

# WIPO



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WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

INTERNATIONAL PATENT COOPERATION UNION  
(PCT UNION)

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

Sixteenth Session  
Seoul, March 16 to 18, 2009

REPORT

*adopted by the Meeting*

## INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its sixteenth session in Seoul from March 16 to 18, 2009.
2. The following International Searching and Preliminary Examining Authorities were represented at the session: the Australian Patent Office, the Austrian Patent Office, the Brazilian National Institute of Industrial Property, the Canadian Intellectual Property Office, the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation, the Japan Patent Office, the Korean Intellectual Property Office, the National Board of Patents and Registration of Finland, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.
3. The list of participants is contained in the Annex.

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## OPENING OF THE SESSION

4. Mr. Claus Matthes, Director, PCT International Cooperation Division, World Intellectual Property Organization, on behalf of the Director General, opened the session, welcomed the participants and thanked the Korean Intellectual Property Office for its offer to host the session and for the excellent arrangements it had made.

5. Mr. Koh Jung Sik, Commissioner, Korean Intellectual Property Office, welcomed the participants to the meeting. He emphasized the focus given by his Office to meeting the needs of its customers, and suggested that the same focus was appropriate in considering the operation of the PCT system. The Office was keen to strengthen its participation and cooperation in global IP issues, and attached priority to its activities under the PCT.

6. The session was chaired by Ms. Kim Sanghee of the Korean Intellectual Property Office.

## ADOPTION OF THE AGENDA

7. The Meeting adopted as its agenda the draft contained in document PCT/MIA/16/1 Rev., subject to a change in the order in which certain items would be considered.

## PCT STATISTICS

8. The Secretariat presented statistics illustrating the context in which some of the items on the agenda needed to be viewed. These were taken from the PCT Yearly Review 2008, to be published in April 2009. Notable points included the modest growth of 2.4% in the numbers of international applications filed in 2008, robust growth rates in filings from applicants from Sweden (+12.5%), the Republic of Korea (+12%) and China (+11.9%), a strong growth rate in the activities of the Korean Intellectual Property Office as an International Searching Authority (+92.2%), further improved timeliness in the transmittal of international search reports to the International Bureau, and statistics showing the percentage of the total number of international search reports established by certain International Searching Authorities of applications that entered the national phase at a selection of designated Offices.

## FURTHER DEVELOPMENT OF THE PCT SYSTEM

### The Future of the PCT

9. Discussions were based on document PCT/MIA/16/9, containing a memorandum by the Director General, including a draft roadmap for further work.

10. The Secretariat noted that the broad content of the document had been discussed and strongly welcomed by both heads of Offices and representatives of users and user organizations. It was therefore necessary to attempt to refine the roadmap to create a package which could be accepted by the Contracting States at the PCT Assembly's next session, in September 2009. The most fundamental issues, in the view of the Director General, were not in the legal framework of the PCT but in the manner in which the Offices of Contracting States chose to operate and use the system.

11. The Authorities confirmed their support for the principle of the roadmap and for ensuring that the PCT provided a strong platform for the acquisition of international patent protection, subject to the need to refine the detailed aims and timelines. General comments included the following:

(a) An increase of confidence in the work of other Offices was necessary. Trust could not be built on statements of intent alone. High quality standards must be applied and the International Bureau was urged to act to promote such standards.

(b) Progress was being made on worksharing in other fora, and the PCT system needed to build on this to provide a strong basis for effective use of international reports under the system.

(c) PCT efforts should centre around increasing the quality of the international work products.

(d) The roadmap must lead to measures permitting rapid resolution of rights, confidence in the work of other Offices, reduction of duplication (both internally and externally) and an increase in worksharing. This should lead to effective reduction of backlogs.

(e) The costs of evaluation and development of systems and procedures needed to be kept to a minimum.

(f) The process needed to be accountable to users and the public.

(g) The roadmap should not be pursued to the exclusion of other options. It was necessary to keep alternatives open for applicants so that they could enjoy the benefits of different filing routes, according to their particular needs.

(h) Work on the roadmap should avoid duplication with work being undertaken elsewhere, such as in the context of the "IP5" cooperation (European Patent Office, Japan Patent Office, Korean Intellectual Property Office, State Intellectual Property Office of the People's Republic of China, and United States Patent and Trademark Office).

12. The Secretariat stated that it intended to present an updated version of the memorandum to the PCT Working Group at its next session in May 2009, taking into account the above general comments and the specific comments relating to various sections of Annex I to Appendix I of document PCT/MIA/16/9, as set out below.

*Compliance and Consistency (Annex I, paragraphs 4 and 5)*

13. In the view of the Secretariat, an undertaking by Offices not to repeat searches in the national phase which they had themselves conducted earlier in their role as International Searching Authority would be the most important single step in establishing confidence in the quality of the international search. There were other actions which were required, including developing search tools and quality systems, but if an Office did not trust its own search results, there could never be any reason for other Offices to do so. It would be essential to properly define what was meant by "repeating": there would clearly always be some cases where further search work was required, such as "top-up" searches, cases where inventions had not been the subject of international search, and cases where the scope of the claims had

significantly changed since the conduct of the international search. Furthermore, it was essential that examiners should continue to cite further relevant documents which they knew of. However, all of these possibilities amounted to extending the original search and not deliberately repeating it.

14. All Authorities which spoke agreed with this general aim, though one Authority indicated that it would not be possible for it to make such a commitment within the proposed timetable, which would apply to international applications for which a search was carried out from January 1, 2010.

