheets as if the incorporation by reference had not been confirmed and proceeds, after the expiration of the time limit under Rule 20.7, as described in Section 309(c) (see also paragraphs 200 to 202). A copy of the notice (Form PCT/RO/114) is sent to the International Bureau and to the International Searching Authority.

205F. ~~Where the An~~ applicant ~~wishes to completely~~ may not replace an element ~~or all elements~~ of an international application as originally filed with a different elements through incorporation by reference of a missing parts~~s, t.~~ The receiving Office may only add any elements of the international application as missing parts but may not perform a substitution of the ~~international application element~~ as filed with the subsequently furnished missing parts. The description, claims or drawings from the earlier application, which are to be incorporated by reference, cannot replace the description, claims or drawings of the international application as filed. The parts to be incorporated by reference (Rule 20.5) should be combined with the elements of the international application originally submitted and should be checked for compliance with the physical requirements referred to in Rule 11 to the extent that compliance is necessary for the purpose of reasonably uniform international publication (Rule 26.3(b)(ii)), including image scanning and OCR by the International Bureau. The receiving Office should invite the applicant to, or, if at all feasible and if the Office so wishes, by way of an ex officio correction, order the pages of the combined international application in such a manner that the sheets incorporated by reference are placed first, sequentially followed by the pages which were originally filed such as in the following examples:

Example 1

Description incorporated from earlier application

Description as originally filed

~~Claims incorporated from earlier application~~

Claims as originally filed

Drawings incorporated from earlier application

Drawings as originally filed

Example 2

Description as originally filed

Claims incorporated from earlier application

Claims as originally filed

Drawings as originally filed

[End of Annex and of document]