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WORLD INTELLECTUAL PROPERTY ORGANIZATION
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INTERNATIONAL PATENT COOPERATION UNION (PCT UNION)

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PATENT COOPERATION TREATY (PCT)

Seventeenth Session
Rio de Janeiro, February 9 to 11, 2010

PILOT PROJECT ON THE THREE-TRACK PCT SYSTEM

Proposal by the Korean Intellectual Property Office

SUMMARY

1. The PCT Working Group, at its second session in Geneva, from May 4 to 8, 2009, agreed that the PCT system can and should function more effectively to deliver results that meet the needs of applicants, Offices and third parties in all Contracting States. The draft roadmap proposed by the International Bureau (IB) in document PCT/WG/2/3 contains various ideas for improving the PCT. However, the Korean Intellectual Property Office (KIPO) believes that the future PCT system should include practical measures that encourage more applicants to use the PCT.
2. At the second session of the Working Group, KIPO proposed the three-track PCT system (with an accelerated track, normal track, and deferred track) as a way of attracting potential PCT applicants (document PCT/WG/2/11). Although some members expressed concern over the complexity and possible confusion that the proposal would add to the PCT system, others supported the idea of giving PCT applicants more options and adding flexibility to the PCT system. There was general agreement that KIPO's proposal should be discussed further as part of the development roadmap.
3. To identify some of the issues raised by members and to test the potential of the three-track PCT system, KIPO plans to launch a pilot project of the three-track PCT system and would like to invite other International Authorities to participate in the pilot project.

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BACKGROUND

4. A recent survey¹ on the three-track PCT system shows that PCT users in Korea like having various options in the PCT system because the options give them more flexibility in planning suitable patent application strategies. Most of the respondents agreed that the three-track PCT system would be useful for PCT users, and they said they would be willing to use the accelerated track or deferred track in a pilot project. They also said that, depending on the technical field, some applications would require an accelerated examination and others would require a deferred examination.

5. In November 2009, the Trilateral Offices (European Patent Office, Japan Patent Office and United States Patent and Trademark Office) agreed that a PCT application with a positive international search report and written opinion (ISR/WO) or international preliminary report on patentability (IPRP) could be used for the purposes of work sharing under the Patent Prosecution Highway (PPH). If, as we expect, other Offices adopt this view, there is likely to be greater demand for fast examinations in the PCT system so that applicants can acquire patent rights earlier in the national phase.

6. To identify the efficiency and challenges of the three-track PCT system, we therefore propose to launch a pilot project of the three-track PCT system and invite International Authorities to participate on a voluntary basis.

THREE-TRACK PCT SYSTEM

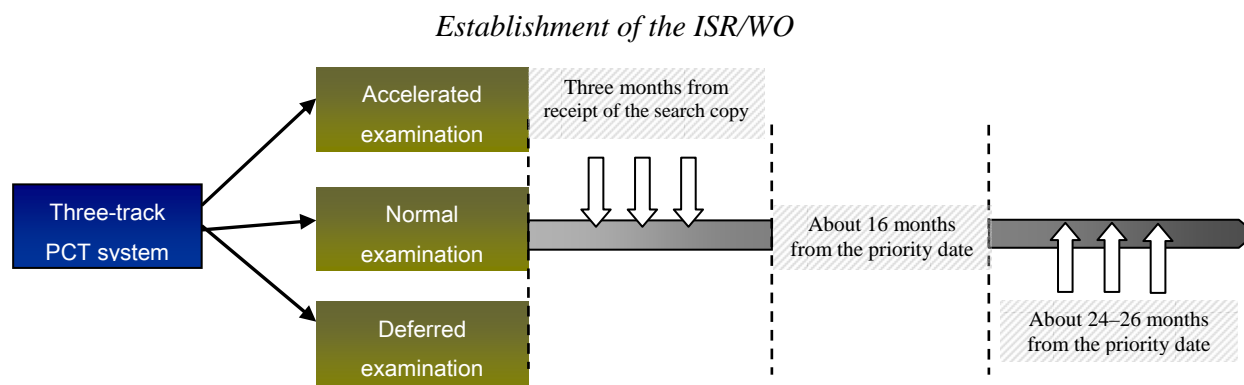
7. The three-track PCT system offers applicants three examination tracks: accelerated, normal, and deferred. Under the accelerated examination track, an international search is conducted within three months of the date on which the search copies are received, regardless of the priority date. The normal examination track refers to a regular examination under the current PCT system. Under the deferred examination track, the ISR/WO is established after the international publication, which is generally within 24 to 26 months of the priority date; a third party observation system could also be introduced.

