

Patent Cooperation Treaty (PCT) Working Group

Eighth Session
Geneva, May 26 to 29, 2015

NATIONAL PHASE ENTRY USING EPCT

Document prepared by the International Bureau

SUMMARY

1. It is proposed to find a pilot group of designated Offices willing to validate a model and test an implementation of a system facilitating national phase entry using ePCT by reusing bibliographic data from the international phase and offering a secure shared environment for instructing attorneys to prepare, check and submit the additional data and documents required for the relevant designated Offices. The data and documents would be provided to the designated Office in a standard machine-readable format, allowing its effective use without the need for transcription and the associated risk of errors.

BACKGROUND

2. At the seventh session of the PCT Working Group, the International Bureau set out a concept for using ePCT to trigger national phase entry (document PCT/WG/7/12 and paragraphs 283 to 305 of document PCT/WG/7/30).

3. The proposed system involved streamlining the formalities of national phase entry by reusing bibliographic data already in the system instead of requiring it to be retyped into national forms and then transcribed by national Offices, taking time and involving two or more opportunities for making errors. The system would simply require the applicant to add the relatively small number of extra pieces of information which would be required in a national phase form, including providing the translations which may be needed to accompany or replace names, addresses and the title of the invention in the original language.

4. It would do this effectively by providing a secure, interactive platform to assist cooperation between an instructing agent and a local agent prior to national phase entry, allowing both parties to be confident that the key information was in a mutually satisfactory form before the national phase processing began. This arrangement could also be used to add any documents which needed to accompany the national phase entry request, such as translations and powers of attorney.

5. The proposal was treated with interest by a number of Offices, subject to a number of concerns, most commonly connected with the fact that payments of fees would need to be made separately from the provision of the documents and information. Representatives of patent attorney associations also recognized the potential benefits, but raised a wider range of concerns, notably over the possibility that local patent agents might not be sufficiently involved to ensure that the national phase entry both met the essential local requirements and was optimized for best effect.

ISSUES RAISED

6. The main issues raised by Offices at the seventh sessions were:

(a) The likely need to pay fees separately introduced a risk of applicants failing to pay within the relevant deadline, as well as difficulties for Offices in linking payments received with the appropriate national phase entry action.

(b) It would be desirable for the system to immediately receive a national application number, allowing more effective further processing with the national Office (including for payment of fees). Where appropriate, this could be generated by the ePCT system itself from a separate number series allocated to it for the purpose, rather than being directly generated by the designated Office.

(c) The system would need to take into account different time limits for national phase entries (30 months from the priority date for some Offices, 31 months or longer for others) as well as time zones.

(d) The system would need to ensure that translations were provided whenever necessary.

(e) The system would need to be carefully checked to ensure that the information provided genuinely met all the requirements of the participating designated Offices and was delivered in a format which was usable by Offices which were used to their own existing forms.

7. Representatives of patent attorney associations raised a wide range of concerns, primarily based around the appointment and involvement of a local patent attorney in order to ensure that national representation requirements were met and that the national phase entry was not made in a manner detrimental to the applicant's interest as a result of insufficient knowledge of the local procedural and substantive requirements. These issues are set out in full in paragraphs 293 to 304 of document PCT/WG/7/30. Some of the main points, beyond those raised by Offices, included:

(a) It would be necessary to ensure that each national phase entry included details of a properly appointed local patent attorney who was qualified and willing to prosecute the application before the relevant designated Office.

(b) Many large patent agencies would require a machine interface for such an arrangement in order to be able to complete a filing on the basis of records from their own internal systems.

(c) There may be a risk of loss of rights if the notification from the International Bureau fails to reach the designated Office.

(d) Many designated Offices have specific local requirements, which agents from other countries might be unaware of, and which can cause great expense and inconvenience or loss of rights if not dealt with properly at the time of national phase entry.

