

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

**Nineteenth Session  
Canberra, February 8 to 10, 2012**

### **SUMMARY**

*prepared by the Chair*

### **INTRODUCTION**

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its nineteenth session in Canberra from February 8 to 10, 2012.
2. The following International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Brazilian National Institute of Industrial Property, the Canadian Intellectual Property Office, the Egyptian Patent Office, the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation, IP Australia, the Israel Patent Office, 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.

### **ITEM 1: OPENING OF THE SESSION**

3. Ruth Bell, elder of the Ngunnawal people, offered a traditional welcome to country to the participants.
4. Fatima Beattie, Deputy Director General of IP Australia welcomed the participants and chaired the session, except for items 10 to 12, which were chaired by Greg Powell, Supervising Examiner, IP Australia. James Pooley, Deputy Director General of the World Intellectual Property Organization welcomed participants on behalf of the Director General.

## **ITEM 2: ADOPTION OF THE AGENDA**

5. The Meeting adopted the agenda as set out in document PCT/MIA/19/1 Rev., subject to:
- (a) the addition of document PCT/MIA/19/7 Add. under item 7 and document PCT/MIA/19/8 Add. under item 8;
  - (b) deciding that the Chair should present a summary of the session under item 13 and that the report would be adopted by correspondence.

## **ITEM 3: PCT STATISTICS**

6. The Meeting noted a presentation by the International Bureau on the most recent PCT statistics<sup>1</sup>.

## **ITEM 4: QUALITY**

### **(a) Report from the Quality Subgroup**

7. The Meeting:
- (a) noted with approval the Summary by the Chair of the Meeting's Quality Subgroup set out in the Annex to this document;
  - (b) approved the continuation of the Subgroup's mandate, highlighting the particular importance of the quality-related work set out in paragraphs 7 to 20, below;
  - (c) agreed that the annual reports submitted by the International Authorities should be made publicly available on WIPO's website; and
  - (d) agreed that the International Bureau should submit a report to the PCT Assembly on the work undertaken in relation to the quality framework, including a reference to the annual reports, an aggregate report to be drafted by the Quality Subgroup, and annexes comprising the report from the Quality Subgroup as set out in the Annex to this document and relevant sections of this summary or the report of the session.

### **(b) Trilateral Collaborative Study on Metrics**

8. The Meeting noted a presentation by the European Patent Office on the "Collaborative Study on Metrics"<sup>1</sup> carried out by the Trilateral Offices (the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office).

### **(c) PPH/PCT Information Update; PPH Metrics**

9. The Meeting noted a presentation by the European Patent Office on the current status, latest developments and future plans with regard to the PPH (Patent Prosecution Highway) and PCT/PPH arrangements the European Patent Office has in place with various other Offices, including information on the results of a preliminary analysis carried out in respect of the applications which have been processed under the PPH arrangements to date<sup>1</sup>.

### **(d) EPO Manual of Best Practice (Quality Procedures before the EPO)**

10. The Meeting noted a presentation by the European Patent Office on its new "Handbook of Quality Procedures Before the EPO"<sup>1</sup>.

**(e) Recommendations Endorsed by the Working Group Related to Quality**

11. Discussions were based on document PCT/MIA/19/2.

*Clarity and Support*

12. The Meeting expressed general support for the proposed modifications of the provisions in the International Search and Preliminary Examination Guidelines which gave guidance to Authorities on the inclusion of observations on clarity and support, as set out in Circular C. PCT 1326. Some Authorities noted that they already provide comments in relation to clarity and support.

13. The International Bureau informed the Meeting that a further revised version of the proposed modifications, taking into account the responses received in reply to the Circular and the comments made at the Meeting, would be included in the Circular which it intended to issue within the next 2 months to consult on a broader package of modifications to the Guidelines aimed at incorporating all changes agreed since the last substantial update of the Guidelines in 2004.

*Scope of Search*

14. See the discussions on document PCT/MIA/19/5 in paragraphs 25 and 26, below.

*Explanations of Cited Documents*

15. The Meeting noted the suggestions by Offices with regard to the issue of explanations of cited documents received in response to Circular C. PCT 1295, as set out in document PCT/MIA/19/2. With regard to the issue of a possible revision of WIPO Standard ST.14, see paragraphs 39 and 40, below.

*Standardized Clauses*

16. The Meeting noted with approval the discussions and the way forward agreed by the Quality Subgroup as set out in the Summary by the Chair of its session, annexed to this summary.

