

Meeting of International Authorities under the Patent Cooperation Treaty (PCT) Working Group

Eighteenth Session
March 15 to 17, 2011, Moscow

Transfer of Search Copies Using PCT-EDI

Document prepared by the International Bureau

SUMMARY

1. The International Bureau wishes to encourage the electronic transfer of search copies from the receiving Office to the International Searching Authority in an arrangement which has been approved by the PCT Working Group in 2008 but has not yet been implemented.

BACKGROUND

2. At its first session held in May 2008, the PCT Working Group noted with approval plans by the International Bureau, as set out in document PCT/WG/1/8, to offer a service whereby the receiving Office would be able (with the agreement of the International Bureau and the International Searching Authority) to transmit the search copy and other documents necessary for international search to the International Searching Authority in electronic form via the International Bureau, using the receiving Office's existing communication link to the International Bureau, for example, via the existing PCT-EDI system.
3. For ease of reference, document PCT/WG/1/8 is reproduced in Annex I to this document. The report on the Working Group's discussions on this issue (document PCT/WG/1/16, paragraphs 106 to 113) is reproduced in Annex II to this document.
4. So far, no Offices have agreed to use this arrangement in practice.

DEVELOPMENTS SINCE THE WORKING GROUP'S DISCUSSIONS

5. At the time of the discussions in 2008, a majority of record copies of international applications were already being sent from Offices in their capacity as receiving Offices to the International Bureau electronically using PCT-EDI, but very few of those Offices in their capacities as International Searching Authorities were yet set up to receive search copies of international applications in that way, even though this involves almost identical sets of documents.
6. Over the past two years, the International Bureau, in its capacity as a receiving Office (RO/IB), has set up a well-functioning process under which it transmits search copies to various International Searching Authorities either in electronic form only (to the Canadian Intellectual Property Office (ISA/CA), the Spanish Patent and Trademark Office (ISA/ES), the National Board of Patents and Registration of Finland (ISA/FI) and the Swedish Patent and Registration Office (ISA/SE)) or both on paper and in electronic form (such "parallel testing" is currently under way with the European Patent Office (ISA/EP), the Korean Intellectual Property Office (ISA/KR), the Japan Patent Office (ISA/JP) and the Federal Service for Intellectual Property, Patents and Trademarks of the Russian Federation (ISA/RU)). Consequently, these International Authorities are presumably now (or should soon be) able to receive and process search copies sent this way.
7. The benefits of the original proposal were seen as improving efficiency, quality and consistency:
 - (a) Time and money would not be wasted on mailing paper documents and scanning the same document several times.
 - (b) There would be no differences between record and search copies as a result of different scanning processes, and in particular there would be no loss of quality and information as a result of printing out electronically filed applications only to have them scanned in again by the International Searching Authority.
 - (c) Receiving Offices would not need to maintain separate systems with each individual International Searching Authority to which documents were being sent electronically.
8. The International Bureau is now piloting an online private file inspection system which could give the applicant the additional benefit of faster and more detailed knowledge of what has been sent to the International Searching Authority on what date in the case where the search copy is sent by this route.
9. As a result of these developments, it now seems to be a good time to promote implementation of this optional arrangement by receiving Offices and International Searching Authorities.

IMPLEMENTATION

10. In order to allow effective take-up of this system, it must be clear to each receiving Office which of its competent International Searching Authorities are willing to accept their search copies in this way and exactly what the process would involve so that they can decide whether it is worthwhile also participating.
11. The International Searching Authority will often need more than just the search copy itself before it can begin the international search. Consequently, simply forwarding a copy of the international application to the International Searching Authority will not be enough. The International Bureau's preferred approach to this would be as follows:

