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PATENT COOPERATION TREATY (PCT)
WORKING GROUP

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COMPREHENSIVE PROPOSAL FOR PCT REFORM

Document prepared by the United States of America

SUMMARY

1. This document contains a proposal by the United States Patent and Trademark Office (USPTO) for a comprehensive revision of the international patent system which would result in the establishment of a new Patent Cooperation Treaty, PCT II.

BACKGROUND

2. At the May 2008 session of the Working Group, the International Bureau (IB) presented a paper titled "Enhancing the Value of International Search and Preliminary Examination Under the PCT" (PCT/WG/1/3). The paper was directed to the fact that the PCT had never achieved its original expectations, and questioned what changes were needed for the Treaty to function as originally envisioned. The PCT was specifically designed to act as a mechanism for mutual exploitation of the work product of other offices thereby reducing the overall workload of patent offices worldwide through the use of the international reports either as the basis for grant or at least as the basis for an accelerated examination process.

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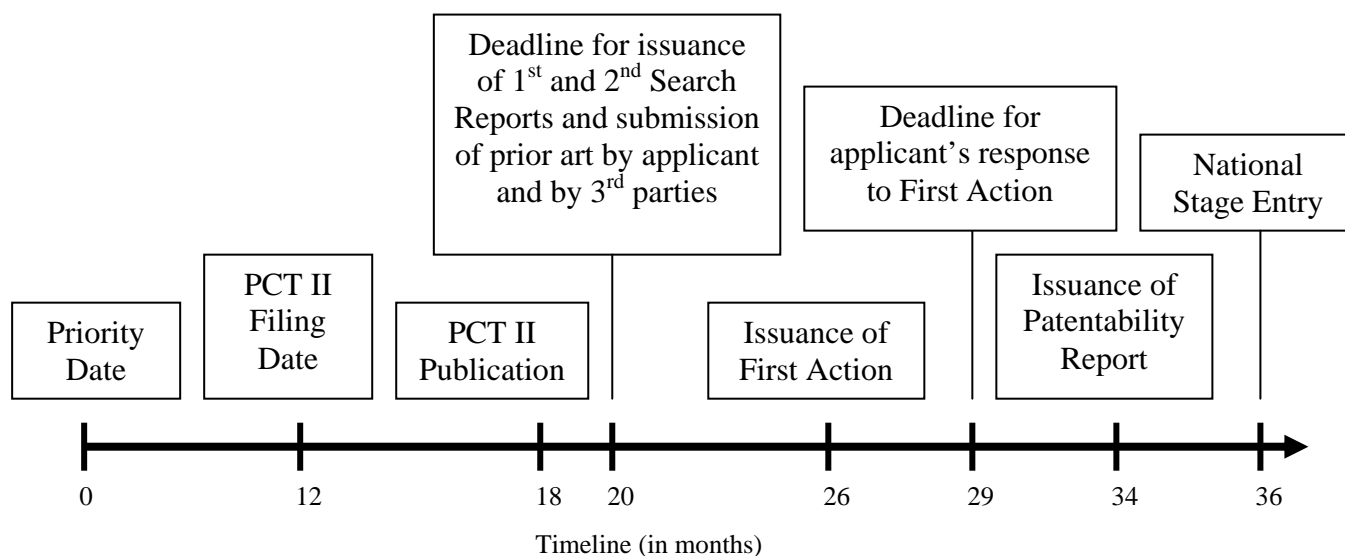
3. The USPTO began discussions, both internally and with the other Trilateral Offices, on possible future PCT reforms to address the shortcomings noted in the International Bureau paper. Those discussions resulted in numerous proposals being considered as possible solutions, such as simultaneous national/international processing, allowing for third party submissions, and collaborative search and examination.

