

[July 8, 2009]

## **PCT User Survey**

### **EXECUTIVE SUMMARY**

The International Bureau of WIPO undertook a comprehensive survey of PCT Users from October 1, 2008 to January 31, 2009. The survey was completed by 480 respondents.

The main themes raised by survey respondents in their written comments were the following:

#### *International search and examination services*

- These services are generally satisfactory. However, a number of complaints were made in respect of timeliness, mainly in respect of receipt of international search reports, and with certain aspects of the search and examination procedure.

#### *Receiving Office services*

- The services provided by receiving Offices are generally satisfactory. However, a number of comments were made in respect of electronic filing problems and with certain procedures before some receiving Offices.

#### *Fees*

- The widely shared view of survey respondents is that PCT fees are too high, with some advocating a differentiated fee structure (e.g., reduced fee for small and medium-sized enterprises) and a refund mechanism in cases of delay (e.g., late search report) or non-performance of work.

#### *PCT legal framework*

- Many comments were made in respect of the PCT legal framework, in particular, procedures and rules. A number of enhancements to the PCT legal framework were also suggested, such as centralized examination, improved amendment procedure, introduction of an appeal or complaint mechanism, and the grant of an international patent based on the PCT procedure.

#### *Electronic filing*

- Survey respondents have an overall level of satisfaction with the electronic filing-related services provided by the main receiving Offices: the United States Patent and Trademark Office, the European Patent Office and the International Bureau. That said, survey respondents would like to see greater e-filing simplification, harmonization of information technology systems, and increased electronic document processing.

*Services provided by the International Bureau*

- There is a large degree of satisfaction with the range of information products and services provided by the International Bureau.

*National phase procedure*

- The majority of survey respondents enter the national phase in Western Europe, followed by the United States of America and Asia. A number of survey respondents are of the view that the PCT does not necessarily lead to an expedited grant in the national phase. Others said that there should be better integration between the international and national phases.

In summary, survey respondents are of the view that the PCT system is functioning generally well. However, they would like to see improvements in respect of timeliness, electronic filing, quality of search and examination reports, reduced frequency of legal changes, consistent application of PCT results in the national phase, and a reduced level of fees. Other areas also identified for improvement are the services provided by receiving Offices and by International Authorities.

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## PCT User Survey Report

### INTRODUCTION

1. The comprehensive PCT User Survey (“PCT Survey”) was the first of its kind for the PCT system. This survey provided the PCT user community with an opportunity to submit views, comments and suggestions on all aspects of the PCT system.

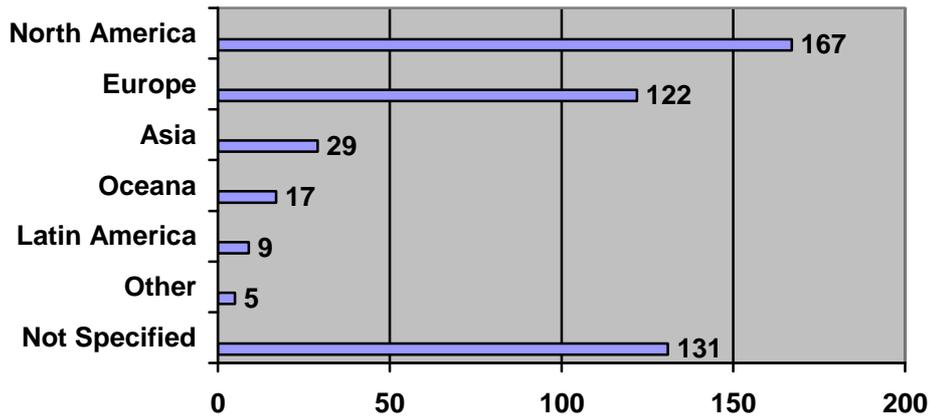
2. The methodology of the PCT Survey was based on a convenience sampling approach, i.e., individuals who are easy to reach and sampling that can be done in a relatively simple manner. This approach consisted of making the PCT Survey available on the Internet for any interested party to complete. The PCT Survey was widely promoted on the WIPO website, *PCT Newsletter*, and with national associations (e.g., intellectual property, patent attorney/agent, etc.). While it is understood that convenience sampling will not yield truly representative results, it nevertheless provides a useful starting basis from which to obtain a range of views that can then be used to develop more targeted and representative surveys.