*Access to Written Opinions*

17. Several Authorities expressed their general support for the proposal to further consider an amendment of the PCT Regulations aimed at making the written opinion by the International Searching Authority available prior to the present 30 months deadline, stressing the need to consult with users to obtain their views on such a change. One Authority stated that it preferred the current situation to remain as is.

*Second Written Opinion by the IPEA*

18. Several Authorities stated that, already today, it was their practice to issue a second written opinion where the applicant had attempted to overcome any deficiencies found to exist in the international application by way of argument or amendment but where the Authority still considered the application to be deficient. All of those Authorities expressed the view, however, that such additional opportunity for dialogue should not be made mandatory in all cases but rather remain optional for Authorities so as to give sufficient flexibility. Some Authorities reiterated their opinion that they considered the streamlining of Chapter II procedures to be one of the main achievements of the PCT reform process which should not be undone.

*Incentives to Encourage High Quality Applications and Early Corrections of Defects*

19. The Meeting noted the suggestions by Offices with regard to the issue of incentives to encourage high quality applications and early corrections of defects received in response to Circular C. PCT 1295, as set out in document PCT/MIA/19/2.

**(f) Further Quality-Related Work**

20. The Meeting agreed:

(a) as recommended by the Quality Subgroup, to proceed with the study proposed by the European Patent Office on a set of characteristics of international search reports established by International Authorities, noting that the resources available to the European Patent Office in 2012 would allow that Office to carry out that study only in respect of search report data from a maximum of two Authorities (in addition to the Authorities belonging to the IP5 group of Offices, which were already the subject of an equivalent ongoing study); the Meeting invited Authorities interested in participating in this study in 2012 and beyond to notify the European Patent Office accordingly;

(b) to request the Quality Subgroup to develop the concept of a pilot project under which Offices willing to participate would analyze the usefulness for the national phase of international search reports, based on a set of quality metrics to be developed by the Subgroup; one possibility might be to identify international search reports containing only "A" citations, where the case entered the national phase without any amendments to the claims and where the national search report contained "X" and/or "Y" citations.

**ITEM 5: FUTURE DEVELOPMENT OF THE PCT**

**(a) Recommendations Endorsed by the Working Group Relating to the Setting Up of a Third Party Observations System and of a Quality Feedback System**

21. Discussions were based on document PCT/MIA/19/3.

22. The Meeting noted with approval that the third party observation system was expected to begin operation on July 1, 2012. Some Authorities expressed concern about the proposed quality feedback system, but this would nevertheless be able to commence operation within a similar timescale.

**(b) Collaborative Search and Examination Pilot Project – Intermediary Report of Pilot Phase 2**

23. Discussions were based on document PCT/MIA/19/4.

24. The Meeting noted an intermediate report by the European Patent Office on phase 2 of the Collaborative Search and Examination Pilot Project carried out jointly by the European Patent Office, the Korean Intellectual Property Office and the United States Patent and Trademark Office.

**(c) Search Strategy Information in the PCT**

25. Discussions were based on document PCT/MIA/19/5.
26. The Meeting agreed that those Authorities which were willing should begin to provide their search strategies to the International Bureau in whatever form they might be available and that the International Bureau should make them available on PATENTSCOPE. The International Bureau should also publish any explanation provided by International Authorities of the contents of their search strategy and how best to understand and use it.

**(d) Any Other Issues**

27. The European Patent Office agreed that it would, once sufficient experience had been gained, provide a report on its recently introduced procedure to require applicants entering the regional phase to address any outstanding issues in the international preliminary report on patentability.

**ITEM 6: REVIEW OF SUPPLEMENTARY INTERNATIONAL SEARCH**

28. Discussions were based on document PCT/MIA/19/6.
29. The Meeting noted a preliminary oral report by the International Bureau on the responses by Authorities, Offices and users of the supplementary international search system received in reply to Circular C. PCT 1329 and exchanged views on the likely causes for the disappointingly low uptake by applicants.

**ITEM 7: PCT MINIMUM DOCUMENTATION – DEFINITION AND EXTENT OF PATENT LITERATURE**

30. Discussions were based on documents PCT/MIA/19/7 and 7 Add.
31. The Meeting agreed that the International Bureau should issue a Circular inviting International Authorities to nominate representatives for a task force to consider the technical issues set out in the document. Further consideration might also be required for other matters, such as effective classification of the documentation concerned.