8. The different options of the three-track PCT system are expected to boost the number of PCT applications, thus the resultant increase of national applications with an ISR/WO is expected to reduce the workload of the designated Offices. Applicants can choose a suitable PCT track in accordance with their patent strategies, the life cycle of their inventions, the commercial viability of their inventions, and so on.

9. Under the current PCT system, many International Authorities are forced by their backlog to delay the establishment of the ISR/WO, regardless of an applicant's request. This delay is one of the main obstacles applicants encounter during the international phase. Under the three-track PCT system, however, International Authorities can delay the establishment of the ISR/WO at the request of the applicant. This capability will help International Authorities

¹ In December 2009, KIPO surveyed the views of PCT users in Korea regarding the three-track PCT system.

keep the time limit for establishing the ISR/WO, and applicants will be more satisfied with the PCT.



Pilot Project of the Three-Track PCT System

10. Applicants can take advantage of the pilot project without any major change to the current PCT procedure. The general procedures of the pilot project are as follows:

(i) After a PCT application has been filed, the receiving Office sends the search copy to the chosen International Searching Authority (ISA). The ISA then sends the applicant a notification that the search copy has been received, together with an explanatory letter about the pilot project of three-track PCT system.

(ii) An applicant who chooses a accelerated examination or a deferred examination should submit a three-track PCT request form (provided exclusively for this project) within a month of the mailing date of the ISA notification regarding the receipt of the search copy. The accelerated track² can be selected only for a first PCT filing,³ whereas a deferred track can be selected for any kind of PCT application. Because the regular track is the default option, an applicant who chooses a regular track is not required to submit a three-track request form.

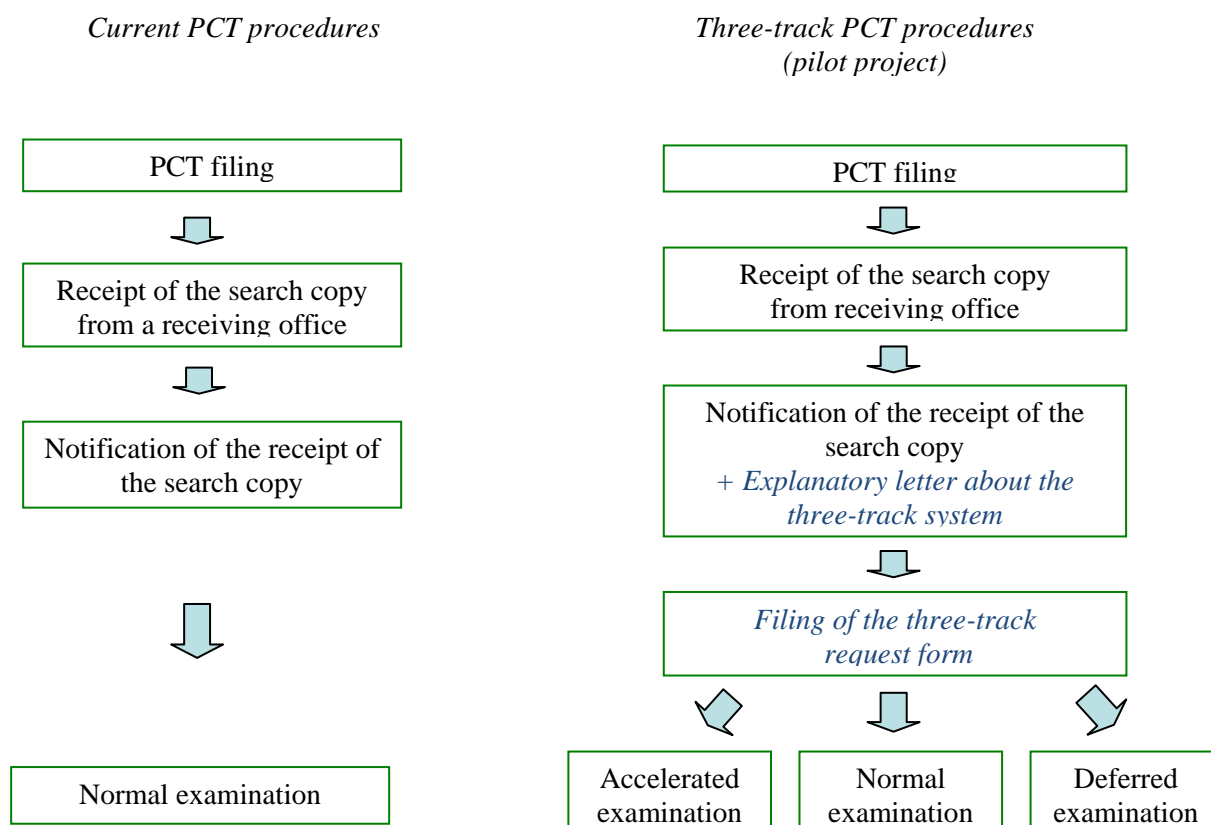
(iii) For the accelerated track, the ISA should establish the ISR/WO within two months of receiving the three-track request form thus within 3.5 months of receiving the search copy. These periods are based on the following constraints: firstly, the notification of the receipt of the search copy is generally mailed within two weeks of the receipt of the search copy; and, secondly, the three-track request form is generally filed within a month of the mailing date of that notification.