15. Some Authorities considered that the best way to achieve such a goal would be to encourage parallel processing of national and international phase actions, at least in the case of those Authorities which felt that such an approach would provide benefits. Certain Authorities considered that it might also be appropriate to delay the time by which the international search was required to be completed in order to address the limitation of current international searches which could not find “secret prior art”. The Secretariat observed that parallel processing would represent a significantly different way of addressing the same aim, and that it might be seen as suggesting that there were deficiencies in the current international procedure which could not be effectively remedied directly.

16. It was generally agreed that a reduction in the number of reservations in force in relation to certain provisions of the PCT Regulations was desirable, given the complications and difficulties in processing which they caused. Nevertheless, it was important to recognize that there were different kinds of, and reasons for, such reservations. Most notably, some had substantive effects. There was a clear right, for example, for Contracting States to maintain reservations under Article 64 for as long as they were felt to be appropriate. Furthermore, it was difficult to make promises in relation to timing of the removal of reservations, given the processes involved in changing national laws. One Authority noted that it would soon be in a position to withdraw two of its present reservations as a result of ratification of the Patent Law Treaty, and it hoped that other Offices would be in a similar position soon.

*Making International Examination More Complete, Relevant and Useful (Annex I, paragraphs 6 and 7)*

17. There was general agreement that there were benefits to be achieved through improvements in international examination, subject to the need to ensure that the international search was of a sufficient quality to give a strong foundation and to concerns that the benefits of additional processing needed to be commensurate with the work involved and not to undo the benefits of the reforms achieved in 2004, which ensured that a written opinion was delivered in all cases without the need for Chapter II processing. The benefits could encompass both higher quality reports and entry of applications into the national phase in a state closer to being ready for grant of a patent.

18. One Authority pointed to the Patent Prosecution Highway as demonstrating the benefits of achieving positive reports in one Office before beginning examination in another Office, but noted that requests for accelerated processing under this system made to date with its Office represented only 1.5% of total common applications between the two participating Offices, one of the most used implementations. It was thus necessary to look at how these benefits could be applied to applications filed via the PCT. It was necessary to ensure that there was a proper tradeoff between accelerated processing and not attempting to re-expand

the scope of claims in processing before the second Office (that is, the national phase, in the context of PCT). Designated Offices needed to look at the incentives which they offered applicants to behave in ways which would enable efficient national processing.

19. It was generally considered that there should be adequate opportunity for dialog in Chapter II proceedings. Several Authorities indicated that it should be required that an applicant properly respond to the written opinion of the International Searching Authority if the International Preliminary Examining Authority was to offer a further written opinion before establishing an international preliminary examination report. Some Authorities noted that, at present, they would establish a written opinion whether the applicant had responded to the opinion of the International Searching Authority or not. It was suggested that it might be useful if international preliminary examination could be conducted on the basis of supplementary international searches in addition to the main international search.

20. There was general support for the idea of top-up searches as part of Chapter II, subject to concern that this might lead to an increase in fees.

21. Some Authorities believed that the objective of top-up searches might be most effectively addressed by delaying the international search until after international publication, subject to offering applicants the opportunity to retain the current timing where an early search was considered important (noting, for example, that international publication offered provisional rights, which had a stronger effect when accompanied by a search report showing that rights were likely to be valid). Delaying the international search would offer the following benefits<sup>1</sup>:

(a) A complete search could be provided in the first instance, including secret prior art, allowing the applicant to respond to all prior art at the same time.

(b) Authorities would not need to conduct top-up searches at a later stage, saving time and examiner resources.

(c) Any information which was submitted by third parties could be reflected in the international search report.

22. Other Authorities expressed concern that such a delay would be detrimental to the interests of third parties, who wished to see international search reports as part of the international publication, as well as risking final reports not being established before the end of the international phase. One Authority commented that searches would need to be conducted at least 24 months from the priority date in order to be confident that most of the relevant secret prior art had been published and made available in the search databases. A delay in the main international search would also present problems for the conduct of supplementary international searches.

23. There was strong interest in the concept of permitting third party observations in the international phase, subject to the need to devise appropriate mechanisms to encourage observations which would be as clear and relevant as possible (including references to specific claims) and not excessive in number. It was noted that the use of current third party

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<sup>1</sup> See the non-paper made available at the session by the Japan Patent Office and posted on the WIPO website at [www.wipo.int/meetings/en/details.jsp?meeting\\_code=pct/mia/16](http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/16).

observation systems varied greatly between different States. One Authority pointed out that its national system provided for a fee and a maximum of 10 citations in order to deter abuses. It would also be necessary to consider how to make observations as effective as possible without introducing a requirement for translation of observations.

24. Several Authorities indicated that all of these potential measures should be evaluated carefully to ensure that they did not lead to an extension of the international phase. On the other hand, another Authority suggested that an extension to the international phase might be desirable as part of an appropriate package. Such an extension could permit additional processing but should apply to all cases to avoid returning to the situation where applicants demanded international preliminary examination merely to “buy time” before having to enter the national phase. Alternatively, or additionally, such an extension might be considered in combination with means for collaboration between Authorities, as further considered in paragraph 29, below.

25. One Authority stated that it considered that there was some scope for flexibility in time limits for the international search, having had feedback from applicants such that, in one questionnaire, it had found that around 85% of applicants would be satisfied by receiving international search reports around 20 months from the priority date. The key matter for many users was that the international search report be delivered well in advance of the time limit for entering the national phase. However, it considered that this time limit was not infinitely extendable and it was important to consider the public interest.

