

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

Twenty-Seventh Session Gatineau, February 6 and 7, 2020

APPOINTMENT AS AN INTERNATIONAL SEARCHING AND PRELIMINARY EXAMINING AUTHORITY (ISA/IPEA) AND DECLARATION BY RECEIVING OFFICES AS COMPETENT ISA/IPEA

Document prepared by the Indian Patent Office

1. A proposal on this topic (document PCT/MIA/26/12) was presented by the Indian Patent Office to the twenty-sixth session of the Meeting of the International Authorities (MIA) held in February 2019 in Cairo, Egypt. It was again presented to the twelfth session of the PCT Working Group held in June 2019 (document PCT/WG/12/18). The discussions on the proposal at the Working Group are summarized in paragraphs 117 to 127 of the Summary by the Chair (document PCT/WG/12/24). Paragraphs 255 to 276 of the Report of the twelfth session of the Working Group, document PCT/WG/12/25, provide a full record of these discussions. Paragraph 127 of the Summary states:

“127. The Working Group invited the Delegation of India to prepare a document for discussion at the twenty-seventh session of the Meeting of International Authorities, taking into account the comments made by delegations at the present session of the Working Group and any further consultations on the proposal with delegations, notably those representing IP Offices which acted as International Searching and Preliminary Examining Authorities.”

2. One of the notable outcomes of the discussions at the last Working Group was that several representatives of user groups supported the general idea of the proposal to provide the applicant with more choice of International Authorities, noting that a free choice of an Authority would be fairer to applicants than a choice that depended on the receiving Office selecting the competent Authority (see paragraph 126 of document PCT/WG/12/24).

3. Competition aids in improving the quality of services, which is beneficial not just to the applicants but also to the whole PCT System. Providing the applicants a free choice of ISA/IPEA simplifies and renders more economical the obtaining of protection for inventions

where protection is sought in several countries, as desired by the Contracting States in the Preamble to the Patent Cooperation Treaty. This also obviates the need for bilateral negotiations between the International Authorities and the Receiving Offices within the framework of the multilateral PCT System.

4. During the twelfth session of the Working Group, the delegations representing the Contracting States of the European Patent Convention raised concerns that implementation of the Proposal may require revision of the Protocol on Centralisation (see paragraph 124 of document PCT/WG/12/24).

5. Some Authorities highlighted the concerns regarding the predictability and management of workload when a free choice is given to the applicants. Concerns were also raised regarding the changes required in IT systems and setting up infrastructure for information exchange with new Receiving Offices. One of the delegations suggested that a pilot project could study the practicalities of the proposal (see paragraphs 120 and 121 of document PCT/WG/12/24).

6. To overcome these concerns, the Indian Patent Office suggests that the implementation of the proposal could be best done initially without amending the PCT Regulations as this would provide enough time for the Authorities and the receiving Offices to overcome the challenges in implementation. As a way forward, the International Authorities who are ready may amend Annex A of the Agreement between the IP Office and the International Bureau in relation to its functioning as an ISA/IPEA under Articles 16(3) and 32(3) to state that the International Authority is willing to act as an ISA and IPEA for international applications filed at the receiving Office of any Contracting State. To ensure that the workload is manageable, the International Authorities may consider limiting the number of search requests accepted in a particular language from each receiving Office. In addition, any receiving Office that is ready to specify any willing ISA/IPEA to be competent for international applications filed at that Office will be required to amend Annex C to the *PCT Applicant's Guide* to state all the ISA/IPEAs that have specified in Annex A of their Agreement with the International Bureau that they will act as ISA/IPEA for international applications filed at any receiving Office. For the longer term, Member States should continue to assess options for broadening the choice of ISA/IPEA for applicants, taking into account the experiences of the Offices voluntarily extending the options available.

7. It may be noted that the Regulations would continue as they exist today and the changes are required only in the actions taken by the Offices. At the time of the publication of the 3 millionth international patent application under the PCT on February 2, 2017, the Director General published a Memorandum titled "The PCT System - Overview and Possible Future Directions and Priorities" (reproduced in Annex I to document PCT/WG/11/5). The introduction to the Memorandum suggests that the primary route to address the issues facing the PCT "is to put renewed emphasis on the 'Cooperation' element of the Treaty, mostly requiring changes to the behavior and actions of Offices (including the International Bureau) rather than significant changes to the legal framework". Paragraph 78 of the Memorandum discusses ISA choice, and concludes: "Consideration thus needs to be given to how to maintain quality and consistency and whether competition between Authorities might serve a role to achieve this goal. While some Offices have a natural role for some applications as a result of language competence, a review in principle of how competence as an ISA is defined may be opportune at this stage".

8. *The Meeting is invited to comment on the way forward suggested in paragraph 6 of the present document.*

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