

PATENT COOPERATION TREATY (PCT) WORKING GROUP

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IMPROVING THE PCT SYSTEM — VIEWS OF UK USERS

Document submitted by the United Kingdom

SUMMARY

1. The United Kingdom (UK) Intellectual Property Office (IPO) conducted a public consultation on reform of the PCT in the summer of 2009¹. The consultation sought the views of users on the proposals set out in the PCT Roadmap², the ideas put forward by Contracting States (in particular by the United States of America³, Japan⁴ and the Republic of Korea⁵) at the PCT Working Group in May 2009, and ideas resulting from informal consultations with UK user groups.

¹ The consultation document (<http://www.ipo.gov.uk/consult-pct.pdf>) and a detailed summary of responses (<http://www.ipo.gov.uk/response-pct.pdf>) are available on the IPO website

² The Future of the PCT (PCT/WG/2/3)

³ Comprehensive Proposal for PCT Reform (PCT/WG/2/12)

⁴ Proposals to Enhance Quality and Efficiency of the PCT Route (PCT/WG/2/8)

⁵ Three Track PCT System (PCT/WG/2/11)

2. The results of the consultation indicated support from UK users for:
 - (a) Reform of the international preliminary examination procedure to encourage a dialogue between the International Preliminary Examining Authority and the applicant.
 - (b) Optional accelerated processing in the national phase for applications having a positive international preliminary report on patentability.
 - (c) Central repository of search and examination results.
 - (d) Improved procedure for correction of errors made by the receiving Office or International Bureau.
 - (e) Collaborative international search.
 - (f) Third party observations in the international phase.
 - (g) Top-up search in the international phase.
 - (h) Optional accelerated processing in the international phase.
 - (i) Review of quality management procedures.
3. This document provides details of the views of UK users on the above issues which may be of interest to the PCT Working Group.

REFORM OF THE IPE PROCEDURE

4. Responses to the consultation show that UK users are in favour of initiatives to encourage greater and better use of the international preliminary examination (IPE) procedure. Some users expressed the view that many did not use Chapter II processing because it was almost impossible to obtain timely and meaningful responses from International Preliminary Examining Authorities (IPEAs) in order to enter the national phase with a positive international preliminary report on patentability (IPRP). Encouraging more meaningful discussion between applicants and the IPEA may persuade those applicants who did not use Chapter II processing only as a means to defer the costs of national phase entry to use the IPE procedure more.
5. To encourage such a discussion process, users favoured measures such as requiring the applicant to respond to the objections in the written opinion (WO) of the International Searching Authority (ISA) when filing a demand for IPE, and requiring the IPEA to provide at least one WO (in addition to the one provided by the ISA) before issuing an IPRP.

OPTIONAL ACCELERATED PROCESSING IN THE NATIONAL PHASE FOR APPLICATIONS HAVING A POSITIVE IPRP

6. Accelerated national processing could act as an incentive to putting an application in order in the international phase. Some users were strongly in favour of this suggestion. However, users commented that the accelerated national procedure should still involve an examination of good quality, given that the current IPRP was not considered to be reliable. If a full and reliable exam is conducted in the international phase, then the application could proceed to grant in the national phase very quickly, with limited further exam, or to immediate rejection following a negative report, subject to immediate appeal.
7. Fee reductions could provide an incentive to use such as system, but only if more than one national/regional Offices provide such reductions. It was noted that the examination fee in the regional phase of the European Patent Office (EPO) is already reduced by 50% if the EPO performed the IPE (regardless of the outcome). There may be scope for offering a further reduction for a positive IPRP.

8. In response to the outcomes of the consultation the UK IPO has implemented a system offering accelerated UK national phase processing for applications with a positive IPRP. To request accelerated treatment, the applicant must make a request in writing to the UK IPO indicating that their application has received a positive IPRP and stating that accelerated processing is required. The request will be accepted where the UK examiner can verify that the claims on file in the UK national phase were examined during international preliminary examination and that no objections were raised in the IPRP to their novelty, inventive step or industrial applicability. If the request is accepted, the application will be given accelerated treatment (although a full examination will still be performed, as for any other PCT application in the UK national phase). The new system will potentially allow for a quicker grant of a patent in the UK for PCT applications which have been found to meet the requirements for novelty, inventive step and industrial applicability during international preliminary examination.

