

Patent Cooperation Treaty (PCT) Working Group

Seventh Session Geneva, June 10 to 13, 2014

PROCEDURES FOR INVITING THE APPLICANT TO SELECT A COMPETENT INTERNATIONAL SEARCHING AUTHORITY

Document submitted by the United States of America

SUMMARY

1. The present document contains a proposal to amend the Receiving Office Guidelines to provide for a more specific process for inviting the applicant to select a competent International Searching Authority (ISA) when either (i) one was not specified in the Request or any other paper filed in connection with the international application or (ii) the originally chosen ISA is deemed not competent.

BACKGROUND

2. Receiving Offices (ROs) often offer several choices of competent ISAs. For example, applicants from the United States of America (US) filing in RO/US or RO/IB may choose USPTO, EPO, KIPO, IP Australia or Rospatent as the ISA, with some restrictions. Some of International Authorities have limited the extent of their competency. For example, the EPO has declared itself non-competent for applications filed by US applicants in RO/US or RO/IB where one or more claims is directed to the field of business methods as defined by certain International Patent Classification units (see Annex A of EPO's agreement with WIPO). In other situations, International Authorities have or are considering a numerical competency limitation. For example, the ISA may only be competent to perform the international search for a specified number of international applications per quarter or per year.

3. The USPTO in its capacity as a receiving Office has experienced operational issues where either (i) the applicant has failed to select a competent ISA on filing or (ii) the originally chosen ISA declares itself non-competent in view of particular competency limitations as described above. In either situation, the RO is obligated under the procedure set forth in paragraph 115 of the receiving Office Guidelines to invite the applicant to select a competent ISA. However, the Guidelines fail to set forth any sanction for failure to respond to the invitation. As such, RO/US has found that some applicants are not compelled to respond to such an invitation, and the RO/US is unable to further process the application.

DISCUSSIONS AT THE TWENTY-FIRST SESSION OF THE MEETING OF INTERNATIONAL AUTHORITIES

4. The issue was presented to the 21st session of the Meeting of International Authorities (MIA) which was held in Tel Aviv from February 11 to 13, 2014, in document PCT/MIA/21/10.

5. A general summary of the discussions from the MIA is set forth in paragraphs 70 to 71 of the Annex to document PCT/WG/7/3, and are reproduced below.

“70. Discussions were based on document PCT/MIA/21/10.

“71. Several Authorities stated that they had not experienced any problems with international applications in respect of which the applicant had not chosen a competent Authority to carry out the international search and had not responded to invitations by the receiving Office to do so. In any case, they suggested that, in such cases, the approach should be for the receiving Office to set a “default” Authority to become competent to carry out the international search rather than considering the application to be withdrawn; the latter was only possible once the applicant had not responded to any invitation to pay any outstanding search fee.”

PROPOSAL

5. The Annex of this document contains a specific proposal to amend the PCT Receiving Office Guidelines to provide for the practice recommended at the MIA which is to set a “default” ISA when inviting applicant to select a competent ISA so that no response or an incomplete response to the invitation will not unduly delay international processing.

6. *The Working Group is invited to consider the proposal contained in the Annex to this document.*

[Annex follows]

PROPOSED AMENDMENTS TO THE PCT RECEIVING OFFICE GUIDELINES

The Competent International Searching Authority

114. The receiving Office checks whether the International Searching Authority specified by the applicant is competent to carry out the international search. Each receiving Office may declare one or more International Searching Authorities as competent for the searching of international applications filed with it (Article 16 and Rules 35.1 and 35.2).

115. If the International Searching Authority indicated by the applicant is competent, or if only one International Searching Authority is competent, the receiving Office indicates the name of that Authority on the last sheet of the request. Where more than one International Searching Authority is competent and no indication as to the choice of International Searching Authority is made in Box No. VII of the request, the receiving Office checks whether such indication appears on any other paper filed in connection with the international application, such as the fee calculation sheet, or on any translation submitted for the purposes of international search. Where no such indication is made, the receiving Office invites the applicant to indicate a choice as to the competent Authority within a time limit so fixed in the invitation. Form PCT/RO/132 may be used for that purpose. The time limit so fixed must be reasonable in the circumstances; it shall be not less than 15 days and not more than one month from the date of mailing of the invitation. The invitation may indicate a particular International Searching Authority as the default should applicant fail to properly respond to the invitation. Where the Office acting as receiving Office is also an International Authority, that Office should generally be set as the default International Searching Authority. The receiving Office proceeds in the same manner where more than one Authority is competent and the applicant has indicated an Authority which is not competent in respect of the application in question. ~~Where more than one International Searching Authority is competent, the applicant may make a change to the choice of Authority if the search copy has not yet been transmitted to the International Searching Authority originally chosen by the applicant.~~ The receiving Office deletes the indication of any non-competent International Searching Authority *ex officio* (paragraphs 161 to 165) and likewise inserts an indication of a competent ISA determined through the above-mentioned process.

115B. Where more than one International Searching Authority is competent, the applicant may make a change to the choice of Authority if the search copy has not yet been transmitted to the International Searching Authority originally chosen by the applicant.

[End of Annex and of document]