*Eliminating Unnecessary Processing (Annex I, paragraphs 8 and 9)*

26. In relation to the example aim of introducing defensive publication, most Authorities considered that there was little benefit to be gained. It was not clear why defensive publication of international applications would be more desirable than cheaper options, including national publication. It was suggested that this might be due to ensuring that the disclosure had relevance with effect from the priority date, rather than merely the publication date, in some PCT Contracting States.

27. One Authority, however, noted that the proposal could be useful if it could actually be shown to eliminate the need to conduct unnecessary international searching on a significant number of international applications.

28. In relation to the desire to reduce the impact of parallel processing, it was suggested that the aims should be more generic, rather than instructing Authorities specifically to address the issue by allocating national and international work to the same examiner.

*Collaborative International Search and Preliminary Examination (Annex I, paragraphs 10 and 11)*

29. A number of Authorities expressed support for investigations into a possible way forward, including possible trials of collaborative approaches, which fostered mutual trust between Offices and achieved benefits from differing perspectives and having regard to different languages skills. It was emphasized that such trials needed to recognize the limited resources available. It would be necessary to carefully consider how to work efficiently. Communication systems would be a significant factor. Some experience from other projects, including the Patent Prosecution Highway and supplementary international search, could be relevant. It was emphasized that such trials should not distract Authorities from the need to

improve the quality of the conventional international search carried out by a single Authority. One Authority considered that it would be preferable not to specify a deadline which would prejudice the analysis of costs, benefits and difficulties of such an approach. A further Authority indicated that it did not regard this item as a priority in view of the numerous other goals and questioned the achievability of this aim within the proposed timeline.

*Fees and Other National Measures (Annex I, paragraphs 12 to 14)*

30. It was observed that the arrangements for fees and processing within the national phase were matters for individual Offices. Nevertheless, such arrangements could have a significant effect on the way in which applicants used the international patent system as a whole. There needed to be incentives provided to persuade applicants to use the system efficiently from the point of view of Offices.

31. One Authority noted that, while it might be the case that international fees formed only a small part of the total cost of seeking international patent protection, they were still a significant barrier. It appreciated the suggestion alluded to in paragraph 6 of Appendix II of document PCT/MIA/16/9 that reductions might be offered for applicants seeking protection in only a small number of States, but was concerned that this might jeopardize the benefit of the universal designation system. It might be better to offer a fee reduction to all applicants. Another Authority considered that such reductions might make the PCT more relevant to the market currently addressed by the Patent Prosecution Highway. Alternatively, reductions for small and medium-sized entities might be considered, though it was recognized that there would be a number of other problems associated with such a proposal.

PCT Reform

32. Discussions were based on document PCT/MIA/16/11, containing several proposals by the European Patent Office.

*Informal Clarification Before Search*

33. The European Patent Office, in introducing its proposal to make wider use of paragraphs 9.34 and 9.35 of the PCT International Search and Preliminary Examination Guidelines, enabling International Searching Authorities to seek clarification from the applicant of the subject matter to be searched, stated that it believed that the increased use of such an informal clarification procedure by Authorities would contribute to raising the quality and the efficiency of search work, to the benefit of applicants, the general public and designated Offices. It stated that it might be beneficial to consider creating common Forms for the purpose.

34. The Meeting expressed its general support for the principle of requesting informal clarifications, subject to the comments and suggestions appearing in the following paragraphs.

35. All Authorities which took the floor on the matter generally welcomed the proposal, provided that it remained an optional and informal procedure which, if used, left the Authority with flexibility as to how to communicate with the applicant and as to the time limits to be set for the applicant to respond, and did not result in delay in the establishment of the international search report. One Authority referred to the satisfactory experience it had had with regard to an existing similar procedure applied by it in its capacity as a national Office.

36. Several Authorities pointed to the need for Authorities to proceed cautiously so as to avoid the introduction by applicants of new matter into their applications. One Authority requested further clarification of the statement contained in paragraph 6 of the document that “later in substantive examination, unsearched subject matter will need to be excised from the application and cannot be used as basis for amendments, as is the case of non-unity”, and wondered whether that statement referred to the practice of the European Patent Office under the European Patent Convention or under the PCT.

*Compulsory Reply to the International Preliminary Report on Patentability*

37. The European Patent Office, in introducing its proposal, stated that its intention was to encourage other Offices to consider introducing a change in their national laws similar to the one which was to be proposed to be introduced into the Regulations under the European Patent convention, according to which an applicant would be required to submit, upon national phase entry, a substantive reply to an international preliminary report on patentability established by the European Patent Office as an International Authority, which would accelerate proceedings, bring efficiency gains for the Office and, most notably, give international preliminary examination reports an increased standing before other designated Offices.

38. One Authority expressed its support for the proposal, noting that it remained, of course, a matter for each national law to decide what consequence should apply where the applicant did not submit the required substantive reply. Another Authority, while generally supporting the proposal, noted that it rarely received national phase entries of international applications in respect of which it had itself established an international preliminary report on patentability.

*Identification of Amendments*

39. The European Patent Office, in introducing its proposal for an amendment of Rule 66.8(a), stated that it viewed its proposal as being of major importance to examiners and the overall efficiency of the examination process, while at the same time resulting in only a minor burden on applicants.

40. All Authorities which took the floor on the matter supported the proposal. The European Patent Office stated that it intended to present a detailed proposal for amendment of Rule 66.8(a) to the next session of the PCT Working Group, in May 2009.