3. The PCT Survey comprised 10 main parts containing close to 80 questions as follows:

Part I	General Questions on the PCT
Parts II to V	Questions Relating to the International Bureau
Part VI	PCT Electronic Filing
Parts VII to IX	Questions Relating to Receiving Offices, International Searching and International Preliminary Examining Authorities
Part X	General Questions on the National Phase

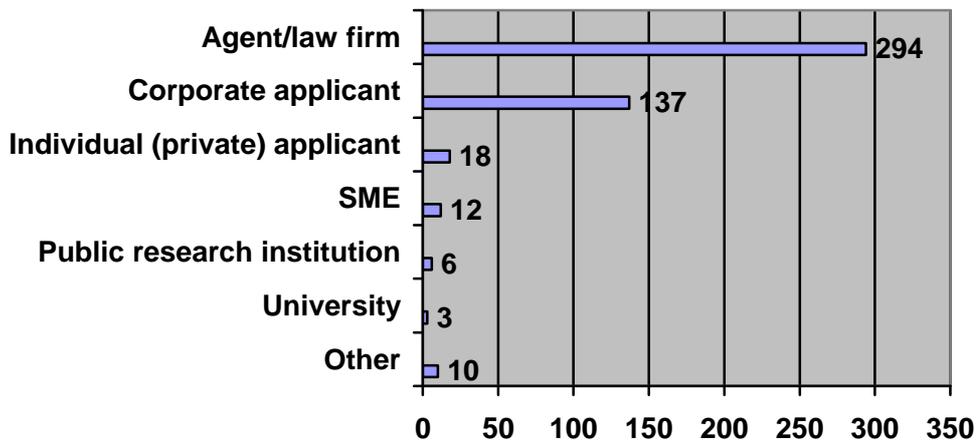
4. Each survey part consisted of a quantitative component (answers selected from a number of predetermined responses) and a qualitative component where survey respondents were encouraged to provide general comments and observations in free text form. The raw comments obtained from the qualitative portion were reviewed and summarized so that they could be presented and grouped in a structured and consistent manner. Over 2000 free-text comments were submitted by PCT Survey respondents.

5. The PCT Survey was predominantly completed by survey respondents from North America and Europe:

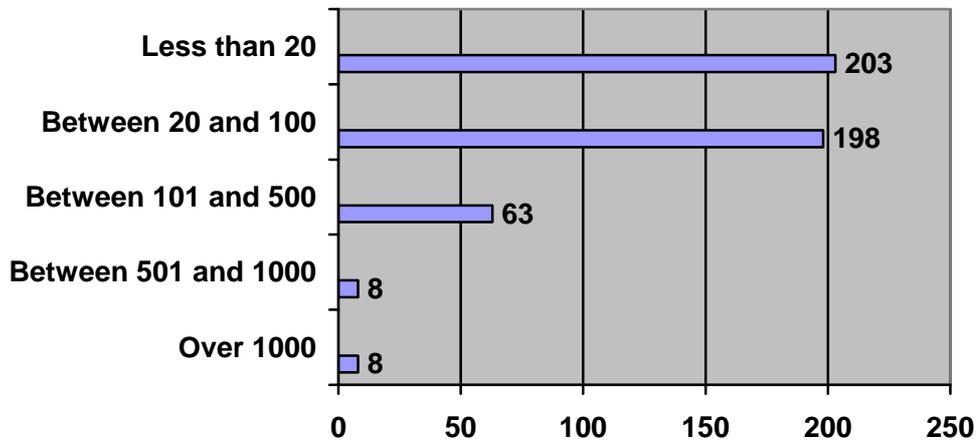


6. It is worth noting that the number of survey respondents from China, Japan and the Republic of Korea was particularly low, even though these countries regularly rank among the top 5 PCT filing origin countries. The low response rate from these countries will be further assessed and addressed as part of a separate exercise.