**ITEM 8: PCT SEQUENCE LISTING STANDARD**

32. Discussions were based on documents PCT/MIA/19/8 and 8 Add.
33. The Meeting noted a progress report by the European Patent Office (in its role as the leader of the corresponding Task Force of WIPO's Committee on WIPO Standards (CWS)) on the development of a WIPO standard for the presentation of sequence listings in XML format and exchanged views on the remaining outstanding issues, in particular, as to the appropriate mechanism to ensure a smooth transition for current WIPO Standard ST.25 (and the equivalent PCT sequence listing standard) to the new XML standard.

34. The Meeting agreed that:

(a) it would be preferable if the CWS Task Force, before concluding its work on the development of the new XML standard, would also look into the issue of whether it will be possible for any tool to be developed which would allow for the easy and complete conversion of sequence listings filed in one format (ST.25 or XML) into the other;

(b) based on the conclusions reached by the Task Force on the issue of the feasibility of developing a conversion tool, the appropriate PCT bodies should commence a discussion on the most appropriate mechanism for transition from ST.25 to the new XML standard.

#### **ITEM 9: COLOR DRAWINGS IN INTERNATIONAL APPLICATIONS**

35. Discussions were based on document PCT/MIA/19/9.

36. The Meeting:

(a) noted a summary of responses to Circular C. PCT 1317 which had been received by the International Bureau;

(b) affirmed the importance of work to allow the use of color drawings in the PCT system, while recognizing the time, cost and legal issues which would be involved; and

(c) noted that a proposal would need to balance the convenience to applicants of a system where color drawings could be used in all Offices during both the international and national phases against the time which would be involved in overcoming all of the legal and technical barriers to achieve this.

#### **ITEM 10: PCT ONLINE SERVICES (ePCT)**

37. Discussions were based on document PCT/MIA/19/10 and a demonstration of the current ePCT applicant portal by the International Bureau.

38. The Meeting welcomed the information on the current state of work and recognized the importance of such developments to communications with and between Offices as well as between the applicant and International Bureau. The International Bureau invited International Authorities to engage in an ongoing discussion with the International Bureau to determine ways to make the overall system more effective for applicants and Offices alike. For International Authorities, the International Bureau was particularly interested in the machine interfaces and data which should be communicated to make the most effective use of each others' local systems.

#### **ITEM 11: REVISION OF WIPO STANDARD ST.14**

39. Discussions were based on document PCT/MIA/19/11.

40. While some International Authorities expressed certain reservations, the Meeting recommended that the International Bureau should propose the creation of a task force under the Committee on WIPO Standards to consider revision of WIPO Standard ST.14. The draft mandate of such a task force should extend to all matters within the scope of ST.14, including the definition of citation categories and the recommended presentation of non-patent literature.

**ITEM 12: FUTURE WORK**

41. The Meeting noted that the next session was expected to be convened in February or March 2013, probably immediately following a meeting of the Quality Subgroup. In the absence of alternative proposals from an International Authority, the meeting would be held in Geneva.

**ITEM 13: SUMMARY BY THE CHAIR**

42. The Meeting noted this Summary by the Chair.

**ITEM 14: CLOSING OF THE SESSION**

43. The Meeting closed February 9, 2012.

[Annex follows]

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<sup>1</sup> The presentations are available on WIPO's website at  
[http://www.wipo.int/meetings/en/details.jsp?meeting\\_code=pct/mia/19](http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/19)

## ANNEX

PCT QUALITY SUBGROUP  
SECOND INFORMAL SESSION  
CANBERRA, FEBRUARY 6 AND 7, 2012

## SUMMARY BY THE CHAIR

**1. REPORTS ON QUALITY MANAGEMENT SYSTEMS UNDER CHAPTER 21 OF THE PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES****(a) Reports by International Authorities**

1. One Authority noted that one issue of interest raised by the reports was the question of who the person or unit responsible for quality should report to; should this be the head of the Office or was it acceptable to report to the person operationally responsible for international search and preliminary examination? Authorities agreed that the appropriate structure depended on the extent of the quality management system and that reporting should be to the most senior person at least in the area to which the quality management system applied. In the case of a common system for an entire Office, this should be the President; in the case of a system specific to international search and preliminary examination this might be, for example, the Vice-President responsible for search and examination operations (though reporting to the President was acceptable or even desirable in this case as well).

2. One Authority wondered about the extent to which other Authorities were able to use a common quality management system for both international and national work products. Authorities agreed that, in most cases, the needs were found to be very similar. While the products differed slightly, particularly in format, the main differences in quality management were typically found to relate to how strictly timing of work needed to be assessed.

