

## **Patent Cooperation Treaty (PCT) Working Group**

**Fourth Session  
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**UK experiences of encouraging more effective use of the International Phase:  
PCT(UK) Fast Track**

*Document submitted by the United Kingdom*

### **SUMMARY**

1. Document PCT/WG3/2 "The Need for Improving the Functioning of the PCT System" recommended in paragraph 176(c) that "Contracting States should consider possible incentives which could be introduced either internationally or at the national level to encourage applicants to file higher quality applications and to have defects corrected in the international phase."
2. The United Kingdom (UK) Intellectual Property Office (IPO) believes that the PCT system has the potential to be a key tool in addressing the challenges posed by backlogs of work in many patent offices around the world. Encouraging applicants to file higher quality applications and to make more effective use of the international phase will help reduce duplication of work in the national / regional phase.
3. The UK IPO introduced its PCT(UK) Fast Track service on May 28, 2010 to act as such an incentive. This service offers accelerated UK national phase processing for applications with a positive international preliminary report on patentability (IPRP). This document explains how the service operates and proposes that other national / regional Offices consider introducing similar services.

## BACKGROUND

4. The UK IPO conducted a public consultation<sup>1</sup> in the summer of 2009 on the subject of PCT reform, the results of which are summarized in document PCT/WG/3/5. Amongst other issues, the responses to the consultation indicated support from UK users for optional accelerated processing in the national phase for applications having a positive IPRP.
5. Some users were strongly in favor of this suggestion. However, users also commented that the accelerated national procedure should still involve a high quality examination, as they do not consider current IPRPs to be reliable. They further commented that if a full and reliable examination has been conducted in the international phase, then the application can proceed to grant in the national phase very quickly, with limited further examination required.
6. In response to the positive support in the consultation responses, the UK IPO introduced its PCT(UK) Fast Track service on May 28, 2010. The service provides an incentive for PCT applicants to file higher quality applications and to make full use of the international phase by amending their application in the international phase to overcome any objections raised. This will reduce duplication of work by designated / elected states in the national phase and thereby help to address the problem of patent backlogs.
7. As an alternative suggestion, users commented that fee reductions in the national phase could provide an incentive to gain a positive IPRP in the international phase, but only if more than one national / regional Office provides 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 international preliminary examination (regardless of whether the claims examined appear to satisfy the criteria of novelty, inventive step (non-obviousness) and industrial applicability). There may be scope for offering a further reduction for a positive IPRP. Many applicants are not anxious to gain a rapid grant - a fee reduction would act as more of an incentive for such applicants.

## OPERATION OF THE SERVICE

8. 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 considered on establishing the IPRP and that no objections were raised to their novelty, inventive step or industrial applicability. If the request is accepted, the application will be given accelerated treatment. Further details of the service are available in the Practice Notice on the UK IPO website at [www.ipo.gov.uk/p-pn-fasttrack.htm](http://www.ipo.gov.uk/p-pn-fasttrack.htm).
9. The service is available whether the IPRP was issued under Chapter I or Chapter II of the PCT. The service is also available based on a positive Written Opinion of the International Searching Authority (ISA). This means that the service is available to those applicants who 'got it right first time' as well as to those who amended to overcome objections in the international phase.
10. The UK IPO has chosen to restrict this service to only those applications which have gained a positive IPRP in respect of all claims. If an IPRP includes any objections to novelty, inventive step or industrial applicability then the offending claims must be deleted or amended in the international phase. Acceleration under PCT(UK) Fast Track is not available if the applicant deletes the offending claims upon entry into or during the national

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<sup>1</sup> 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

phase. The service therefore acts as an incentive to make such amendments in the international phase.

11. The UK IPO decided that this service is not available to those applications where the applicant deletes the offending claims upon entry into or during the national phase (either prior to or at the time of making the request for acceleration). This is because we wish to encourage the applicant to make such amendments in the international phase so that all designated / elected offices might benefit from the completed action. Although extending the service to applications where offending claims are deleted upon entry into or during the national phase might encourage more applicants to make use of the service, this would not meet the overriding policy objective behind the service.
12. A full examination is still performed, as for any other PCT application in the UK national phase. The examination is performed in the same timescales as other accelerated UK patent applications - a first examination report can be expected to issue within two months of receipt of the request for acceleration and subsequent amendment rounds are also accelerated.
13. The PCT(UK) Fast Track therefore allows for a faster prosecution of PCT(UK) applications which have been found to meet the requirements for novelty, inventive step and industrial applicability in the international phase.

#### **COMPARISON WITH PCT-PATENT PROSECUTION HIGHWAY (PPH)**

14. The PCT(UK) Fast Track service is available irrespective of which International Authority issued the IPRP. The service is therefore not restricted to a positive report from any particular International Authority. This offers greater flexibility to applicants. A full examination is always conducted in the national phase – the examiner is able to place as much or as little reliance on the results of the IPRP as they deem appropriate.
15. Simplicity is another major benefit of the PCT(UK) Fast Track service. The only requirements are a positive IPRP (or Written Opinion of the ISA) and a written request from the applicant. The simplicity of the process is advantageous for both applicants and the UK IPO.

#### **USE OF THE SERVICE**

16. To date, fifteen patent applications have been accelerated under the PCT(UK) Fast Track service. Although the numbers are currently small, the service has been working well and the UK IPO is pleased with the initial uptake.
17. Looking at the accelerated applications, it is interesting to note that (i) a range of international authorities (the Korean Intellectual Property Office, the European Patent Office, the State Intellectual Property Office of the People's Republic of China, and IP Australia) acted as ISA/IPEA and (ii) there is an even spread between those that requested Chapter II processing (with amendments being filed in the international phase to overcome objections) and those 'getting it right first time' under Chapter I.
18. To date, four PCT(UK) Fast Track patents have been granted, in an average time of six months from request for acceleration.
19. The UK IPO has sought comments from PCT(UK) Fast Track users. The responses received give a clear indication that the incentive is currently inadequate to encourage many applicants to make claim amendments in the international phase. In particular, the potential benefit of rapid grant in the UK is not sufficient to outweigh the increased cost of Chapter II processing coupled with the risk that claim amendments made early may subsequently prove to have been ill-considered and unduly limiting.
20. These comments may provide an explanation for the low numbers of applicants who have used the service.

21. Users have explicitly commented that a greater incentive would be offered if other national / regional offices (especially major patent offices such as the European Patent Office and United States Patent and Trademark Office) were to provide a scheme similar to the PCT(UK) Fast Track. No comments were made as to whether the existing PCT-PPH programs provide sufficient incentive.
22. A comment was also received that non-UK patent attorneys prosecuting the international phase may not be aware of the service.
  23. *The Working Group is invited to note the contents of this document and to consider whether further incentives should be offered to applicants.*

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