PURPOSE OF PROPOSAL

8. As indicated in paragraphs 3 and 4 above, the purpose of the proposal is not to reduce the professional role of the national attorney, but to eliminate unnecessary transcription of existing information to and from national forms, and to assist with communications. This should provide confidence between an instructing (international) attorney and a national attorney that errors are minimized, that requirements have been properly understood and that the national phase entry will take place as intended.

9. Clearly, there is a possibility that a few users might see the arrangement as an opportunity to cut corners. However, the risks appear limited, given the proposed requirement to specify a national attorney, who would need to have agreed to handle the case and would be the only one to directly receive the resulting correspondence, together with the well understood costs and risks of undertaking national phase work without ensuring that steps have been taken to address local requirements from the outset.

CONTENT OF FORM AND PACKAGE

10. In principle, there should be no legal barrier to any designated Office allowing the action of national phase entry on the basis of a common form generated by the ePCT system, even though it would inevitably not precisely match the national forms which are commonly used, since PCT Rule 49.4 requires that “No applicant shall be required to use a national form when performing the acts referred to in Article 22”. The requirements of Article 22 for national phase entry are limited to payment of a fee and furnishing of any necessary translation (together with certain other possibilities which would not be relevant to the circumstances in which this system would be used).

11. There are, of course, other national requirements which may either be subject to the same time limit or else be subject to additional fees if not met at the time of national phase entry. It is not practical to maintain an international system which perfectly deals with the nuances of over 120 national and regional designated Offices, but in practical terms there are few differences in terms of the issues which are dealt with in national phase entry forms. Document PCT/WG/2/5 reviewed the contents of such forms and the items indicated in there would form the basis of a proposal for the “form” for national phase entry (in the sense of the bibliographic data which would be provided to the designated Office in XML format and also rendered into a paper-equivalent view for ease of reading).

12. The main differences appear not to involve the information which is provided in forms, but the documents which may be provided at the same time as the forms. For these, it will be necessary to review the list of document description codes which already exist for transmission of international phase documents between Offices, to add new document types which are likely to be relevant to actions taking place at the same time as national phase entry and to identify the extent to which it is appropriate to check indicated document types as required or likely to be appropriate (and thus provide a warning if missing) for different designated Offices.

FEE PAYMENTS

13. At present, ePCT offers the opportunity for real-time payment of fees either by credit card or by authorization to charge a current account held by the International Bureau for a regular client. However, this service is currently limited to paying the transmittal, international filing and search fees due in respect of international applications filed at the receiving Office of the International Bureau.

14. Documents PCT/WG/8/15 and 20 propose further work towards allowing centralized payment of those fees for international applications filed at other receiving Offices. If such arrangements can be put in place with receiving Offices, technically there should be little difficulty in using the same mechanisms to accept fees on behalf of designated Offices which are willing and able to set up the necessary arrangements.

15. Nevertheless, it would be necessary to ensure that payments made to the International Bureau acting for the designated Office were treated as paid at the time of receipt by the International Bureau, even though the transfers of funds would likely be made as bulk payments on a monthly basis, as is typical for international phase fee transfers between Offices and the International Bureau. Furthermore, whereas the International Bureau receives a transmittal fee which allows it to absorb credit card transaction fees and similar costs associated with payments to the receiving Office of the International Bureau, there is no current equivalent for national phase actions. Consequently, it would likely be necessary for the service to include a small fee to cover processing costs.

OTHER TECHNICAL ISSUES

16. The ePCT system already has processes in place which demonstrate that the main challenges can be overcome:

- (a) The ePCT-filing component provides an example of checking different parameters for different receiving Offices, such as the languages accepted for filing, determining whether a translation will also be required for international search and/or publication, and taking into account the closed dates of different Offices in calculating time limits.
- (b) The ePCT-filing component demonstrates a graduated approach to errors, preventing submission of applications with clearly “fatal” errors, warning of correctable errors which should be dealt with immediately if possible, but can be left for later if necessary, and information on issues where there is not clearly an error but the applicant may wish to give closer scrutiny.
- (c) Both the ePCT-filing and document upload components recognize and record the time zones which apply at different national Offices when accepting documents on their behalf as receiving Office or International Searching or Preliminary Examining Authority.