- (a) The receiving Office sends the record copy package (an electronic bundle of documents including the record copy and a number of accompanying items) to the International Bureau.
 - (b) The International Bureau extracts the documents from this package and prepares the ones which are relevant to the International Searching Authority for forwarding. Wherever possible, this action would be entirely automated and the forwarding would be carried out within minutes of receipt of the record copy by the International Bureau. In other cases (for example, where the body of the international application had been split into multiple documents which require a manual check of whether the creation of the single application body had been successful), the manual intervention would be treated as a high priority work item and the forwarding would take place immediately afterwards. In all cases, the forwarded package should reach the International Searching Authority faster than a paper copy sent by post,
 - (c) Any further documents which are not included in the record copy package (such as translations for the purpose of search and notifications that the search fee had been paid) are sent separately later by the receiving Office to the International Bureau and are also forwarded automatically, usually without any need for further processing.
12. The International Bureau would also be prepared to support an alternative approach whereby the receiving Office prepared a package specifically for the International Searching Authority and sent it only when all of the fees and documents had been received, as long as this approach was agreed for use by all receiving Offices and International Searching Authorities and was not taken as an alternative option used by some but not all.
13. The main benefit of the first option is that it would require less work to implement by receiving Offices since most are already sending the record copy this way and it would only be necessary to develop new systems to send later documents, rather than a large, new special package in addition to packages which need to be delivered later (which will always be a possibility). In addition, the first option will guarantee that the contents of the record copy and search copy are identical and that International Searching Authorities receive documents in a consistent way from all participating receiving Offices.
14. For International Searching Authorities willing to use this arrangement, the International Bureau would be prepared to also forward the OCR text of the application body as soon as it has been prepared, to assist with the international search in cases where the search copy was sent only as page images.
15. If there is sufficient interest from International Authorities, the International Bureau will follow this matter up with any more detailed consultations required. At this stage, it would be useful to collectively discuss:
- (a) which Authorities would be interested in receiving search copies this way;
 - (b) whether the approach outlined in paragraph 11 appears promising; and
 - (c) whether there are any additional document types, pieces of information or issues of technical format which need to be included in a practical implementation of this arrangement.

16. *The Meeting is invited to comment on the proposals set out in this document.*

[Annexes follow]

ANNEX I

TRANSMITTAL OF THE INTERNATIONAL APPLICATION,
TRANSLATIONS AND RELATED DOCUMENTS

(reproduced from document PCT/WG/1/8)

SUMMARY

1. The Working Group is invited to note plans by the International Bureau to offer a service whereby the receiving Office would be able (with the agreement of the International Bureau and the International Searching Authority) to transmit the search copy and other documents necessary for international search to the International Searching Authority in electronic form via the International Bureau, using the receiving Office's existing communication link to the International Bureau, for example, via the Electronic Data Interchange (EDI) system. Additionally, the International Bureau plans to offer International Searching Authorities access to the full text of international applications captured using optical character recognition (OCR).

BACKGROUND*Transmission of Documents*

2. At present, the receiving Office transmits the record copy and any translation required for publication to the International Bureau in accordance with PCT Rule 22 and separately transmits the search copy and any translation required for international search to the International Searching Authority in accordance with Rule 23. The system was set up on the assumption that each Office with a role in the PCT system would require a separate physical copy of the international application to be posted to it as quickly as possible, along with any necessary supporting documentation. Using only paper copies, this can only be achieved without undue delays if all the copies are distributed by the receiving Office.
3. At present, around 85% of record copies of international applications are received by the International Bureau from the receiving Office in electronic form; this covers international applications originally filed in electronic form, as well as applications filed on paper and scanned by the receiving Office. The remainder are converted into electronic form by way of scanning by the International Bureau. Normally, in either case, the international application is available in electronic form within 1 working day of receipt by the International Bureau.
4. However, very few search copies are sent by the receiving Office to the International Searching Authority in electronic form (except in the case where the receiving Office is the same Office as the International Searching Authority and the transmission is between different parts of the same Office, rather than to different Offices). This results in significant extra mailing costs for receiving Offices and, unless expensive overnight courier services are used, avoidable delays in receipt of the search copy by the International Searching Authority. Furthermore, the search copy will often need to be scanned by the International Searching Authority even though it might originally have been filed in electronic form, or else already scanned by the receiving Office or the International Bureau.