7. The majority of survey respondents were either agent/law firms or corporate applicants:



8. Most survey respondents indicated that they filed between 1 and 100 PCT applications per year:



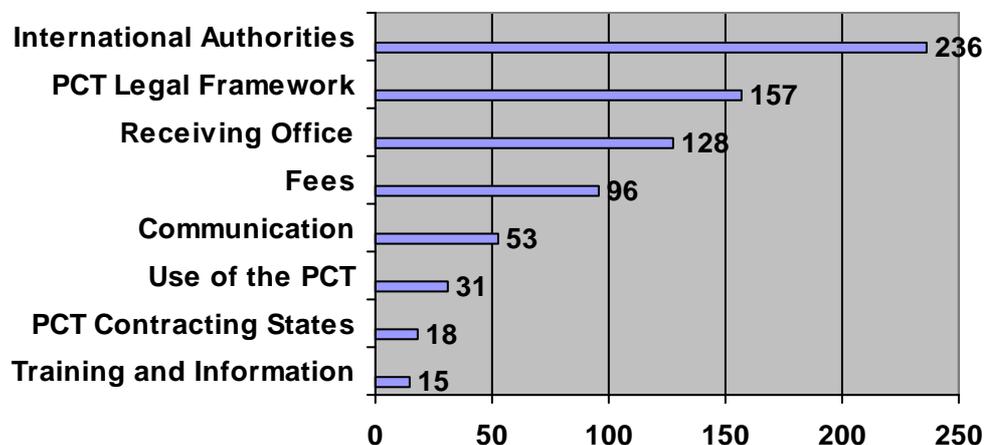
9. The following sections contain a high-level summary of the various survey parts. The detailed quantitative and qualitative responses (synthesized summaries of free text comments) are contained in the various annexes and have been edited for form and presentation.

**PART I GENERAL QUESTIONS ON THE PCT**

10. Part I of the survey consisted of the following three open-ended questions:

- (1) What are the main obstacles you encounter during the international phase of the PCT procedure?
- (2) What further improvements to the PCT system would you like to see in the future?
- (3) What would encourage you to make greater use of the PCT?

11. Over 700 free text comments were provided by survey respondents on the following topics:



12. While the original intent was for survey respondents to provide separate responses to the three questions, it became apparent that such a demarcation would prove to be impractical due to the overlapping nature of the responses. For example, survey respondents frequently stated that PCT fees are obstacles, areas of improvement, and at the same time, means to encourage greater use of the PCT. Therefore, for ease of reference and presentation, the responses to the three questions have been grouped together by theme rather than by individual survey question.

13. Many survey respondents commented on the services provided by International Authorities. A total of 236 comments were made with over half of the comments (56%) directed to timeliness issues, in particular, with late receipt of search reports. Several survey respondents made reference to the low quality of the search report and to the examination procedure. Some survey respondents made suggestions to improve the procedure before international authorities, e.g., providing applicants with copies of citations, providing a better opportunity for dialogue between the examiner and applicant, introducing a protest/appeal procedure, divisional filing, etc.

14. In the area of the PCT Legal Framework, 157 comments were made in respect of the frequency of rule changes, PCT reservations, procedures and representation, and the application and calculation of PCT time limits. In respect of search and examination, a number of suggestions were made, such as:

- Centralized examination procedure that would be binding on all Contracting States;
- A procedure for amending a PCT application without having to file a demand;
- The introduction of an appeal or complaint procedure in the international phase; and
- The grant of an international patent based on the PCT procedure.

15. In respect of PCT fees, 96 comments were provided. Close to 85% of these comments advocated a reduction in PCT- related fees. The remaining 15% were directed to modes of payment and to the PCT fee structure. Some survey respondents said that the level of PCT fees was too high for small and medium-sized enterprises (SMEs) and recommended creating a separate fee structure for SME applicants. Others made reference to difficulties in keeping up with PCT fee changes. Some survey respondents suggested a refund of search and examination fees in situations where the international search report is late or when search and/or examination does not take place.

16. Another theme raised in the free text comments was the services provided by receiving Offices. The issue most frequently raised was electronic filing, which represented 65% of the total number of receiving Office comments. Many survey respondents complained about electronic filing and provided a number of suggestions for improvement, e.g., e-filing simplification, electronic exchange of documents, harmonization, and software integration of the various electronic filing systems. Problems encountered with basic receiving Office procedures were also raised, such as simplifying the filing requirements and streamlining document transmission.

17. Survey respondents also commented on other areas such as patent grant/protection, national phase procedures, sequence listings, and level of satisfaction with respect to the PCT.

## PART II PATENTSCOPE®

18. Part II of the survey contained questions on the use of PATENTSCOPE®, WIPO's website for patent information products and services.

