

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

Thirty-First Session
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MERGING INTERNATIONAL SEARCH REPORT AND WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

Document prepared by the International Bureau

SUMMARY

1. At various times, interest has been expressed in merging the international search report and the written opinion of the International Searching Authority. This could assist more efficient preparation of the reports and a better presentation of information to applicants and Offices. However, it would require significant investment by International Authorities as well as the International Bureau. If not implemented carefully and with consistent timing across all International Authorities, it could also greatly increase the cost of translation.
2. The preliminary view of the International Bureau is that the cost of comprehensive changes would only be justified if they were part of a broader plan to use XML more consistently and effectively.

BACKGROUND

3. Following the international search, an International Searching Authority will prepare and issue three forms together:
 - (a) PCT/ISA/210 International Search Report (or PCT/ISA/203 Declaration of Non-Establishment of International Search Report).
 - (b) PCT/ISA/237 Written Opinion of the International Searching Authority.

(c) PCT/ISA/220 Notification of Transmittal of the International Search Report and the Written Opinion of the International Searching Authority, or the Declaration (essentially, a cover sheet with information on potential further action).

4. These forms contain a significant amount of common information, but related items of information are set out in slightly different ways between the different forms. Most notably, this includes:

(a) The basis of the search/opinion (item 1 of the “first sheet”¹ of ISA/210 and Box No. I of ISA/237 contain substantively the same material, but numbered differently and, where sequence listings are used, split across different pages because of the lack of space on traditional forms with fixed page layouts).

(b) Material concerning unsearchable or unexamined claims (ISA/203 or Box No. II of ISA/210 and Box No. III of ISA/237).

(c) Material concerning lack of unity of invention (Box No. III of ISA/210, Box No. IV of ISA/237 and information concerning the status of any protest in item 3 of ISA/220).

(d) The lists of citations in the second sheet of ISA/210 are very closely associated with the reasoned statements concerning novelty, inventive step and industrial applicability in Box No. V of ISA/237, as well as the lists of “certain documents” in Box No. VI. However, it should be noted that they do not always match neatly because the “relevant dates” are based on the filing date for ISA/210 (Rule 33.1(a)) and on the priority date for ISA/237 (Rules 43*bis*.1(b) and 64.1).

5. The contents include elements aimed at different audiences, requiring different actions with different timeframes. Most notably:

(a) The first sheet of ISA/210 contains some material that is important to applicants and designated Offices (though this is mostly near-duplicated in ISA/237 as noted in paragraphs 4(a) to (c), above), together with elements (items 4 to 6 and Box No. IV) used primarily by the International Bureau to determine the appropriate contents of the front page of the publication.

(b) The second sheet of ISA/210 (along with some parts of the first sheet) is attached to the international publication in accordance with Rule 48.2(a)(v) (or published in a later A3 document if not available in time for initial publication). In accordance with Rule 48.3(c), reports that are not established in English are translated into English for use as part of the publication.

(c) Form ISA/237 is made available to the public in its original language when the international application is published. If no international preliminary examination report is to be established, the report is used in the international preliminary report on patentability (Chapter I of the PCT) under Rule 44*bis*.1 and is translated into English in time for that report to be distributed to designated Offices 30 months from the priority date. It may also be translated into English early under Rule 44*bis*.3(c) in the event of early national phase entry.

(d) Form ISA/220 is essentially a cover sheet, providing the mailing address (though many reports are no longer sent by physical mail), and information to the applicant concerning further stages of processing and options and time limits for further actions. It is important to the International Bureau for the date of mailing (in principle, also shown on

¹ The “first sheet” of the international search report is generally administrative in nature. The “second sheet” contains the details of the search itself. Both will commonly in fact include one or more continuation sheets.

ISA/210, but sometimes indicated there only by reference), which is relevant to the time limits for Article 19 amendments and submission of the demand for international preliminary examination.

6. Merging the various forms remains an item under long term consideration in the line of work concerning improvement of the international search report and written opinion. Deciding whether or not to attempt such a change is a key factor in determining how best to approach some of the other improvements desired.