Diagram of current arrangements: Case 1 – paper transmission of search copy

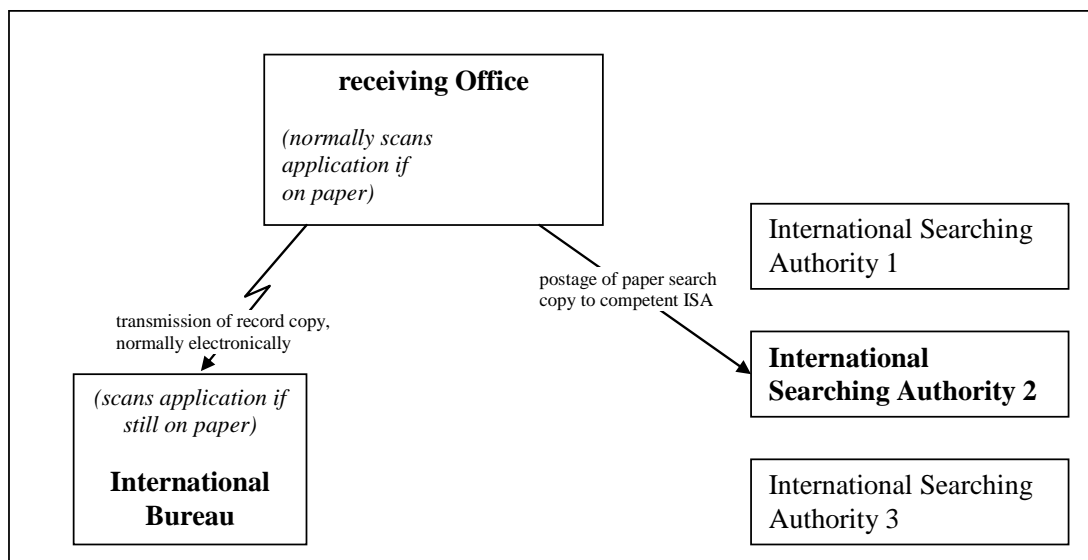
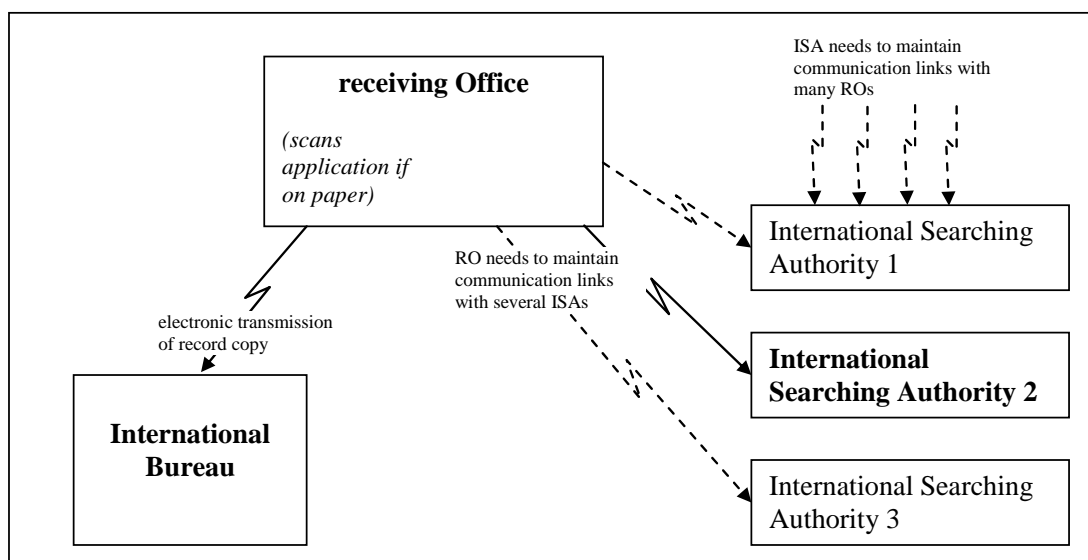