19. Just over 50% of survey respondents indicated that they consult PATENTSCOPE® at least once a week and another 24% at least once a month. The survey respondents said that the most popular services/resources are the *PCT Newsletter*, PATENTSCOPE® search service, *PCT Applicant's Guide* and PCT Legal Information. Less than 16% said that they do not consult PATENTSCOPE® on a regular basis, and about 8% said that they have never used PATENTSCOPE®.

20. While many survey respondents expressed general satisfaction with PATENTSCOPE®, several of them made a number of suggestions in respect of improvements to the search service, and to the inclusion of additional information and documents. In particular, the following suggestions were made:

- Make available pre-publication documents, patent families, prior art citations, responses to written opinion;
- Provide more information on national phase entry status including the results of search and examination conducted in the national phase; and
- Provide links to particular services provided by national/regional Offices.

21. Other suggestions were made in respect of an automated translation service, an online discussion group for intellectual property, and a patent-alert service to monitor the developments in a specific field.

## PART III PCT INFORMATION RESOURCES ON PATENTSCOPE®

22. Part III of the survey contained questions on the PCT Information Resources on PATENTSCOPE®. Between 65%-70% of survey respondents found the general presentation and layout of the PCT Information Resources to be good or very good, and a like number found the quality of those resources to be good or very good. Some 55% of survey respondents gave the completeness of the PCT information resources a good or very good response.

23. A number of suggestions were made for improvements, such as, the development of an improved interface to simplify the retrieval of information, and a more simplified presentation of PCT fee schedules. It was also suggested that the availability of information in French and German be improved.

### *PCT Applicant's Guide*

24. Over 50% of survey respondents consulted the *PCT Applicant's Guide* from time to time, another 25% on a monthly basis. Some 70% of survey respondents considered the quality and completeness of the *PCT Applicant's Guide* to be good or very good.

25. A number of survey respondents complained about the complexity of the *PCT Applicant's Guide* and the difficulty in finding answers to questions. Some suggestions were made, such as ensuring complete and up-to-date National Phase information, improving ease of use and ability to search for information, and improved presentation of information. Some survey respondents suggested that an updated version of the *PCT Applicant's Guide* be made available in German. Some others expressed an interest in the inclusion of information targeted to experienced users.

### *PCT Newsletter*

26. Some 78% of survey respondents considered both the quality and the completeness of the *PCT Newsletter* to be good or very good with a number of comments expressing particular satisfaction with the Practical Advice section of the *PCT Newsletter*.

27. A number of improvements were suggested, among them: the establishment of an e-mail address for the submission of practical advice related questions, the availability of more substantive information about changes in the PCT, and regular updates and reminders.

28. The majority of survey respondents preferred the PDF (82%) over HTML (13%) format of the *PCT Newsletter*. Some of them expressed a preference for the former layout and presentation of the *PCT Newsletter* while others suggested that earlier issues of the *PCT Newsletter* be made available in electronic form.

### PCT Seminar Materials

29. Some 56% of survey respondents were not familiar with the PCT seminar materials. Most of those who were familiar with the seminar materials found the quality to be good or very good.

30. A small number of complaints were made in respect of the PCT seminar materials, e.g., low quality, complexity of the materials, material being overly framed in the legal context, lack of ready answers to crucial questions.

31. A number of improvements were suggested, such as, improved arrangement of PCT seminar content, the inclusion of more examples in order to provide for a better understanding of the PCT Regulations, timely updates of changes, and improved web presentation.

## PCT Multimedia (Video) Presentations

32. The majority of the respondents (86.3%) were not familiar with the PCT Multimedia (Video) presentations. Only 50% of those who were familiar with the presentations found them to be of good quality. A limited number of complaints were made in respect of quality and the difficulty in downloading presentations.

33. It was also suggested that WIPO produce shorter videos covering single topics.

## PART IV SERVICE DELIVERY OF THE INTERNATIONAL BUREAU

34. Part IV of the survey contained questions related to the services provided by the International Bureau in respect of PCT procedure, e.g., formal examination of PCT applications, international publication, various translation functions, etc. This part also contained questions on the general functions of the International Bureau as a receiving Office.

35. The majority of survey respondents considered the overall quality of the service provided by the International Bureau of WIPO to be good or very good.

