

FICPI Proposal for a PCT LINK System – Jan Modin

Background

Last year, WIPO issued a document suggesting some improvements of the PCT system, denoted PCT Roadmap, which is an attempt to improve the system without changing the legal framework, but making the system more effective and also picking up the concept of Patent Prosecution Highway arrangements. In parallel to this, a new system of Supplementary Searches has been introduced following some recent rule changes in the PCT making such searches possible during the international phase of a PCT application.

Still, as also recognised in the WIPO Roadmap paper, it remains to make the PCT system even more attractive and yet effective and to ensure a better coordination between the patent offices of the contracting parties. The proposal below intends to be instrumental in achieving this goal.

The PCT system is based on a principle of dividing the patent process for several countries in two parts, an international phase with a single, comprehensive, high quality search and possibly also an international preliminary, non-binding examination, and a national phase, involving an ultimate granting process under national law.

Unfortunately, it has turned out that the international search product (International Search Report and Written Opinion) is not acknowledged as a basis for further search and examination among the designated offices, as would be desirable. In this regard, there are two extremes. On one hand, a number of offices simply take the search and preliminary examination as a final product and grant a patent without further efforts. On the other hand, some other designated office start the national phase process basically from scratch, beginning with a fresh search, and virtually take no notice of the work already done by the PCT searching and examining authorities.

Another problem is that in many Offices being appointed as PCT Authorities, there is not enough time for a meaningful search and examination process. Therefore, the international phase examination process is often limited to one major effort, by the PCT searching authority (ISA). So the further process during the international phase is most often inconclusive and leaves the fundamental issue of patentability quite open, mainly because of insufficient time for a dialogue between the office and the applicant. Recently, as a response to requests from the user organisations, there has been installed a system for optional supplementary searches at other PCT authorities during the international phase. However, it appears that this additional option, as it has been implemented, will not solve the problem. The costs are probably far too high to the applicants, the further search is not truly supplementary in nature, and only a few PCT Authorities have joined the system.

Accordingly, we are at present far from an ideal situation where the total search and examination is shared by the international and national authorities and where the national offices build on the work already done by the international searching and examining authorities.

Another consideration is the third party interest. At present, the WIPO tool PATENTSCOPE is effective for searching among published PCT applications. However, it is not so easy to find relevant information concerning national and regional phase applications. The present

proposal intends to facilitate for Offices and third parties to easily obtain relevant information on such national and regional applications.

Main idea of a PCT LINK System

The present proposal for a PCT LINK system aims at coordinating the efforts of the PCT Authority and the designated or elected offices, at least those having facilities for search and substantive examination, in line with the concepts of the PCT ROADMAP recently presented by WIPO.

According to the PCT LINK system now being proposed (see also the appended flow chart), there should be established, for increased efficiency and work sharing, a

- a link between the efforts of the office of first filing “OFF” and those of the PCT Authority,
- also links between the PCT international phase efforts and the efforts made by the designated/elected offices during the national phase processing of the PCT application, including a feedback of supplementary search results to the other designated/elected Offices, so as to effectively provide a kind of extended international processing, without involvement of the PCT Authorities, and
- a publicly available data base containing information on the PCT application as such and the above-mentioned links, as from 18 months from the priority date of each PCT application, following a voluntary authorisation by the PCT applicant in the PCT request, if needed. There should be incentives for the applicant and the offices to authorise public availability and to coordinate the efforts, respectively, and for the offices to deal with the national phase procedure at an early date.

It is believed that such a system can be implemented without changing the overall legal frame-work of the PCT.

First link – Office of first filing OFF and the PCT Authority ISA-IPEA

There is an increased number of first filings with PCT Authorities. Still, it is more frequent that applicants make a first filing with an Office other than a PCT ISA, or with a national/regional Office in its capacity of a national/regional office. In the latter cases, and provided that the first office is an examining office, it would be meaningful for the subsequently involved PCT ISA to systematically build on the results gained by the OFF. If there is a problem of confidentiality, this could be remedied by having the applicant cross a box in the request form authorising the OFF and the PCT ISA to exchange information on the dialogue between the applicant and the OFF, in particular in case such a dialogue is ongoing before the ISA starts its work. This will often be the case, but not always. There are a number of examples where the OFF normally starts the search and examination during the first 12 months, viz. the German, UK and the offices in the Nordic countries (SE, DK, NO, FI) and presumably also in other countries.

There is already a system of partial refund of the search fee among these offices, but this system can probably be expanded in order to increase the incentive for such coordination.

The coordination should operate in both directions. It does not work that way today. There would be savings if the OFF and ISA processes were coordinated, especially of course if the OFF is the same office as the ISA. So, the OFF may have use of the ISA search result and the ISA Written Opinion as well, even before these documents are published. The processes can preferably be totally coordinated if the applicant files a demand under Chapter II. Then, there can also be a partial refund of the national office examination fee or the fee for IPE.

It goes without saying that such coordination would involve a saving of substantial work for the OFF as well as the PCT ISA-IPEA.

By crossing the same box, or an additional box, the applicant could also authorise the OFF and the PCT ISA to make the combined efforts publicly available, through the PCT file, at 18 months from the priority date. This would be of benefit both to patent applicants and to third parties.

