

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

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

RECOMMENDATIONS ENDORSED BY THE WORKING GROUP RELATED TO QUALITY

Document prepared by the International Bureau

SUMMARY

1. This document addresses a number of issues relating to the quality of the international search and preliminary examination raised by Member States in response to Circular C. PCT 1295, dated March 8, 2011. Other quality-related matters, notably, matters arising from the annual reports by International Authorities under Chapter 21 of the PCT International Search and Preliminary Examination Guidelines, proposals for the development of quality metrics and the need for further modifications to Chapter 21, including the templates for submitting reports under Chapter 21, will be discussed by the PCT/MIA Quality Subgroup at its second session to be held on February 6 and 7, 2012. An oral report summarizing the discussions by the Quality Subgroup will be delivered to the Meeting.

BACKGROUND

2. The third session of the PCT Working Group endorsed a series of recommendations to improve the functioning of the PCT system, based on a study prepared by the International Bureau (document PCT/WG/3/2) and related submissions from certain member States (documents PCT/WG/3/5 and PCT/WG/3/13), as detailed in the report for the session (paragraphs 14 to 137 of document PCT/WG/3/14 Rev.). As a follow-up to the discussions by the Working Group, the International Bureau invited comments on issues relating to the quality of the international search and international preliminary examination of international applications from all PCT stakeholders by way of Circular C. PCT 1295, dated March 8, 2011. The issue of

quality was further discussed by the Meeting of International Authorities under the PCT at its eighteenth session, held in Moscow from March 15 to 17, 2011, as summarized in paragraphs 22 to 25 of the report of the session (document PCT/MIA/18/16).

3. A summary of responses to Circular C. PCT 1295 in relation to quality and appropriate content of reports by International Authorities was presented to the fourth session of the PCT Working Group, held in Geneva from June 6 to 10, 2011, as set out in paragraphs 12 to 14 of document PCT/WG/4/3, reproduced below:

“12. The responses to Circular C. PCT 1295 indicated that Offices found the intended contents of international reports do generally meet their needs. The most commonly expressed desire for improvement is to make it mandatory to include comments on at least significant issues of clarity (notably, where there is any doubt about the scope of the claims) and sufficiency of disclosure. One Office suggested that, insofar as these issues apply to specific claims, the written opinion form could include “Yes/No” boxes as is done for novelty, inventive step and industrial applicability.

“13. With regard to the performance of International Authorities in meeting the requirements, most respondents indicated that they were satisfied in most cases, but that there was a need for improved quality control and greater consistency of approach and some respondents indicated a need for more detail on the scope of the search (see also paragraph 55 [of document PCT/WG/4/3], below). A number of Offices indicated that a change of approach in presenting the report might help. This might involve moving away from the current “box” format of report to a more linear form, merging or slightly modifying some of the boxes and/or using more standard clauses to guide examiners in presenting arguments consistently and fully.

“14. The International Authorities have begun consideration of possible improvements in this area and the responses will be presented to the International Authorities in more detail to assist those discussions.”

QUALITY ISSUES

Clarity and Support

4. In relation to the inclusion of comments on at least significant issues of clarity and sufficiency of disclosure, the International Bureau has issued Circular C. PCT 1326, dated December 16, 2011, reproduced in Annex I to this document. Circular C. PCT 1326 invited comments on proposals for modifications to the PCT International Search and Preliminary Examination Guidelines with a view to require that observations on significant and pertinent issues relating to the clarity of the claims, description and the drawings, and comments on the question of whether the claims are fully supported by the description (PCT Rule 66.2(a)(v)) be always included in written opinions and the international preliminary examination reports. Given the direct impact of the proposed modifications on the work of International Authorities, the International Bureau considers that it would be useful to discuss and provide feedback on the issues set out in Circular C. PCT 1326 during the present session of the Meeting.

Scope of Search

5. In relation to providing more detail on the scope of the search, several Offices in response to Circular C. PCT 1295 commented on the proposal by the Canadian Intellectual Property Office to include broader search strategy information in international search reports (document PCT/MIA/18/7). While most Offices recognized the value of search strategy information, especially to patent examiners in national phase procedures, others expressed concerns about the additional time required for documentation of the strategy in the international search report. The Canadian Intellectual Property Office has submitted an amended proposal (document PCT/MIA/19/5) on how to take this issue forward.

Explanations of Cited Documents

6. In responding to Circular C. PCT 1295, several Offices underlined the importance of clear explanations of cited documents and accurate references to cited passages in reports produced in the international phase of the PCT. One Authority suggested that this point could be addressed in any future user surveys of the work of International Authorities. Specific comments included prefacing the claimed invention with an examiner's summary, along with a breakdown of the technical features to compare the degree of compatibility of the application under examination with the cited document, providing a detailed explanation of inventive step, given the different national laws and practices in this area, and including a distinction in search reports between X (novelty) and X (inventive step if the document is relevant when taken alone). The latter issue and a proposal for a possible revision of WIPO Standard ST.14 are set out in document PCT/MIA/19/11.

Standardized Clauses

7. In responding to Circular C. PCT 1295, several Offices further referred to the proposal by the Canadian Intellectual Property Office on the use of standardized clauses in international search reports, written opinions and international preliminary examination reports (document PCT/MIA/18/6). The International Bureau has invited submission of existing standardized clauses presently used by International Authorities in these reports, along with any other relevant clauses used in examination of national patent applications (see Circular C. PCT 1328, dated December 13, 2011, reproduced in Annex II to this document). The International Bureau will update the Meeting on any responses received to the Circular, and International Authorities are invited to offer comments on how to advance the discussions on the use of standardized clauses.