Diagram of current arrangements: Case 2 – electronic transmission of search copy



5. At its 15th session, held April 7 to 9, 2008, in Vienna, Austria, the Meeting of International Authorities (PCT/MIA) discussed the problem of international applications published without classification. It noted that a significant part of this problem was due to the International Searching Authority not receiving the search copy in sufficient time prior to the international publication date to be able to classify the international application in time. The Meeting agreed that means should be sought of providing search copies to International Searching Authorities in electronic form at an earlier stage (see paragraph 70(i) of document PCT/MIA/15/13).
6. One of the issues in delivering search copies in electronic form is the significant time and effort involved in setting up and reliably maintaining a link between two Offices suitable for the secure communication of international applications which have not yet been published: Offices use a wide variety of communications protocols, which need to be carefully tested whenever either party makes any changes. Since most receiving Offices permit applicants to choose from more than one competent International Searching Authority, transmitting search copies electronically will require more than one such communication link to be

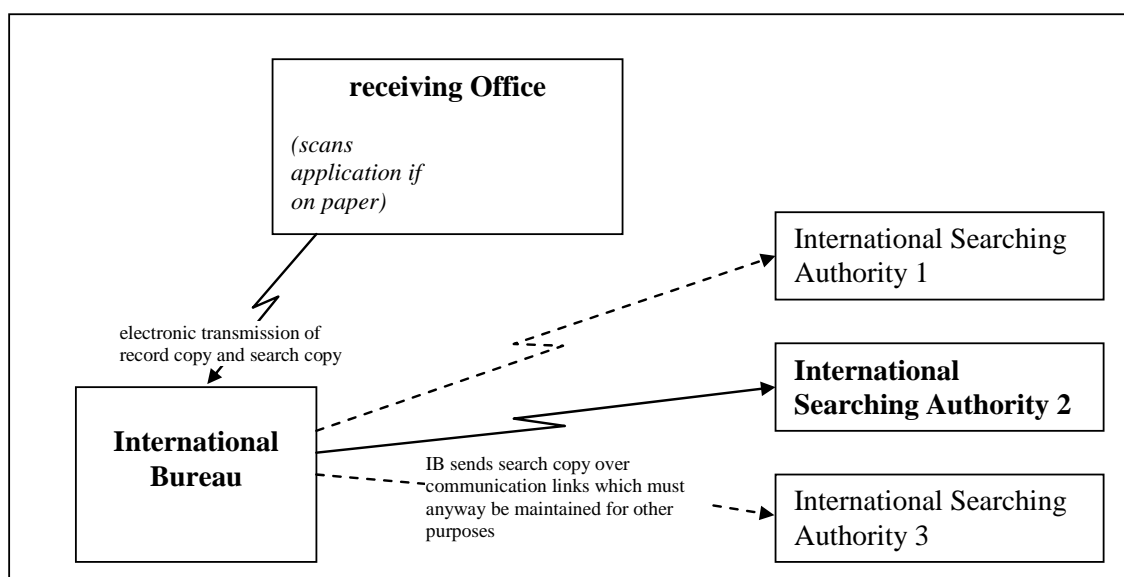
maintained, in addition to the communication link which is required with the International Bureau. As well as the cost of maintenance, this limits the speed with which any individual Office can implement changes to systems without risking cutting off communications with one or more of its partner Offices.

7. The International Bureau has already set up electronic communication links with a large proportion of PCT Offices, including all of those which act as International Searching Authorities, and is committed to maintaining them for communication of documents to and from receiving Offices and designated Offices. The same systems are ready for communications with International Authorities, even though these communication links are currently used for a much smaller proportion of documents than is the case for communications with those Offices in their other capacities. In particular, all but 3 of the Offices acting as International Authorities have accounts on the EDI system, which is presently used for a large majority of PCT electronic data exchange.