PCT LINK Data Base

There should be established, e.g. as an extension of the present PATENTSCOPE, a data base at WIPO, containing, as from 18 months from the earliest priority date:

- all bibliographic data relating to the PCT application, including priority details, these data being updated at least up to national entry, i.e. longer than 31 months,
- the current, full PCT file, and also including the dialogue between the ISA-IPEA and the OFF, the public availability being authorised, if necessary, by the applicant by way of a special (voluntary) authorisation in the PCT request,
- an extended PCT file, containing links to national/regional office websites, where national/regional phase information is presented in the English language in a standardized manner. This information should be updated during the whole pendency of the national/regional application, and should remain available for the duration of parallel applications and patents, i.e. at least 20 years from the PCT filing date. The national/regional offices should be encouraged to provide, at their websites, bibliographic information and supplementary search and examination reports, including a standardised presentation of what material has been searched at the national/regional phase, possibly including the international classes that were searched, which data bases that were covered, and also languages and keywords used, the claims presently on file, information on possible divisional applications and any other essential information.

Second link – Feedback from the designated/elected offices to other national/regional offices via the PCT LINK Data Base

Upon entry of the national/regional phase (within the same time-frame as today, i.e. 30/31 months from the priority date), there should be an incentive for each examining office to conduct a truly supplementary search and examination at an early date, building on the PCT Preliminary Report on Patentability (Chapter I or II), and to issue a National/Regional Examination Report within an appropriate deadline. In this way, information on all parallel patent applications in a given family will be very easily available to all stake holders, including the applicant, other offices and to third parties.

A crucial issue is to provide an incentive for the designated/elected offices to participate in such feedback activities within a reasonable time-frame.

Final grant process at the national/regional level – Balance of interests

Like today, the final process of examination and grant of a patent should take place at the respective national/regional offices being responsible for the grant of patents in the particular jurisdiction. Now, with the PCT LINK System, there will be a much better basis for the offices to look at a number of examination reports from the PCT Authority and other offices where a substantial examination has been carried out. Also, by building on work already made during the international phase, the Offices will be able to confine their efforts to evaluating the search and examination already carried out, to conduct search and examination on additional material available in the Office and to apply possible further national patentability criteria as well as possible third party observations or oppositions during the national phase procedure. If time permits, of course, any Office is free to check previous searches made and to conduct an additional search, if the circumstances warrant such extra efforts. Moreover, if narrower claims are filed, it may be necessary to focus the national or regional examination on the narrowed scope.

Furthermore, as a benefit from the view of cost-effectiveness, the applicant should be relieved from the obligation to inform the local Offices about examination results from other countries or the mere existence of parallel patent applications. Where there are requirements to file an Information Disclosure Statement or the like, as in the USA, such requirements can be confined to disclosing prior art items that have not been cited by other patent offices. Even in this regard, it would be desirable to have all PCT contracting parties participating in such a scheme, so that a complete and updated record on national and regional phase applications can be maintained.

With the PCT LINK System, it will be easier to obtain a fair balance of interests between the applicants and third parties. Thus, third parties will have better access to relevant information on the invention, and they will also have better opportunities to take part in the national granting process by way of filing observations or oppositions.

No changes in substantive patent law

Because of the final national granting process, the PCT LINK System does not in itself involve any changes in substantive patent law, and each contracting party is free to uphold its own patentability criteria.

Decentralised system

Any data base, containing a large volume of data originating from many different sources (in this case a large number of national and regional patent offices) will have a difficulty to be constantly updated, complete and correct. There are also issues of responsibility and liability. With the PCT LINK system, the responsibility lies with the respective patent office, and the reliability of the data will therefore be virtually of the same quality as can be obtained in other ways. Also, the data volume centrally at WIPO will be limited and basically confined to the international phase proceedings of the PCT applications and to links to the relevant office websites.

Standardised format

Preferably, the format of the data available at the national and regional offices, should be standardised, which has to be agreed upon among the PCT contracting parties. Such standardised format remains to be developed but may be gradually developed, from a rather limited and simple initial standard. Preferably, at the central PCT data base, there should be a list in the central data base, containing the contracting parties where national/regional applications have been filed, whereas most other data relating to the national/regional applications may be available at the national/regional office websites only.

Of course, for other offices and third parties, it is interesting to access the status of any national/regional application (whether a particular application is still pending, whether a patent has issued, etc.), and what additional prior art has been found (in addition to the prior art documents listed in the search reports of the ISA).

Other data of broad interest are

- details on the search and examination carried out (classes and data bases searched, key words used, etc.)
- independent claims presently on file (in the language of proceedings and possibly also translated to other languages – in machine translation)
- current bibliographical data
- possible other objections raised by the Office or third parties (observations or oppositions)

Conclusion

Hopefully, there will be a more effective work-sharing among the offices and a reduction of the total work-load for the Offices, and also for applicants and third parties. It has been said in the WIPO document on the future of the PCT that the offices already have the necessary capacity of dealing with all incoming patent applications and the problem is only one of properly sharing the substantive work. The PCT LINK System will hopefully contribute to achieving such work sharing. A crucial point to reach the goal is that all or most Offices will conduct truly supplementary searches in addition to the main search by the ISA.

Of course, the feasibility of the PCT LINK System will depend on the degree of participation of the major patent offices having facilities for search and examination. It will be necessary to introduce features that constitute a sufficient incentive for the offices, and possibly also for patent applicants to make use of the system, the crucial mechanism being coordination of search and examination activities among offices handling parallel applications concerning the same invention.

FICPI members (and others) are invited to propose more specific features which will provide such incentives for major patent offices and PCT applicants and, of course, other suggestions to make the system work in practice.

(end of text document – see attached chart)

PCT Link system – FICPI proposal 2009