*Filing of Third Party Observations*

41. The European Patent Office indicated that it strongly favored allowing third party observations to be submitted in the international phase, and in this context referred to its comments made during the discussions relating to document PCT/MIA/16/9 (see paragraph 23, above).



Enhancing the Value of International Search and Preliminary Examination Under the PCT:  
Making International Preliminary Examination More Useful

42. Discussions were based on document PCT/MIA/16/3.

43. The Meeting expressed its general support for the proposed ways in which international preliminary examination might be made more useful as set out in paragraphs 6 to 20 of document PCT/MIA/16/3, subject to the comments and suggestions appearing in the following paragraphs.

44. One Authority suggested that the focus on citation of relevant documents (see paragraph 11 of document PCT/MIA/16/3) should be restricted to documents relevant to the question of novelty and should not encompass citations relevant to the question of inventive step.

45. Several Authorities, commenting on the proposed possible modification of the PCT International Search and Preliminary Examination Guidelines set out in paragraph 12 of document PCT/MIA/16/3, stated that objections, especially those relating to inventive step, should in general be maintained in the case of doubt, but raised concerns with regard to the statement that objections “in fields where it is known that there are significant differences in national laws, should be maintained in a final report in the event of doubt, even if the examiner would drop them in a national report”. It was noted in this connection that such an approach would potentially require detailed knowledge by the examiner of the national laws of all Contracting States, that the examiner would in some cases raise objections in the international report that would later be dropped by the same Office in the national phase, and that there were differences in practice within the same Office acting as both the International Authority and a designated Office in respect of the same international application, which would result in the need for applicants to amend the international application upon national phase entry before that Office. Such factors would not help in building wider trust in international reports if the suggested approach were to be implemented.

46. One Authority, commenting on the issue of the significance of secret prior art to be explained in written opinions and reports set out in paragraph 13 of document PCT/MIA/16/3, noted that any such explanations would be likely to be of small benefit to applicants in view of different definitions as to what constituted prior art under the various applicable national laws of Contracting States.

47. One Authority, commenting on the proposal that the questions of clarity and support should be commented on in written opinions and international preliminary examination reports (see paragraph 14 of document PCT/MIA/16/3), suggested that, in view of the vastly different practices of Offices on those issues, a thorough analysis should first be carried out on how to overcome those differences in practice before encouraging Authorities, or before making it mandatory for Authorities, to comment on those issues.

48. One Authority expressed its general concern about the fact that certain of the proposals set out in document PCT/MIA/16/3 would in fact constitute a reversal of some of the positive effects which had been achieved when Member States had agreed, as part of PCT reform, to modify the legal framework to streamline Chapter I and Chapter II procedures. It furthermore stated that, in its view, it was not necessary for an International Preliminary Examining Authority to comment on possible formality defects in international applications, as proposed in paragraph 14 of document PCT/MIA/16/3, as this matter properly lay within the domain of receiving Offices.

49. One Authority stated that, while it generally supported the proposal, set out in paragraph 16 of document PCT/MIA/16/3, to provide at least one written opinion by the International Preliminary Examining Authority during the Chapter II procedure before a negative final report is established, in addition to that which had previously been drawn up by the International Searching Authority, and while it was considering changing its current practice to provide for such a written opinion in all cases, it considered it to be sufficient if such a practice were implemented by Authorities on a voluntary basis without being obliged to do so. That Authority further stated that it did not support the proposal, set out in paragraph 16 of document PCT/MIA/16/3, to enable applicants to request additional searching following amendment at the time of filing the demand to overcome defects which had prevented a full search from being carried out, noting that such an additional search would only contribute to the overall complexity of the system.

#### Content and Format of International Search and Preliminary Examination Reports

50. Discussions were based on document PCT/MIA/16/4.

51. The Meeting expressed its general support for the proposed way forward as set out in paragraph 22 of document PCT/MIA/16/3, subject to the comments and suggestions appearing in the following paragraphs.

52. While all Authorities which took the floor on the matter generally agreed with the general approach of moving to a linear format for international search and preliminary examination reports, noting the clear advantages of that format as described in document PCT/MIA/16/4, several Authorities, referring to limited availability of resources, stated that they would not be in a position to implement such a new format in the short to medium term and that thus there was a need to maintain the present “box” format, in parallel with the new linear format, for the foreseeable future.

53. One Authority stated that it fully supported the move to the linear format, while keeping the box format for those Offices which had a continued need for that format and offered its assistance to the International Bureau to develop the necessary style sheets for XML search and examination reports.

54. One Authority suggested a number of factors that should be borne in mind in the development of a new linear format: (i) standard text should be clearly distinguished from non-standard text; (ii) the citation of references should be placed on a separate page or document so that they could be easily processed by machine, by both the Authority concerned as well as designated Offices, and identified by other examiners in search exchange projects; (iii) paragraph numbers should be assigned to the standard text paragraphs and, when printed, appear in parenthesis on the report so that the reader who did not understand the language of the report could compare the report with a list of paragraphs in his language; (iv) the current

standard texts should be retained as far as possible; (v) the forms should be clearly identified as PCT forms; and (vi) text portions relating to a given section of the report should always be numbered the same, even if this caused breaks in the numbering sequence.

55. In response to a query by one Authority as to whether it would be desirable and possible to develop a common system for producing the reports in the linear format for use by all Offices, the Secretariat indicated that it had some doubts as to the feasibility of such a system, noting the number of different existing IT systems such a system would have to fit in with and the desire of Authorities to maintain their own integrated systems within their Offices.