PROCESSING CONSIDERATIONS AND OPPORTUNITIES

7. If the process were designed from scratch, the result would probably be a single form, but with the information grouped more logically by default, yet stored in formats that allowed efficient processing of sub-sections so that:

- (a) Examiners could enter and review data more efficiently.
- (b) Applicants could see the information important to them in a more logical order and without repetition.
- (c) Designated Offices would be able to read the reports more efficiently.
- (d) The International Bureau could extract data more efficiently and reliably, while still being able to separate data and views of sections of the reports for separate processing without the risk of confusion, such as over which parts of a document needed to be translated or from having different parts of the same XML file in different languages following translation of part of the report.
- (e) Users in general would be able to use the data from the reports in a variety of different views, according to the needs of their particular tasks.

8. It might also be considered that the international search report and declaration under Article 17(2)(a) no longer needed to be formally included as part of the contents of the publication of the international application under Rule 48.2(a)(v), but with Regulations to prescribe publication of the international search report as a separate document. It should be noted that the international search report is readily available from the same sources as the international application and might often be more convenient to be displayed side-by-side with the application body rather than after it, and in its HTML format with links to citations, rather than as a PDF image.

9. From the point of view of the International Bureau, it is critical to ensure that parts of the report that are processed in different ways can be efficiently handled as separate units. As noted above, at present the second sheet of ISA/210 is used as part of the formal international publication and is, where necessary, translated into English before publication. The part that is translated and published must be easily separable in both image and data formats. The ISA/237 is usually translated separately at a much later time.

10. Bringing the translation of ISA/237 forward would be extremely expensive. There would be a one-off cost in the order of tens of millions of Swiss francs to translate the backlog of reports earlier than would otherwise have been necessary². But there would also be large additional ongoing costs compared to the present situation:

² In addition, new temporary translation contracts would need to be set up since the International Bureau's existing contracts and quality oversight arrangements would not have the capacity to deliver the necessary volume of work to bring forward the translations of written opinions in a suitable transitional timeframe.

- (a) Reports on applications where international preliminary examination is demanded would be translated unnecessarily (and would not necessarily significantly assist the translation of the subsequent international preliminary examination report).
- (b) Satisfactory translation of a written opinion requires the application body to be shared (this is not usually necessary for the much simpler content of the international search report). Noting that almost all translation of reports is outsourced, requiring the translations prior to international publication would require new, secure processes to be set up with the translators, with the associated costs and risks.
- (c) There is typically a very short time between receipt of the international search report and international publication. The relevant parts of the ISA/210 are sufficiently short and simple that there is time to translate the report without disrupting the publication process. The length and complexity of ISA/237 would result in many more delays in publication or republications and the associated costs.

11. Technically, it would be possible to deliver a combined report that still allowed the different types of material easily to be separated and processed in different ways and at different times. It would also make reports somewhat easier to read and help to deliver improved services around the search process and the use of search and examination data.

12. However, it would require the data to be delivered by all International Authorities in a consistent XML format, carefully designed to meet the relevant needs. The new format would need to be designed carefully and International Authorities would need to commit to changing their processes and IT systems to begin using the new format to similar if not identical timescales. Any such consideration ought also to take into account national arrangements for search and examination, as well as exchange of search and examination data between related applications and different stages of processing.

POSSIBLE FURTHER WORK

13. International Authorities are invited to comment on whether they consider the possible benefits of formally merging the international search report and written opinion of the International Searching Authority to be sufficient to justify more detailed study. A carefully considered new data format and associated views could certainly improve services and efficiency but would require significant coordinated investment and some of the benefits sought can probably be achieved through smaller scale changes.

14. In the view of the International Bureau, even if the issues concerning translation costs are properly addressed, the effort and disruption involved in defining the new XML standards and building tools to create or use the data could only be justified if it formed part of a wider project to improve the efficiency of data exchange concerning international and national phase search and examination reports, such as if Offices started to use the same standards in national processing and make the relevant data available.

15. In the meantime, the International Bureau's tools for creating search reports and written opinions in ePCT seek to address some of the issues over creation of the reports by grouping data entry by subject, independent of the arrangement of information on the form and ensuring that data used by several forms need only be entered once. Further optimizations are being considered. It may be possible to further streamline data entry and applicant experience by minor revisions to the existing forms, aiming to group data better and, if possible, to eliminate duplication of data. This would, however, in itself imply the need for International Authorities to change systems, albeit in smaller ways.

16. The International Bureau would also like to consider ceasing to include the international search report into the international publication itself and instead concentrate on providing better services around the delivery of information from the international search report and written opinion alongside the international publication.

17. The Meeting is invited to comment on the contents of document PCT/MIA/31/7.

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