CENTRAL REPOSITORY FOR SEARCH AND EXAMINATION RESULTS

9. Some users suggested the International Bureau could provide a central database of search and examination results for national phase applications which would be provided by national Offices. The procedure could be an extension of the current register indicating national phase details.

IMPROVED PROCEDURE FOR CORRECTION OF ERRORS MADE BY THE RECEIVING OFFICE OR INTERNATIONAL BUREAU

10. Users were in favour of amending the PCT Regulations to allow an error made by the receiving Office or International Bureau to be corrected in the international phase where the error concerns the international filing date or a priority claim that has been erroneously considered void. Details of the UK's proposed amendments to the Regulations can be found in the document "Improved Procedure for Correction of Errors made by the Receiving Office or the International Bureau".

COLLABORATIVE INTERNATIONAL SEARCH

11. Collaborative international search, where the international search would be performed by more than one ISA, would be welcome if it leads to a higher quality search. Users indicated that they would be prepared to pay a higher fee for a better quality search, especially if savings were passed on in the national or regional phase in the form of lower fees, since national or regional Offices would not need to duplicate the search.
12. Two different systems have been suggested by UK users:
 - (a) Offices collaboratively agree a search strategy and then split the work according to their respective resources. Some duplication would be acceptable where different classification and search systems could be expected to give different results. Each office would have the opportunity to comment on the results before the lead office combines the results into a single report.
 - (b) An ISA carries out a high quality search of its own databases. The ISA then considers any requests for supplementary searches with the applicant and decides to what extent the original search can be complemented by searching skills and resources elsewhere. The ISA then liaises with other search authorities to produce a collaborative result. The other search authorities could include ISAs, national Offices and non-governmental authorities (subject to appropriate quality standards). Alternatively, the system could be managed by WIPO (or an outside non-governmental body) in place of the ISA.

13. Other issues that require closer consideration include the number of ISAs involved in the collaboration, how the ISAs would be selected (e.g. language, geographical restrictions), and how the search fee would be calculated and distributed.

THIRD PARTY OBSERVATIONS IN THE INTERNATIONAL PHASE

14. Some users in the UK are in favour of this idea. To compensate for cases where the observations are not considered during IPE, some users have suggested that the PCT could be amended to require national/regional offices to consider the observations. However, this would require some national/regional offices to carry out substantive examination where their current procedures may simply allow them to accept the written opinion of the ISA.
15. It was suggested by some users that observations could be allowed until 30 months from the priority date. For applications where IPE was requested, provision could be made in the PCT Regulations for observations to be sent to national/regional Offices and ignored during IPE if they are not received within a specified shorter deadline.
16. Third parties may be willing to pay a fee if international authorities provided third party observations to the national/regional Offices. Unduly long submissions could be discouraged by imposing a fee for additional pages. The system should not disadvantage applicants by requiring them to expend costs to deal with the observations e.g. by having to translate them for the national/regional offices. One option could be to require observations to be made in the language of publication, which should be understandable by the IPEA.

TOP-UP SEARCH IN THE INTERNATIONAL PHASE

17. There is support among UK users for introducing a top-up search into the IPE procedure. Users generally agree that all relevant documents having an earlier priority date than the international application should be brought to the applicant's attention. However, the international preliminary examination should only consider documents published earlier than the priority date. Documents published after the priority date would be considered in the national/regional phase under the applicable laws.
18. Some users would not be prepared to pay a fee for this service, on the basis that the top-up search may often find nothing relevant. However, some users would be prepared to pay, especially if there were some fee reductions in the national/regional phase to compensate for the cost. It was also commented that it would not be desirable for a top-up search to be optional.

OPTIONAL ACCELERATED PROCESSING IN THE INTERNATIONAL PHASE

19. There is some support amongst UK users for optional accelerated processing in the international phase, although some consider that it may not be used very often since many applicants want to delay processing to defer costs. Users would be prepared to pay a fee for such a service.

REVIEW OF QUALITY MANAGEMENT PROCEDURES

20. Some users commented that the issue of transparent quality monitoring of the work done by international authorities needs to be seriously addressed. It was suggested that the issue should be examined by an inter-authority working group, possibly with a view to eventually having an independent monitoring committee to review samples of each authority's work.

21. One idea would be to have a periodic quality assessment process to compare and contrast the work performed by different international authorities. A starting point could be to run a pilot scheme where international authorities could participate in such an assessment exercise on a voluntary basis.

22. *The Working Group is invited to consider the issues raised in this document.*

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