36. A number of comments were made on the following issues:

- Improve communication between the International Bureau and the applicant's representatives;
- Improve confirmation mechanism in respect of facsimile transmissions;
- Increase reliance on electronic communication;
- Introduce "account managers" for large users; and
- Provide for electronic access to the complete file of the PCT application.

37. A small number of comments were made in respect of errors in the international publication of international applications and to better quality and timely translations.

## PART V PCT INFORMATION AND SEMINARS

38. Part V of the survey contained questions on the PCT Information Service and PCT Seminars.

### PCT Information Service

39. Close to 50% of survey respondents do not use the PCT Information Service. The majority of those who used the service considered it to be good or very good.

## PCT Seminars

40. Just over 50% of survey respondents said that they had never attended a PCT seminar at which WIPO personnel had taught about the PCT. A large percentage of those who had attended a PCT seminar found it to be good or very good.

41. The preferred seminar formats were, in decreasing order:

- One-day update on latest developments;
- Two-day advanced seminar; and
- Two-day basic seminar.

42. The large majority of survey respondents preferred the delivery of seminar content in person rather than by other means.

43. Some respondents suggested that the number of geographical locations for seminars be expanded. Others suggested that seminars include advanced topics and new developments in the PCT.

## PART VI ELECTRONIC FILING

44. Close to 70% of survey respondents have filed PCT applications electronically. Over 75% of them found the electronic filing system to be good or very good.

45. The majority of electronic filings were made with the receiving Office of the United States Patent and Trademark Office followed by the European Patent Office and the International Bureau of WIPO.

46. The large majority (80%) of PCT applications were prepared using MS Word followed to a much lesser extent by the PCT-SAFE Editor.

47. The preferred electronic filing format was overwhelmingly image format (e.g., PDF, TIFF). Character-coded (XML) format filing is not widely utilized by survey respondents.

48. A number of complaints were made in respect of the usability of electronic filing software with many respondents providing comments on both PCT-SAFE and the electronic filing systems used by national Offices (i.e., United States Patent and Trademark Office, European Patent Office). Some survey respondents also expressed frustration with the time required to file PCT applications electronically.

49. Other comments made by survey respondents included fee calculation issues and suggestions for service improvements.

## PART VII RECEIVING OFFICES

50. Part VII of the survey concerned services provided by receiving Offices. Survey respondents provided feedback on their experiences with 38 receiving Offices. The majority of feedback was provided for the receiving Office of the United States

Patent and Trademark Office (206) followed by the European Patent Office (113), the International Bureau of WIPO (58), Australia (24) and Canada (22).

51. Survey respondents who provided comments complained about knowledge levels and the availability of receiving Office staff, in particular, the receiving Office of the United States Patent and Trademark Office (RO/US). Several survey respondents also made reference to difficulties with using EFS-WEB, the RO/US electronic filing system. Other complaints were made in respect of the timeliness of receiving Office communications and to specific receiving Office procedures, especially those related to electronic filing.

## PART VIII SERVICES PROVIDED BY THE INTERNATIONAL SEARCHING AUTHORITY

52. Part VIII of the survey concerned services provided by International Searching Authorities (ISAs).

53. The European Patent Office (ISA/EP) was selected most often by survey respondents as ISA, followed by the United States Patent and Trademark Office (ISA/US), the Republic of Korea (ISA/KR), and Australia (ISA/AU). The services offered by these ISAs were generally found to be satisfactory or above.

54. The main issues raised by survey respondents in their comments were directed to the search report, written opinion, procedures, timeliness, costs, and unity of invention determination. Some expressed the view that ISA examiners do not take PCT applications seriously as compared with national applications.

55. A number of comments were directed to the low quality of the search report and written opinion. Comments were also raised in respect of examiner skill levels and with the quality of their arguments and objections.

56. Several of the survey respondents complained that the International Search Report (ISR) is not significantly relied upon by national Offices and thus questioned the value of the ISR.

57. Some survey respondents expressed the view that the ISA/EP application of unity of invention was overly rigid.

58. A number of survey respondents complained about the ISA/US practice of outsourcing searching and written opinion work to private contractors. Many complaints were also made in respect of RO/US delays in issuing search reports and written opinions.