## QUALITY FRAMEWORK

### Proposal for Revision of the PCT International Search and Preliminary Examination Guidelines

56. Discussions were based on document PCT/MIA/16/2, containing a proposal by the European Patent Office.

57. The Meeting expressed its full support for the proposed draft revised text of Chapter 21 of the PCT International Search and Preliminary Examination Guidelines as set out in the Annex to document PCT/MIA/16/2, subject to the comments and suggestions appearing in the following paragraphs.

58. The Meeting noted that, in accordance with present paragraph 21.19 of the Guidelines, the proposed changes to Chapter 21 would need to be the subject of wider consultation with interested parties.

59. One Authority suggested that it might be useful for Authorities to exchange existing quality manuals and other documentation. Certain Authorities which had already established quality manuals indicated their willingness to share them with other Authorities.

### Complementary Proposal

60. Discussions were based on document PCT/MIA/16/5, containing two proposals made by the Swedish Patent and Registration Office, the first for an electronically based feedback system and the second for a quality subgroup under the Meeting.

### *E-based Feedback System*

61. Several Authorities expressed general support for the proposal for enhanced communications arrangements for allowing feedback to be given to Authorities on international search and preliminary examination reports, subject to availability of resources and ensuring that the requirements were properly identified. It was made clear that use of the system would need to be optional, both for Authorities and for designated Offices.

62. It was noted that such a system would offer two distinct features, the first being to provide feedback to Authorities in connection with the processing of particular applications, and the second to enable Authorities to derive information of a more systematic nature for use in improving their quality systems. It would be necessary to ensure that the available information was structured and could be accessed in such a manner that quality managers would be able to extract information which could be analyzed effectively. It was observed that the input arrangements might be closely related to those established for a third party observation system, and it might be most efficient to consider the two issues together.

63. The Meeting agreed that the Secretariat should, in consultation with the Swedish Patent and Registration Office, develop more detailed proposed system requirements with a view to establishing an e-based feedback system, for consideration by the Meeting at its next session.

### *Quality Subgroup*

64. Certain Authorities expressed support for the proposal for the establishment of a quality subgroup, while others expressed reservations as to the need for a further body, noting the resources that might be involved, especially if it were envisaged that the body would meet physically. It was noted that some quality issues, including the formulation of the Meeting's annual report to the Assembly on quality matters, would benefit from more detailed consideration by quality experts before they were put to the Meeting as a whole. One Authority emphasized that, if such a subgroup were to be established, it should focus on specific issues with the aim of arriving at useful and concrete outcomes. The Swedish Patent and Registration Office explained that it envisaged that the proposed subgroup would operate using electronic communication means.

65. The Meeting agreed that the Secretariat should, in consultation with the Swedish Patent and Registration Office, establish a suitable electronic forum whereby experts from interested Authorities could undertake discussions of quality-related matters. Progress on the establishment and operation of the forum should be reported to the Meeting at its next session.

### Reports and Further Work

66. Discussions were based on document PCT/MIA/16/5, containing a memorandum prepared by the International Bureau, and on reports on quality systems covering 2008 that had been prepared by individual Authorities and made available to other Authorities via the PCT/MIA electronic forum.

67. One Authority raised several questions in connection with those reports, including: (i) the reasons why certain Authorities had reported that there had been no change in their quality systems since their previous reports; (ii) suitable parameters for discussing product standards; (iii) the objectivity of self-check systems whereby certain Authorities' examiners assessed the quality of their own performance; (iv) the relationship between improvements in quality systems and work output levels; and (v) the ways in which Authorities dealt with negative feedback received from users and other Offices.

68. One Authority commented that the reasons for its report to the effect that there had been no change in its quality systems during the reporting period were partly based on resource and time constraints but also on its belief that its quality systems were working satisfactorily.

69. Two Authorities noted that the matters mentioned in paragraph 67, above, would benefit from discussion by quality experts in a forum of the kind mentioned in paragraphs 64 and 65, above, in order to better prepare the matters for discussion by the Meeting as a whole.

70. The Meeting discussed how best to proceed with the preparation of annual reports by the Meeting to the PCT Assembly on quality activities of the various Authorities. It would be desirable for such annual reports to deal with substantive matters and to provide a basis for future improvements to be made.

71. The European Patent Office, after consultation with the other Authorities which formed a partnership in the context of the European patent system, suggested that that partnership could discuss the matter with a view to putting proposals to the Meeting in late 2009 as to how the Meeting could deal in 2010 with reports by Authorities covering the 2009 reporting period. The partnership would be prepared to coordinate activities of the subgroup mentioned in paragraphs 64 and 65, above, with a view to the preparation of a more useful report to the Assembly in 2010. This would imply that individual Authorities' reports would be needed at least two months before the Meeting's session in 2010.

72. The European Patent Office also offered to act as lead Office in developing revised templates which could be used by Authorities in preparing their reports.

73. The European Patent Office emphasized that input from other Authorities in the course of the work just described would be very welcome.

74. The Meeting agreed to accept the proposals by the European Patent Office as to the preparation of quality reports in future years, as outlined in paragraphs 71 to 73, above. The annual report to be submitted to the Assembly in 2009 covering the 2008 reporting period would be established, as in recent years, on the basis of a draft to be prepared by the International Bureau subject to consultation with all Authorities via the PCT/MIA electronic forum.