Recipient	Electronic routing method	Current date and time at recipient Office
<input checked="" type="radio"/> IB	ePCT i	Wednesday, 08 April 2015, 16:00 CEST
<input type="radio"/> RO	PCT Electronic Data Interchange i	Thursday, 09 April 2015, 00:00 AEST
<input type="radio"/> ISA	PCT Electronic Data Interchange i	Thursday, 09 April 2015, 00:00 AEST

(d) The ePCT system allows an “eOwner” (typically the international phase agent) to delegate access rights on a case by case basis to any person with whom he has an “eHandshake”, essentially forming an address book of individuals likely to be trusted with a role in processing an international application. It would be up to individual agents to foster their network of trusted partners in different countries – the International Bureau would play no part in this beyond providing tools to allow the parties to share access to the file of the international application and draft documents associated with it.

(e) The ePCT system is able to represent bibliographic information in 10 different languages, selectable by the user so the same information can be viewed effectively by two people in different languages.

(f) It is envisaged that the system would only be used with Offices willing to receive the documents and data electronically. The International Bureau has established mechanisms for reliably transferring documents and data to national Offices – loss of the data is significantly less likely than loss of paper forms in the postal system. The system could, if designated Offices were willing, be set up to expect receipts once the data had been actively loaded into the relevant designated Office’s systems.

17. In relation to the suggestion that some agents would prefer to use their own software to prepare national phase entries, both the ePCT system and PATENTSCOPE already allow the download of XML representing current bibliographic data (live in ePCT, updated nightly in PATENTSCOPE). It is intended soon to offer this as a web service from ePCT for easier automation. Furthermore, it is envisaged that the XML for the national phase entry action would be prepared according to a published standard, which designated Offices may choose to accept from sources other than ePCT.

NEXT STEPS

18. Clearly, any service of this type should only be introduced in relation to Offices which are able to guarantee that its use will be effective. This would mean, *inter alia*:

(a) ensuring that the documents and data could be received and processed effectively;

(b) ensuring that the reference data on which the system was based was accurate and kept up to date (specific time periods for national phase entry, languages accepted, acceptable States for a local attorney and suchlike);

(c) ensuring that proper legal effect would be given to the documents, based on the date and time at which they were received by the International Bureau on behalf of the designated Office, even if they were only loaded into local systems at a later date;

(d) considering whether the means for making payments are suitable to ensure that the fees can reliably be associated with the correct national phase entry; and

(e) to the extent that there is seen to be scope for problems which cannot readily be detected by the ePCT system, or for ensuring that payments are properly received, checking that the national law provided sufficient opportunity for correcting the defects.

19. The International Bureau has begun to prepare a prototype interface. When this is ready, it can be made available in the demonstration environment for consultations with a small, representative group of interested designated Offices and user representatives to ensure that it is able to meet the needs of Offices with different IT systems, languages and requirements of national law. The aim would be to offer stakeholders the opportunity to influence the system as early in its development as possible and to identify what further development may be needed

before a live pilot could begin. This would include not only work on the interface and package format, but in identifying whether improvements would be required to IPAS¹ or to interfaces for efficient and preferably near-real time communication with designated Offices' own IT systems.

20. Such a group would ideally include a mixture of large and small Offices with different official languages and requirements of national laws, some of which being frequent subjects of parallel national phase entries, but where the Offices did not see any significant barriers in their current national legislation. Expressions of interest by Offices would be welcome either during the session or by email to pct.wg@wipo.int.

21. The Working Group is invited to comment on the issues set out in the present document.

[End of document]

¹ The Industrial Property Automation System: a flexible, modular system offered by the International Bureau to assist national industrial property processing, in use at over 60 national Offices.