² PCT applications related to “green” technologies can be considered for the accelerated examination track in line with the International Bureau’s proposal which is outlined in document PCT/MIA/17/5.

³ According to KIPO’s internal statistics, about 6% of all the PCT applications of ISA/KR are first PCT filings (2008: 6.2%; 2009: 6.5%).

(iv) For the deferred track, the ISA should establish the ISR/WO at around 24 to 26 months from the priority date. The international search should preferably commence at least 24 months from the priority date to ensure a perfect top-up search. Under the deferred track, the demand for international preliminary examinations may be limited. However, this is not a major problem because applicants who request a deferred examination are already aware of this limitation.

11. Here is a flowchart comparing the three-track PCT system with current procedures:



12. For the pilot project, we need an explanatory letter about the three-track PCT system and the three-track request form. KIPO will prepare these documents and provide copies to International Authorities that participate in the project.

13. When the pilot project is launched, only one procedure for requesting the three-track system will be added to the current system, and the time limits for establishing the ISR/WO under each track will be shown automatically to the examiner. Accordingly, the project is not expected to add any complexity or confusion to the current PCT system.

Evaluation of the Pilot Project of the Three-Track PCT System

14. The pilot project will be conducted for a period of one year and limited to 100 cases of accelerated examinations and 100 cases of deferred examinations.

15. The pilot project will enable issues such as the following to be evaluated:

(i) What are the conditions and constraints under which the three-track PCT system can be introduced?

(ii) What are the costs of the three-track PCT system (particularly the cost of amending the IT system, additional time investments, and so on)?

(iii) What are the potential benefits for applicants and Offices (in terms of the level of user satisfaction, the possibility of increasing the number of PCT applications, flexible time control, and so on)?

16. After the completion of the pilot project, International Authorities can evaluate the project by conducting a survey among the three-track users.

NEXT STEPS

17. The pilot project is expected to be launched before the second half of 2010. In the first and second quarters of 2010, technical preparations will continue and information about the pilot project will be sent to PCT users. We hope International Authorities will consider participating in this project with KIPO.

18. KIPO will give a presentation on the results of the pilot project at the 2011 Meeting of International Authorities and PCT Working Group meeting. KIPO expects the results of the pilot project to stimulate further discussion on the three-track PCT system among the participants of those meetings.

19. The Meeting is invited to comment on the pilot project of the three-track PCT system.

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