#### ESTABLISHMENT OF EQUIVALENT AMOUNTS OF CERTAIN FEES

75. Discussions were based on document PCT/MIA/16/6.

76. The Meeting expressed its general support for improving the legal framework governing the establishment of equivalent amounts of certain fees set out in document PCT/MIA/16/6, subject to the comments and suggestions appearing in the following paragraphs.

77. Several Authorities indicated that, due to the late receipt of the document, they had not had sufficient time to consider the proposals in detail and thus wished to reserve their position until the discussion of the matter at the next session of the PCT Working Group, in May 2009.

78. One Authority suggested that, in view of the proposal to move large parts of the provisions currently set out in the Regulations to the directives given by the Assembly, it would be desirable to make those directives more easily accessible to Offices and the general public, notably on WIPO's website. Upon a query by the Authority as to the meaning of the term "promptly" in the Regulations as proposed to be amended ("the ... fee shall promptly be transferred by ... to ..."), the Secretariat stated that that term was widely used throughout the Regulations to express an obligation to carry out a certain action without delay in a timely manner.

79. One Authority welcomed in particular the proposals designed to add more flexibility to the procedures governing the establishment of equivalent amounts in case of changes in the exchange rates of currencies ("4 consecutive Fridays", yearly review cycle), noting that they would allow the International Bureau, Offices and Authorities to react to changes in exchange rates in a more timely and accurate manner.

80. One Authority expressed its concern as to the proposed amendment of Article 11(3) of the agreements between the International Bureau and Authorities, according to which any change in the amount or currency of fees or charges set by an Authority could not enter into force earlier than at least two months later than the date on which the notification was received by the International Bureau, noting that national legislation often required an Authority to have an earlier entry into force date of provisions dealing with fees, and suggested that the proposal be revised to provide more flexibility to Authorities in this respect.

#### MINIMUM DOCUMENTATION

81. Discussions were based on document PCT/MIA/16/14, containing proposals by the European Patent Office.

82. Several Authorities expressed appreciation of the progress which had been made following the renewed efforts led by the European Patent Office, but considered that the proposals were still not ready for implementation. Some of the concerns included the following:

(a) A restriction to documents in the English language, or for which English abstracts were available, was too limiting. The purpose of the minimum documentation was to ensure an appropriate standard of quality and this necessarily involved searching documents in languages other than English. It needed to be noted that machine translation was making a wide range of documents more readily accessible in a variety of languages.

(b) The criteria were only formal ones and not sufficient to completely define what documentation should be added to the list. It was considered necessary to have a definition of how to evaluate whether a source of documentation was sufficiently useful.

(c) It was not clear that the criteria, particularly for patent literature, properly covered the features necessary to ensure that document sets could be added effectively to Offices' search databases.

(d) It was agreed that, so far as possible, Authorities should not be tied to the use of specific vendors for accessing the documentation. Nevertheless, it would be useful to maintain lists (probably not exhaustive) of vendors who gave access to specific items in order to assist gaining access and seeking the lowest cost and most efficient sources.

(e) It was not clear whether copyright conditions were practical or appropriate, nor the extent to which the proposed condition applied to the existing non-patent literature.

(f) It might not be essential that patent abstracts be available free of charge; it might rather be sufficient that they be generally available from a convenient source.

(g) The definition of “primary literature” needed to be considered carefully. It might be appropriate to use what might be considered secondary sources in some cases where real added value was offered.

83. It was observed that the minimum documentation was important to many Offices, not only the International Authorities, and that the final proposals should be the subject of broad consultation. However, in view of the lack of consensus, further discussion between the Authorities was required before the consultations were broadened. It was also observed that PCT Rule 34 was one of those Rules for which Rule 88 set out special conditions to be met for amendment.

84. The Meeting agreed to request the minimum documentation task force to give further consideration to the proposals, taking into account the matters outlined in paragraph 82, above.

#### SUPPLEMENTARY INTERNATIONAL SEARCHES: LIMITATIONS UNDER RULE 45*bis*.9

85. Discussions were based on document PCT/MIA/16/8.

86. The Meeting agreed that an International Searching Authority offering the service of supplementary international searches should, as a matter of principle, be allowed to adopt a limitation as to the extent of particular supplementary searches to be carried out by it, rather than only a limitation as to its general competence to carry out supplementary searches. The Meeting requested the Secretariat to consider appropriate measures to clarify the issue, including a possible amendment of the Regulations, taking into account the comments and suggestions appearing in the following paragraphs.

87. One Authority stated that, while it agreed with the Secretariat on the more strict interpretation of Rule 45*bis*.9 as set out in document PCT/MIA/16/8, it had no objection to clarifying the issue by way of an appropriate amendment to the Regulations.

88. One Authority expressed the view that Rule 45*bis*.5(g), which provided for a supplementary search request to be considered not to have been submitted where the Authority concerned had found that carrying out the search was excluded by a limitation or condition specified in the applicable agreement between the International Bureau and the Authority, should be interpreted as applying only to the case where the Authority was not competent at all to carry out such search and not to the case where the Authority had made a

limitation only as to the extent of a supplementary search. The Secretariat expressed some doubts as to such interpretation and stated that it might be preferable to put the matter beyond doubt by amending both Rule 45*bis*.5(g) and 45*bis*.9.

89. One Authority expressed the view that it was important that Authorities continue to have complete freedom to make limitations as to the subject matter for which they were willing to carry out supplementary international searches so that, as at present, they would be able to exclude certain kinds of subject matter, such as business methods.