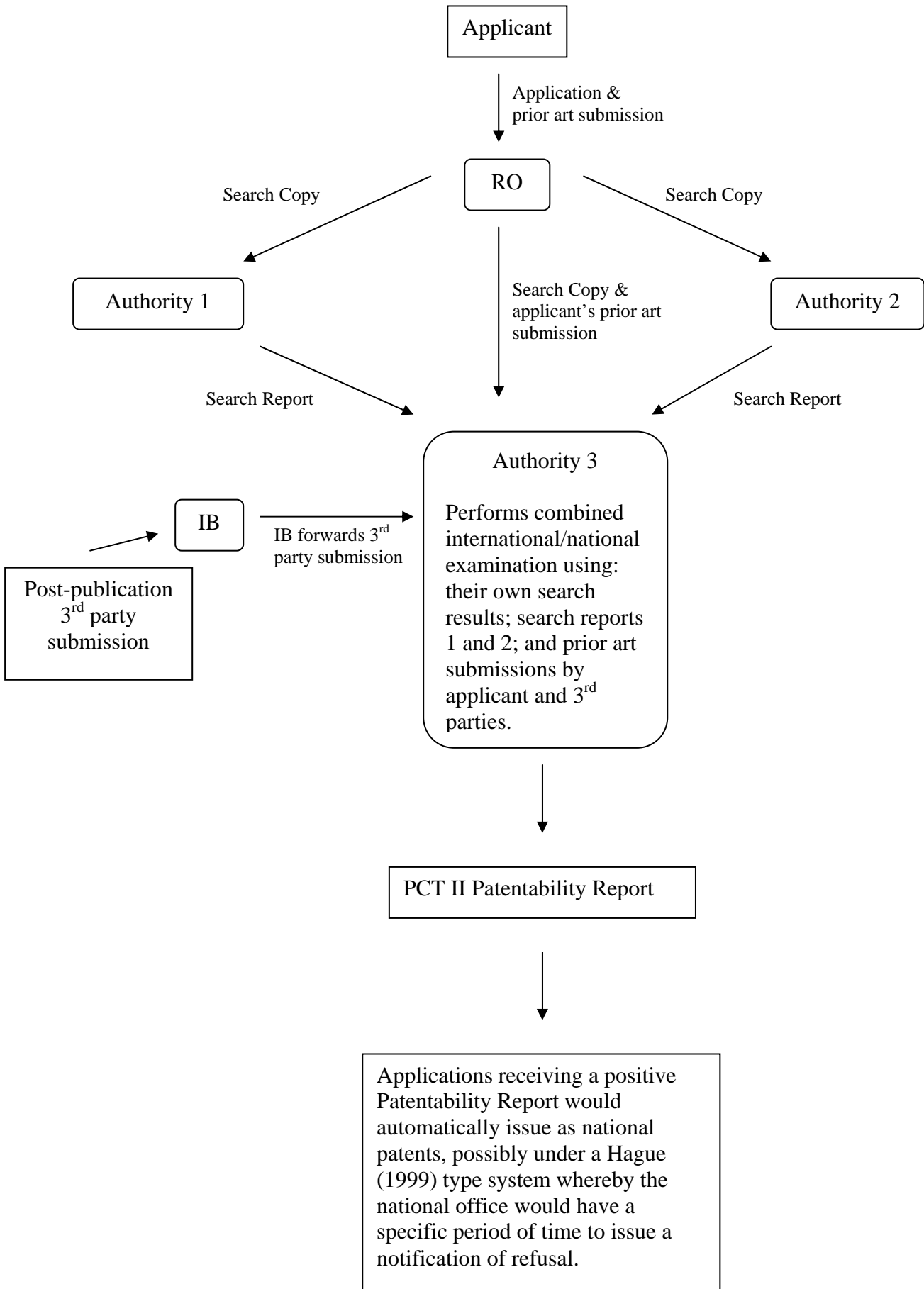
4. The first phase of PCT reform, while accomplishing many significant benefits, was hampered by the necessity of working within the present PCT framework, and the piecemeal approach to PCT reform. The USPTO proposed to the Trilateral Offices in September 2008, that consideration be given to taking a more comprehensive approach to PCT reform. Such an approach would have the goal of maximizing the utilization of the international work product by improving the international patent system so that the final work product would be of such a high quality that it would be readily used and accepted by national offices. A substantially similar proposal, as set forth below, was submitted to the Trilateral Offices for consideration.

5. In order to achieve such a goal, while also addressing the issues of workload and delays in processing of patent applications, the USPTO has proposed developing a new PCT which would include the following features: (i) the combining of international and national processing that will enable more efficient processing in the Authority/national office performing the search and examination, (ii) search/examination collaboration among Authorities, (iii) allowing for the submission of prior art by the applicant, and (iv) allowing for third party prior art submissions. Additionally, the combining of all of these features will result in an increased confidence level in the final international work product.

PROPOSAL

6. The proposal is represented in the below timeline and schematic.





7. A system as diagrammed above would result in an extremely high quality final work product that should be able to be heavily relied on, if not accepted, by national offices due to the fact that it is the result of a comprehensive search of multiple offices that incorporates prior art submissions by the applicant and third parties. It will have the additional confidence factor of being prepared in conjunction with the processing of the national application in Authority 3, thus resulting in either a patent grant or a final rejection in that office.

8. While the above diagram indicates that the two searching authorities would feed the result of their searches to Authority 3, which then performs a complete examination, the exact nature of such a system should be explored. For example, some sort of collaboration between one or more authorities, could be established. One Authority could focus their efforts on specific technologies or on certain language documents. Also, as common search tools are improved, it may be possible to reduce the number of Authorities giving input to the process. In addition, it may be possible to implement aspects of the Patent Prosecution Highway as applicants enter the national phase.

9. It is envisioned that applications receiving a positive report at the end of the international/national processing by Authority 3 would essentially result in automatic patent grants in all member States. Substantive harmonization and sovereignty issues could be overcome through a protocol system whereby a member State would have a given amount of time following the issuance of a positive International Patentability Report to issue a notification of refusal indicating that the conditions for the grant of protection have not been met.

10. Such a system should result in the issuance of patents having a very high level of confidence for applicants as well as substantial long term savings for the national/regional offices through its collaboration, work sharing, and mutual exploitation aspects allowing for the rapid resolution of international patent rights.

11. The Working Group is invited to consider the proposals contained in this document.

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