## PART IX SERVICES PROVIDED BY INTERNATIONAL PRELIMINARY EXAMINING AUTHORITIES

59. Part IX of the survey concerned services provided by International Preliminary Examining Authorities (IPEAs).

60. The European Patent Office (IPEA/EP) was selected most often by survey respondents as IPEA, followed by the United States Patent and Trademark Office (IPEA/US), and Australia (IPEA/AU). The services offered by these IPEAs were generally found to be satisfactory or above.
61. The main issues raised by survey respondents in their comments were directed to the International Preliminary Report on Patentability Ch.II (IPRP Ch.II), skill levels of patent examiners, procedures, timeliness and costs.
62. Several complaints were raised in respect of the IPRP Ch.II with some suggesting that the poor responses provided by some patent examiners was linked to low skill levels.
63. In respect of IPEA/US, a number of complaints were made regarding the repetitive nature of the IPRP Ch.II and that the IPRP Ch.II does not add any value to the international search or written opinion.
64. In respect of IPEA/EP, a few survey respondents suggested that the EPO provide for multiple claim amendments. They also encouraged increased pro-active dialogue between the applicant and examiner during the IPEA procedure in situations where an applicant response is unsatisfactory. It was also suggested that the IPEA/EP should always issue a written opinion of the IPEA.
65. Complaints were also made regarding the fact that some IPEAs failed to consider PCT Article 19 and 34 amendments before issuing an IPRP Ch.II.
66. Some complaints were also raised in respect of the timely issuance of IPRP Ch.II reports and with the high cost of the IPEA procedure.

## PART X GENERAL QUESTIONS ON THE NATIONAL PHASE

67. Part X of the survey concerned the experiences of survey respondents with the national phase procedure.
68. The primary regions of national entry were Western Europe (24%), followed by North America (23%) and Asia (20%).
69. Close to 60% of survey respondents said that the PCT did not provide them with an expedited grant in the national phase.
70. Some 56% of survey respondents encountered obstacles during the national phase procedure, in particular, the discovery of new and pertinent prior art (21%) and a requirement that PCT applications be amended to conform with national requirements (30%). Reference was also made to other obstacles (5%).
71. A number of PCT users expressed frustration with the fact that national Offices failed to make effective use of search and examination reports produced during the international procedure. In this regard, specific comments were raised in respect of the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office. A small number of comments were raised in respect of

differing standards of patentability at the national level, duplication of work, and delays in patent granting.

72. Other comments raised by PCT users addressed national requirements, national phase entry procedures, and the need for adequate training.

## CONCLUSION

73. The main themes for improvement that may be extracted from the survey results are the following:

- Timeliness in the delivery of search and examination reports. This was the most frequently heard complaint in the free form comments, and was repeated throughout most sections. Several of the comments called for fee refunds when reports are sent late, suggesting that some of the dissatisfaction with PCT fees may be tied to poor performance in respect of timeliness.
- Quality of search and examination reports. Most respondents reported an overall satisfaction with the search and examination processes but found that the results in practice were sometimes less than expected. Comments tended to focus on questioning the value of the reports in practice and the perceived skill levels of patent examiners. Respondents particularly criticized the USPTO practice of outsourcing the preparation of their PCT reports. There was also dissatisfaction with the low level of reliance on the reports by national offices.
- Frequency of rule changes. The frequency of PCT rule changes, as well as the number of member states filing reservations and incompatibility statements for specific rules, was criticized. A number of respondents reported difficulties in locating answers to specific questions about the PCT system. The information resources provided by WIPO are generally well-liked, but ease of searching and use of those resources could be improved.
- High level of PCT fees. Respondents generally complained of both the level of fees charged to small and medium enterprises and the lack of any fee refunds in the event of late reports or for searches which are not performed.
- Application of PCT search and examination results in the national phase. Respondents would like to see more reliance and acceptance of PCT search and examination results by national Offices.

74. There is a general degree of satisfaction with the work conducted by the International Bureau, receiving Offices, International Authorities, and with the PCT system as a whole. That said, it would appear that aspects of procedures before receiving Offices, International Authorities and national Offices may merit closer attention. Matters worth highlighting are fees, backlogs, legal framework, PCT procedures, quality and uniformity of search and examination, increased electronic processing of PCT applications, and effective use and application of PCT search and examination results in the national phase.

75. The survey results will be considered as part of broader efforts to further improve and enhance the PCT System for the benefit of users, Offices, International Authorities and the International Bureau of WIPO.

76. Annexes of the PCT Survey are available upon request.