#### PCT RECEIVING OFFICE GUIDELINES: MISSING PARTS IN THE INTERNATIONAL APPLICATION

90. Discussions were based on document PCT/MIA/16/10, containing several proposals by the European Patent Office.

91. While there was general support among Authorities for the proposal to further modify proposed new paragraph 205E of the Receiving Office Guidelines as set out in paragraph 6 of document PCT/MIA/16/10, it was generally felt that, at this stage, it might be premature to provide, in the Receiving Office Guidelines, for detailed procedures concerning the incorporation by reference of missing elements or parts in international applications. Due to the fact that the remedy of incorporation by reference had only recently been added to the Regulations, Offices were still in the process of developing practices and gaining experience as to how best to implement provisions set out in the Regulations. It was thus felt that, at this stage, it might be preferable to leave the Guidelines as flexible as possible so as to accommodate the various different practices among Offices until a “best practice” emerged and could be agreed upon.

92. There was no support for the proposal to further modify proposed new paragraph 205F of the Receiving Office Guidelines as set out in paragraphs 8 and 9 of document PCT/MIA/16/10. Two Authorities stated that, while they had some sympathy for the proposal, they felt that a more strict interpretation of the provisions governing the incorporation by reference of missing elements or parts would be appropriate. While missing elements or parts could be added to the application by way of incorporation by reference, that remedy did not allow for the deletion of elements or parts which were contained in the international application as filed, even if incorporation by reference resulted in, for example, two set of claims being contained in the application. Consequently, all parts of such application had to be searched by the International Searching Authority, unless there was a case of lack of unity of invention or inability to carry out a meaningful search.

93. The Meeting invited the Secretariat to take the views expressed in paragraphs 91 and 92, above, into account in the context of the consultation procedure on the proposed modifications of the Receiving Office Guidelines as set out in Circular C. PCT 1157. Should the outcome of that consultation procedure be such that it was decided to include detailed provisions in the Guidelines on the issues covered by paragraphs 205E and 205F, the Meeting suggested that a further round of consultations be held with all receiving Offices. With regard to the issue covered by paragraph 205E, the Meeting suggested that, in such a case, consultations should be undertaken on the text as proposed to be further amended as set out in paragraph 6 of document PCT/MIA/16/10.



## PRESENTATION OF REVISIONS TO INTERNATIONAL APPLICATIONS

94. Discussions were based on document PCT/MIA/16/13.

95. The Secretariat recalled that an increasing proportion of international applications were being filed in XML format. Certain Offices wished, to the greatest extent possible, that international phase processing be carried out directly in XML format (such as submitting replacement paragraphs) and, as designated Offices, to receive the results in XML format. If this was to be done effectively, it was essential that the communications meet the information and processing needs of designated Offices. One major issue might be that the XML standards in *application-body.dtd* at present did not specifically allow for any information to be included to distinguish between original and new or revised paragraphs, figures, etc.

96. Authorities were not yet in a position to state firm positions on the issues set out in the paper. Initial views included the following:

(a) It was essential that an examiner viewing the application (either as XML or as a rendered view based on the XML) be able to identify individual paragraphs and drawings which had been changed in any way since the international filing date.

(b) It was desirable that this information should be clear when viewing the paragraph itself, but it might be acceptable as an alternative to provide a list of changes at the start or end of the specification, so long as this was in a clear format and was clearly distinguished from the application body.

(c) It was at least desirable, and possibly essential, to include information concerning the date and nature of the change, in addition to the simple fact that a change had occurred. This information should preferably be provided in a clear, consistent and language-independent manner.

(d) It was not clear whether there would be technical or legal issues if text indicating showing the details of a change were added to the text of a paragraph itself, as distinct from being included as an attribute of the paragraph or as a separate list.

(e) If information on changes were included as a separate file, concerns over this information being separated from the application body might be overcome by providing the various files as a package.

(f) There might be significant resource issues in allowing for national phase receipt of such XML information, quite apart from systems for creating the new application bodies in the international phase. Discussion of the business requirements should not be restricted to consideration of specific solutions set out in the discussion paper.

97. The Meeting agreed that the Secretariat should send a consultation circular to designated Offices and International Authorities outlining the above and related issues in order to ensure that the business requirements for presenting XML application bodies, and views rendered from such application bodies, be properly identified.

## PROPOSAL FOR PARAGRAPH AMENDMENT OF PCT APPLICATIONS

98. Discussions were based on document PCT/MIA/16/14, containing proposals by the Japan Patent Office.

99. The Japan Patent Office recalled that XML-based applications did not have well-defined page breaks and it was consequently difficult for applicants who had prepared their applications in this way to submit replacement sheets. Moreover, the Office wished to ensure that such international applications were fully processed in XML format. Consequently, it was important to provide a proper basis in the PCT for paragraph replacement. It was emphasized that the page-based replacement system would remain available for use with applications and in Offices where such an approach was more appropriate.

100. Authorities recognized the need for a paragraph replacement system, but were not yet in a position to agree on the required details. In particular, one Authority was concerned by a number of details relating to the numbering system and arrangements for how changes other than one-to-one replacements should be made, as follows, and would consequently be very reluctant to accept the proposal as a basis for an international system:

(a) This proposal appeared to have had moved away from an earlier position whereby the Japan Patent Office had indicated that it was abandoning its objection to “branch” paragraph numbering. Branch numbering was used for insertions in that Authority’s domestic processing systems and could not accommodate renumbering until the application was ready for grant.

(b) The proposal did not accommodate numbering of sentence fragments, which was important to that Authority because of limitations of its search systems.