FORWARDING OF SEARCH COPY AND RELATED DOCUMENTS USING INTERNATIONAL BUREAU SYSTEMS

8. The International Bureau intends to offer an optional service whereby the receiving Office can (with the agreement of the International Bureau and the International Searching Authority) transmit the search copy and other documents necessary for international search to the International Searching Authority in electronic form via the International Bureau, using the receiving Office's existing communication link to the International Bureau via the EDI system. This would allow more timely delivery of search copies and elimination of mailing costs, without the associated expense of maintaining individual secure communication links with every International Searching Authority which is competent for the particular receiving Office.
9. The exact technical details of how this system will operate have yet to be finalized. However, it is hoped to begin a trial arrangement shortly involving certain receiving Offices uploading a package containing the search copy and related documents using EDI in a manner such that it is automatically transmitted to the International Searching Authority. This would require no changes to the legal framework since the International Bureau would be acting simply as a direct equivalent to the postal service.

Diagram of proposed optional service



10. Following a successful trial, the service would be offered to any pairs of receiving Offices and competent International Searching Authorities wishing to use such an arrangement. However, to assist in development, the Working Group is invited to comment on whether many Offices are likely to find such a system beneficial and whether there are particular features which would be considered necessary.
11. For the longer term, consideration is being given to whether arrangements could be made which would allow the receiving Office, rather than having to transmit two copies of the international application (the record copy and the search copy), to only transmit one copy of the application (the record copy) to the International Bureau, which in turn would prepare the search copy on the basis of the record copy and transmit it to the International Searching Authority. The issues to address include the following:
 - (a) Although the record copy and the search copy should be identical, save for the case where a translation is provided for search under Rule 12(3), the accompanying documents are different. This is not an issue where the component documents of a package (request, originally filed application, translations for different purposes, copies of information relating to earlier searches, etc.) are fully indexed by the receiving Office and the portions relevant to the different Offices can be automatically identified, but many scanned record copies are received by the International Bureau as an unindexed block of pages, which need to be manually separated into the different documents before they could be forwarded – since the International Bureau cannot guarantee to perform this action the same day that the data is received, this would significantly reduce the speed advantage sought.
 - (b) If the record copies do not contain at least the minimum bibliographic information in machine readable form which is required for correct routing of the search copy, the documents could not be processed until all the data had been manually entered by the International Bureau. Again, this would significantly reduce the speed advantage sought.
 - (c) The search copy is often sent later than the record copy because of delays relating to receipt of the search fee or of translations required for the purpose of search. Since it is neither permitted nor desirable to delay the transmission of the record copy pending receipt of these items, it would be necessary for the receiving Office to send the confirmation of receipt of the search fee and translations as later packages and the International Bureau's systems would need to decide whether to send the various components to the International Searching Authority separately, or only when all of them had arrived and been assembled into a single package.
12. The International Bureau is also looking at whether it could provide a similar service for receiving Offices which send record copies to the International Bureau on paper. However, although paper copies are usually scanned within 1 working day from receipt by the International Bureau, the indexing of the pages and entry of the bibliographic information essential to routing only takes place at a later stage, so at present it would not be possible to guarantee the speed advantage sought by this arrangement.

ADDITIONAL RELATED SERVICES

OCR Text

13. Some International Searching Authorities have expressed a desire for full text versions of search copies of international applications in order to assist with the international search. At present, the International Bureau performs an initial “rough” OCR process of the text of the description, claims and abstract (where the international application is filed in English, French, German, Russian or Spanish, and, as of January 2009, where it is filed in

Portuguese). This process is currently done in batches each weekend following the issue to the applicant of the Form confirming receipt of the record copy and the image corrections (for skew and margin deficiencies – see paragraphs 17 to 19 of document PCT/WG/1/5) which are performed on that copy at the same time (typically 1–2 weeks after receipt of the record copy). While this OCR is performed only to assist the work of the translators at the International Bureau and is not of the quality which is published later together with the international application, it may be sufficient for the purposes of the International Searching Authority.