3. In response to a query by one Authority, Authorities noted that keeping quality related instructions up to date was a resource-intensive activity and that it was important to ensure that this was a top priority for a sufficient group of staff. Most Authorities had a selection of resources available, typically accessed using an Intranet. Responsibility for keeping these up to date might lie with either a particular unit or else a cross-cutting committee. It was observed that formal manuals frequently took time to update and in this case were often supplemented by interim instructions pending the publication of a new version, for example on an annual basis.

4. The Subgroup agreed to continue review of the reports and, to assist this process and provide additional information for the Member States, to compile an aggregate report covering matters of interest from all of the individual reports, including areas where practice was particularly close or particularly different between Authorities as well as any issues of special relevance noted. This would build on work already begun on the Subgroup's electronic forum, with different Authorities taking the lead for each section of the reports. The lead Offices should complete their first drafts by mid-May for comment by other Offices, to allow the work to be completed by the end of June, ready for publication of a document to be submitted to the PCT Assembly at the end of July.

**(b) Proposals for Modifications to Chapter 21**

5. In relation to a proposal by a designated Office to include, in paragraph 21.06, a requirement for assessing IT infrastructure, the International Bureau agreed to seek more detail on what requirements the infrastructure would be required to meet.



### **(c) Proposals for Modifications to the Reporting Template**

6. The Subgroup recommended that, instead of submitting full reports every five years and cumulative updates in the intervening years, Authorities should submit each report in the form of a full report, making the differences from the previous year's report clear, for example using "track changes" or other form of highlighting. The supplementary template would therefore no longer be required.

## **2. BETTER UNDERSTANDING OF THE WORK OF OTHER OFFICES**

### **(a) Trilateral/IP5 Catalogue of Differing Practices - Update**

7. The European Patent Office introduced the Catalogue of Differing Practices, which was the result of work carried out in the context of the cooperation between first the Trilateral Offices and subsequently extended to the IP5 Offices and which had now been published on the IP5 website. The Catalogue was intended to form a springboard for further work, both in helping examiners to understand work from other Offices and in identifying areas where convergence of practices was feasible. However, one of the main findings was that the terminology used by different Offices was inconsistent: the same term could often be understood in different ways by different people.

8. An expert study was now under way in one limited field (definition of prior art) to establish whether it was practical to condense the findings into something which was clear and useful. It was possible that this might form the basis of a glossary. A report on the feasibility of such an approach was expected by the end of 2012.

### **(b) Search Strategies**

9. Authorities agreed that work in this field could be divided into several areas. There was continued support from several Authorities for making available search strategies or search listings in whatever form they were currently recorded in their systems. However, this was considered by some Authorities to be a matter of assisting utilization of work rather than a quality issue as such. Authorities could simply go ahead with this if they wished to do so. Noting that search strategies would differ between Authorities and might not be self-explanatory, the International Bureau agreed, where an Authority wished to do so, to publish them on PATENTSCOPE together with any general explanation which an Authority wished to provide of how to understand and make best use of its search strategy documents.

10. In relation to the utility of search strategies for assessing quality, whether as a purely internal matter or between Authorities, Authorities agreed that a greater degree of understanding was required and that a greater degree of consistency was at least desirable. It needed to be clear who the search strategies were aimed at and what they were to be used for. Facilities for recording strategies or search listings varied considerably between different search systems and approaches needed to be found which worked in relation to all searching systems used and allowed the contents to be used readily. It was agreed that the target audience would always be someone with the skills of an examiner, whether that was in fact an examiner in a designated Office or a quality unit within the International Authority. Exactly what was required would still depend on what use was intended.

11. The Subgroup agreed to consider matters further on the electronic forum beginning with:

- (a) Willing Authorities would post examples of search strategies or search listings to assist in identifying best practices to assist internal development within Offices, scope for effective use by different interested parties and possible recommendations for developing more consistent approaches between Offices;

(b) Authorities would seek to find a common understanding of terminology, including items such as “search statement”, “search strategy” and “search listing”.

**(c) Use of Standardized Clauses**

12. Authorities noted that standardized clauses had a number of separate roles, including helping end users to quickly understand the issue being raised through consistency in use, as well as guiding examiners to cover all required issues to an appropriate level of detail. Use of clauses should never be compulsory, but there was significant interest in seeking to develop a set of model clauses, which could assist discussions of quality and consistency and be adopted by Authorities and used by examiners to the extent considered appropriate.