(c) In the case of changes other than one-to-one replacement, the proposal required the complete specification to be resubmitted, which would be inefficient in the case of large applications; automated processing would be easier if working only with the paragraphs which were affected.

(d) The proposal would rely on an applicant’s description of changes to inform the examiner where to look for changes, whereas it would be more efficient to have the machine indicate the relevant portions of the document. Branch numbering would assist in automated amendment processing and highlighting of the changes to the examiner.

(e) The proposal would often require processing the entire document in order to display changes, which might not be the case with alternative approaches.

(f) The proposal would not be compatible with that Authority’s existing automation environment.

101. The Meeting agreed that the Secretariat should send a consultation circular to Offices outlining these and related issues, if possible either combined with or at the same time as the consultation referred to in paragraph 97, above, seeking agreement on the matters necessary for the establishment of a PCT paragraph replacement system meeting the needs of Offices in both the international and national phases.

## FUTURE WORK

102. The Meeting agreed that, should the PCT Assembly at its September 2009 session adopt a roadmap for the further development of the PCT (see paragraphs 9 to 31, above), a further session of the Meeting should be convened towards the end of 2009 so as to commence discussions on a draft package of appropriate measures designed to implement that roadmap. The Meeting noted with gratitude the offer of the Brazilian National Institute of Industrial Property to host that session in Brazil, should it be convened.

[Annex follows]

ANNEX

LIST OF PARTICIPANTS

I. INTERNATIONAL AUTHORITIES

(in the English alphabetical order of their names)

AUSTRALIAN PATENT OFFICE

Bob BARTRAM, Assistant General Manager, Patent and Plant Breeder Rights

AUSTRIAN PATENT OFFICE

Peter HOFBAUER, Head, PCT Department

BRAZILIAN NATIONAL INSTITUTE OF INDUSTRIAL PROPERTY

Luiz Otávio BEAKLINI, Senior Adviser of the Presidency for Quality Systems Affairs

Catia Regina PINHO GENTIL DA SILVA (Mrs.), Technical Coordinator of Patents II

CANADIAN INTELLECTUAL PROPERTY OFFICE

J. Scott VASUDEV, Chief, Patent Policy, Classification and International Affairs Division,  
Patent Branch

Nicholas OHAN, Section Head, Biotechnology Division, Patent Branch

EUROPEAN PATENT OFFICE

Robert CRAMER, Director, Directorate 5.2.5, International and Legal PCT Affairs

Colin PHILPOTT, Principal Director, Principal Directorate 2.02, Quality Management

Hubert PLUGGE, Director, Directorate 2.0.22, Quality Management Support

Mark WEAVER, Director, Directorate 2.0.21, Practice and Procedure

Alfred SPIGARELLI, Director, DG1 Business Services

FEDERAL SERVICE FOR INTELLECTUAL PROPERTY OF THE  
RUSSIAN FEDERATION (ROSPATENT)

Andrey ZHURAVLEV, Deputy Director, Federal Institute of Industrial Property

Tatiana VLADIMIROVA (Mrs.), Acting Head of Division, Federal Institute of Industrial Property

Valeria MAKSIMOVA (Mrs.), Deputy Head of Division, Federal Institute of Industrial Property

JAPAN PATENT OFFICE

Takuya TANABU, Deputy Director, Examination Standards Office

Hiroshi KAWAMATA, Deputy Director, PCT Task Force, International Affairs Division

KOREAN INTELLECTUAL PROPERTY OFFICE

KWON Jongnam, Senior Director, Patent Examination Support Division

CHOI Insun, Senior Deputy Director, International Organization Division

KIM Sanghee (Ms.), Senior Deputy Director, Mechanics, Metal and Construction Examination Division

KIM Byeongpil, Deputy Director, Patent Examination Support Division

HAN Deokwon, Deputy Director, Patent Examination Support Division

HAN Sanggyoo, Deputy Director, International Application Division

NATIONAL BOARD OF PATENTS AND REGISTRATION OF FINLAND

Juha REKOLA, Development Director

Riitta LARJA (Mrs.), Coordinator, International and Legal Affairs

NORDIC PATENT INSTITUTE

Niels RAVN, Director

SPANISH PATENT AND TRADEMARK OFFICE

Javier VERA ROA, Head, Applied Mechanical Patents Division, Patents and Technological Information Department

Isabel SERIÑÁ RAMÍREZ (Ms.), Technical Advisor, Department of Patents and Technological Information

STATE INTELLECTUAL PROPERTY OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

YANG Kefei (Ms.), Director, Examination Guideline Division, Patent Administration Department

GAO Fei (Ms.), Official, Preliminary Examination and Flow Management Department

SWEDISH PATENT AND REGISTRATION OFFICE

Marie ERIKSSON (Ms.), Head of Legal Affairs, Patent Department

Kerstin BRINKMAN (Ms.), Director, Patent Department

Måns MARKLUND, Quality Manager, Patent Department

UNITED STATES PATENT AND TRADEMARK OFFICE

Charles A. PEARSON, Director, PCT Legal Administration

Karin L. FERRITER (Ms.), Patent Attorney, Office of IP Policy and Enforcement

II. OFFICERS

Chair: KIM Sanghee (Ms.) (Korean Intellectual Property Office)

Secretary: Michael RICHARDSON (WIPO)

III. SECRETARIAT  
OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Philip THOMAS, Senior Director-Advisor (PCT and Patents)

Claus MATTHES, Director, PCT International Cooperation Division

Michael RICHARDSON, Head, Institutional Relations Section, PCT International  
Cooperation Division

[End of Annex and of document]