

Patent Cooperation Treaty (PCT) Working Group

**Twelfth Session
Geneva, June 11 to 14, 2019**

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

Document prepared by India

1. A proposal on this topic (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.
2. Discussions on the proposal at the twenty-sixth session of MIA are summarized in the paragraphs 47 to 53 of the Summary by the Chair (PCT/MIA/26/13, reproduced in the Annex to document PCT/WG/12/2) as follows:

“47. Discussions were based on document PCT/MIA/26/12.

“48. The Indian Patent Office indicated that the proposal in the document was aimed at making the PCT services more accessible and useful to the applicants. Under the existing practice, the requirements and the procedure for appointment as International Authority were common for all offices seeking appointment. Furthermore, each receiving Office (RO) specified the International Searching and Preliminary Examining Authorities competent for the search and examination of international applications filed with such Office. This was applicable to the international applications filed with the International Bureau as RO by its nationals/residents. Thus, the applicant could choose only those ISAs and IPEAs that were declared competent by the receiving Offices of the country of the applicant’s nationality/residence.

“49. The Indian Patent Office continued by stating that, under the existing mechanism, any applicant from any of the Member States could not utilize the services offered by all of the International Authorities offering the services. In case of multiple applicants from

different countries, the applicants had more choice since selection of an ISA/IPEA was possible if at least one of the applicants was eligible to choose the office as ISA/IPEA. Thus, the choices were not uniformly available to all the applicants. To make the PCT System more efficient and accessible, the Office proposed that all applicants should have equal opportunities to make use of the system. Such choice should not be restricted due to lack of bilateral arrangements. By simplifying the procedure and making available more choices to the applicant, the PCT System would better enable the ease of doing business by PCT applicants. This would encourage more applicants to use the PCT System.

“50. The Indian Patent Office therefore proposed that all Authorities should consider changes in the existing mechanism so that the International Authorities may act for all the States. The step of declaration as competent ISA/IPEA by the receiving Offices of each of the Member States of the PCT could be ultimately done away with so that the applicants who are nationals/residents of any of the Member States of the PCT could choose any of the International Authorities as ISA for their international applications. As far as choice of IPEA is concerned, this choice could be based on which Authority was chosen as ISA for the application, if such condition applied for the IPEA.

“51. The Indian Patent Office concluded by stating that this proposal could be implemented without any changes to the Treaty and Regulations, if all receiving Offices declared all International Searching and Preliminary Examining Authorities as competent. Certain technical hurdles that were foreseen in implementing this proposal included the arrangements by receiving Offices for the transmittal of search fees and search copies to the ISAs. Until such arrangements were in place, either directly between Offices or through the International Bureau, the Indian Patent Office proposed that, to start with, the applicants filing international applications through the International Bureau as receiving Office (RO/IB) might be allowed the choice of any of the International Authorities as ISA/IPEA. Once the Authorities agreed in principle to the proposal, such detailed modalities could be worked out.

“52. Authorities indicated that they had not had sufficient time to prepare formal responses to the proposals set out in the document. Some preliminary considerations were that there would be technical and legal difficulties involved in allowing a totally free choice of International Searching Authority, including effective delivery of search copies between Office pairs where eSearch Copy was not available, the need for translations, and the need to change national laws or the provisions of certain other international agreements. It was observed that many applicants could already arrange some of the benefits proposed by virtue of the choices gained from co applicants with different nationality or residence.

“53. The Meeting invited the International Bureau to open an area on the Quality Subgroup’s electronic forum for discussion of the issues arising from the proposals in the document.”

3. Accordingly, the International Bureau opened a discussion page on the Quality Subgroup’s electronic forum on March 15, 2019, inviting comments on the topic from all the Authorities by April 15, 2019. Only one Authority has commented so far with a request to elaborate the background of the proposal.

4. The following reasons and advantages, some of them repeated from the proposal, are presented for the consideration of the PCT Working Group:

- According to the existing mechanism, once the PCT Assembly appoints an Office as an International Authority, practically the applicants who are nationals/residents of any of the Member States of the PCT are not able to choose the Authority as ISA or

IPEA for their International Applications. The step of “declaring as competent ISA/IPEA” by the receiving Offices of each Member State adds a further step of bilateral recognition by each of the Member States. This has an overriding effect on the recognition/appointment already secured following the due process in which all the Member States were already part of the decision-making. The multilateral cooperation under the PCT need not be restricted due to lack of bilateral agreements.

- In today’s world, the businesses are transnational with multiple partners for research, production, marketing etc. The need for patenting the invention and the choice of ISA/IPEA are decided by the applicants based on various factors. In case of multiple applicants from different countries, the applicants have more choice since selection of an ISA/IPEA is possible if at least one of the applicants is eligible to choose the Office as ISA/IPEA. Such a choice is not uniformly available to all applicants and there exists a need to shape the rules for the changing world.
- As a multilateral treaty, the PCT system currently allows all applicants to designate or elect any of the Member States during the national phase. By allowing the applicants to choose any International Authority as ISA/IPEA, the cooperation among the International Authorities would be more meaningful as the Authorities recognize the services offered by other Authorities and all the Member States recognize equally the services offered by all International Authorities.
- By simplifying the procedure and making available more choices to the applicant, the PCT System would better enable the ease of doing business by PCT applicants. There will be better utilization of resources and dissemination of best practices. This would encourage more applicants to use the PCT System.

5. IPO proposes that, to start with, the applicants filing international applications through the International Bureau as receiving Office (RO/IB) may be allowed the choice of any of the International Authorities as ISA/IPEA. This is suggested as mechanisms for transfer of fee and documents are already in place between the different offices and the International Bureau. It is further proposed that the mechanism can be extended gradually to other receiving Offices.

6. The Working Group is invited to note the details of the proposal and to comment on the proposed way forward in paragraph 5.

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