14. For those International Searching Authorities which agree to receive documents in this manner, it may be possible to offer these OCR texts to assist the international search. Though they would frequently not yet be available at the time that the search copy is transmitted, they would normally be available by the time that the search copy is actually received by an examiner.

Late Search Copies

15. As noted in paragraph 5, above, a significant number of international applications are currently published without classification because, by the time that the international publication is prepared, the search copy has still not been received by the International Searching Authority. Independent of any arrangement to send the search copy by a type of arrangement as proposed in this document, it is proposed to make the record copy available to International Searching Authorities by similar arrangements so that they can provide classifications on request for international applications for which they have not yet received the search copy.

16. *The Working Group is invited to comment on the value and requirements of a service to electronically route search copies using existing communication links between the International Bureau and the receiving Offices, and between the International Bureau and International Authorities.*

[Annex II follows]

ANNEX II

EXCERPT FROM THE REPORT OF THE FIRST SESSION OF THE
PCT WORKING GROUP, GENEVA, MAY 26 TO 30, 2008

(reproduced from document PCT/WG/1/16)

“TRANSMITTAL OF THE INTERNATIONAL APPLICATION, TRANSLATIONS AND
RELATED DOCUMENTS

- “106. Discussions were based on document PCT/WG/1/8.
- “107. All delegations which took the floor on the matter expressed general support for the International Bureau’s plan to offer a service whereby the receiving Office would be able (with the agreement of the International Bureau and the International Searching Authority) to transmit the search copy and other documents necessary for international search to the International Searching Authority in electronic form via the International Bureau, using the receiving Office’s existing PCT Electronic Data Interchange (EDI) communication link to the International Bureau, and to offer International Searching Authorities access to the full text of international applications captured using optical character recognition (OCR). Several delegations expressed interest in exploring ways of using the system for the benefit of their national Offices in their capacities as receiving Offices and/or International Searching Authorities.
- “108. Following a query by one delegation, the Secretariat noted that, at present, it was envisaged that the new service would rely solely on EDI system links, since this could be offered at essentially zero cost through the existing infrastructure, whereas providing an equivalent service through other systems would require significant development work for which no budget was currently provided. However, the proposed service would be entirely optional, and any other form of communication link which existed between the sender and the recipient of data (such as, for example, the Trilateral Network) could be used provided that both the sender and the recipient of data so agreed.
- “109. Several delegations suggested that it would be very useful if the International Bureau could make the search copy available to the International Searching Authority in text format and not in an image format so as to facilitate the processing of the international application by the Authority.
- “110. It was noted that the communication of documents from the receiving Office via the International Bureau to the International Searching Authority would not require any changes to the present legal framework since the International Bureau would only be performing the role of an “e-courier” service, similar to the role performed at present by the postal service in the case of communication of paper documents. It was further noted that the proposals were not intended to affect in any way the present arrangements with regard to the payment by applicants of fees related to the international search; as at present, the applicant would be required to pay the search fee to the receiving Office, which would continue to transmit that fee directly to the International Searching Authority, with no involvement of the International Bureau whatsoever.
- “111. Following a query by one delegation, the Secretariat stated that, while many of the details, including details of a technical nature, of how the final system would operate remained to be determined, the receiving Office would not, at least in the trial arrangement, delay the transmittal of the search copy to the International Bureau until after the receipt of the payment of the search fee. Rather, the search copy would be transmitted from the receiving Office to the International Bureau prior to the receipt of the payment of the search fee, and the search copy would immediately

be made available by the International Bureau to the International Searching Authority. The Authority, however, would “pick up” the search copy only after it had been notified of the receipt of the search fee by the receiving Office.

- “112. Following a query by one delegation, the Secretariat confirmed that the communication of documents via the EDI system would take place in a secure environment, as witnessed by the fact that that system was already being used in the vast majority of cases for the communication in electronic form of record copies from the receiving Offices to the International Bureau.
- “113. The Working Group noted with approval the International Bureau's plans, as outlined in document PCT/WG/1/8, for automated transmittal of the international application and other documents.”

[End of Annex II and of document]