13. The Subgroup agreed to begin a pilot, seeking to develop model clauses in a limited area to be selected by the pilot group. The discussions would seek to identify general principles which would be useful in developing further clauses which were appropriate to making reports which would be useful to readers, assumed to be skilled examiners or patent attorneys. The pilot would be led by the Canadian Intellectual Property Office and assisted by the National Board of Patents and Registrations of Finland, the Spanish Patent and Trademark Office and the United States Patent and Trademark Office, as well as the International Bureau. The work would be conducted using the electronic forum so that other Authorities could follow the progress and comment.

**(d) Other ideas**

14. The Subgroup agreed to add a “brainstorming” area to the electronic forum, where Authorities could post any ideas for quality improvement, even if they were not clearly immediately practical. It was observed that much could be learned from considering and even trying out radically different approaches and sharing even “wild” ideas could lead to further, practical progress.

15. There was some discussion of how quality could be monitored and maintained in outsourcing arrangements. One Office observed that outsourcing could be highly effective if properly monitored and appropriate action taken if quality standards were not acceptable. Contract conditions could often be changed, if necessary, faster than changing practices within an Office. It was essential to provide a high degree of scrutiny in the early stages of outsourcing; this could be reduced at later stages, but needed to be kept at an appropriate level and acted on promptly. Another Office observed that outsourcing could be extremely valuable in cases of sudden unexpected influxes of work, especially if the work was conducted by another examining Office which clearly had all the necessary skills.

**3. QUALITY IMPROVEMENT MEASURES**

16. Discussions were based on a proposal by the Swedish Patent and Registration Office to further study an earlier suggestion made by IP Australia to modify Chapter 21 of the PCT Search and Examination Guidelines and the reporting templates thereunder to require Authorities to report in their annual quality reports on a number of quality indicators for international work products.

17. The Subgroup agreed that the International Bureau should invite Authorities, by way of a Circular, to reply to the Questionnaire proposed by the Swedish Patent and Registration Office, subject to minor modifications (responses to item (b) of each of the questions should not only indicate “yes/no” but should give further details as to what kind of checklist was used by the Authority; responses to item (d) of each of the questions should indicate what kind of quality metrics were used by the Authority) and further clarification as to what was meant by “written

formalities” in question 5 (all formal, non-substantive issues to be dealt with in the context of establishing a report or written opinion). One Authority stressed the importance of not only addressing the issue of final product quality but also of process quality, that is, the efficiency of the process of obtaining a high quality final product. The Secretariat indicated that it would aim at sending the Circular within 4 weeks following the meeting, with a time limit of 6 weeks for Authorities to respond to the Questionnaire.

#### **4. QUALITY METRICS**

18. Discussions were based on a proposal by the European Patent Office to carry out a study on a set of characteristics of international search reports established by all International Authorities (PCT search results; intermediate prior art cited in ISRs; patent and non-patent literature citations in ISRs; and official and non-official language citations), with the aim of developing indicators of what should be the focus of the work of the International Authorities in the near future when seeking to improve the quality of the international work products. The study would be carried out by the EPO in the analysis environment which it had developed for a similar study carried out in the context of the Trilateral Office cooperation and would use search report data publicly available in the EPO's PATSTAT database.

19. The Subgroup agreed to proceed with the study as proposed by the European Patent Office and to share the results through the electronic forum. It was noted that the proposed metrics would enhance mutual understanding of common and different practices. In addition, changes in the metrics if repeated over a number of years might also provide significant pointers for quality units. A more direct measure of quality, such as re-useability by Offices in the national phase, would require significant manual work by examiners to assess results. While this work was not practical at present, direct quality metrics remained the goal of the Subgroup.

#### **5. FURTHER WORK**

20. The Subgroup recommended that its work should continue, but considered that it was necessary to seek improved working arrangements. Each task on the electronic forum should have a clear leader posting an initial working document and Authorities should be given a clear deadline for response to questions. The International Bureau would assist in making these arrangements, including posting e-mails to the main PCT/MIA mailing list and, where appropriate, sending Circulars to emphasize particularly important arrangements.

21. The Subgroup recommended that further physical meetings should be held, but that the Meeting of International Authorities should recommend the timing following its experience in the 19th session, which was to be held immediately after the Subgroup meeting. Ideally, Subgroup meetings would be held separately from the Meeting of International Authorities, encouraging the participation of quality experts and allowing follow-up activities to be conducted in advance of the Meeting. However, this would be significantly more expensive than holding the two meetings back to back and it was not clear whether the benefits would be sufficient to warrant the additional expense.

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