Access to Written Opinion

8. One Office in response to Circular C. PCT 1295 suggested making the written opinion of the International Searching Authority publicly available at an earlier point in time. At present, if international preliminary examination is not requested by the applicant, Rule 44*ter* requires the written opinion of the International Searching Authority and the international preliminary report on patentability to remain confidential until 30 months from the priority date, unless the applicant has entered the national phase early before any designated Office (in which case the Office may request access to the written opinion) or unless earlier access by a designated Office (or others) is requested or authorized by the applicant. The Meeting may wish to consider whether there is a need to review the current approach under which the written opinion of the International Searching Authority is made available to designated Offices and the general public only after the expiration of 30 months from the priority date.

Second Written Opinion by the IPEA

9. A number of respondents to Circular C. PCT 1295 supported the proposal to give applicants an extended opportunity for dialogue during the international preliminary examination procedure, notably by having the International Preliminary Examining Authority issue a *second* written opinion, in addition to that of the International Searching Authority, which is considered to be the *first* written opinion of the International Preliminary Examining Authority, where the applicant has attempted to overcome any deficiencies found to exist in the international application by way of arguments or amendments but where the Authority still considers the application to be deficient. Such an additional opportunity for dialogue in the international preliminary examination procedure would appear to be particularly beneficial for applicants intending to benefit from accelerated national examination schemes, such as the Patent Prosecution Highway (PPH), paving the way to file further amendments and/or arguments with a view to obtaining a positive international preliminary report on patentability (Chapter II).

10. While it would appear that, already today, many International Preliminary Examining Authorities follow this practice and issue a second written opinion, not all do so. In this regard, it is noted that the European Patent Office in its capacity as an International Preliminary Examining Authority has revised its practice under Rule 66.4 with effect from October 1, 2011, and will now issue a second written opinion, prior to establishing an international preliminary examination report, where the applicant has made a bona fide attempt to overcome any objections raised in the first written opinion yet the Authority considers that the application still is deficient.

Incentives to encourage high quality applications and early correction of defects

11. A number of respondents to Circular C. PCT 1295 made suggestions with regard to possible incentives for applicants to encourage the filing of high quality applications and the early correction of defects. Suggestions included the setting up of front-end formality checks by receiving Offices (prior to the filing of the application); incentives to increase the use of online filing (with built-in formality checks) and the filing of applications in compliance with the Common Application Format (CAF); the charging of additional fees where the application contained formality defects; the granting of fee refunds where an entirely positive international search report and written opinion by the International Searching Authority was issued; and accelerated processing during national phase procedures where a positive International Preliminary Report on Patentability (under Chapter I or II) had been established. One Office suggested that a "Code of Practice" should be developed which identified best practices for patent applicants and attorneys in the filing and prosecution of patent applications.

12. *The Meeting is invited to:*

(i) *provide feedback on the proposals set out in Circular C. PCT 1326, reproduced in Annex I to this document;*

(ii) *comment on the issues set out in Circular C. PCT 1328, reproduced in Annex II to this document;*

(iii) *comment on the other issues raised in this document.*

[Annexes follow]

ANNEX I

QUALITY OF SEARCH AND EXAMINATION OF INTERNATIONAL APPLICATIONS,
CONTENT OF WRITTEN OPINIONS AND INTERNATIONAL PRELIMINARY
EXAMINATION REPORTS

(reproduced from Circular C. PCT 1326)

C. PCT 1326

December 16, 2011

Madam,
Sir,

*Quality of Search and Examination of International Applications –
Content of Written Opinions and International Preliminary Examination Reports*

1. This Circular is being sent to your Office in its capacity as a designated and elected Office and, where applicable, a receiving Office and/or an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty (PCT). It is also being sent to Geneva-based missions and foreign ministries of PCT Contracting States and of States that are invited to attend meetings of the PCT Working Group as observers, as well as interested intergovernmental organizations and certain non-governmental organizations representing users of the PCT system.

Background

2. The PCT Working Group, at its third session held in Geneva from June 14 to 18, 2010, endorsed a series of recommendations to improve the functioning of the PCT system, based on a study prepared by the International Bureau (document PCT/WG/3/2) and related submissions from certain member States (documents PCT/WG/3/5 and PCT/WG/3/13), as detailed in the report for the session (document PCT/WG/3/14 Rev., paragraphs 14 to 137).

3. As a follow up to the discussions by the Working Group, the International Bureau invited all PCT stakeholders, by way of Circular C. PCT 1295, dated March 8, 2011, to comment on certain matters relating to the quality of search and examination of international applications.

4. Pending responses to that Circular, the issue of quality was further discussed by the Meeting of International Authorities under the PCT (PCT/MIA) at its eighteenth session, held in Moscow from March 15 to 17, 2011, in particular with regard to the question of what should be the appropriate content of written opinions and international preliminary reports on patentability. The PCT/MIA discussions are summarized in paragraphs 22 to 25 of the report of the session (document PCT/MIA/18/16), reproduced in Annex II to this Circular.

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5. A summary of the responses to Circular C. PCT 1295 in relation to quality and appropriate content of reports by International Authorities was presented to the PCT Working Group at its fourth session, held in Geneva from June 6 to 10, 2011, as set out in paragraphs 12 to 14 of document PCT/WG/4/3, reproduced in Annex III to this Circular.
6. The discussions by the Working Group of document PCT/WG/4/3 in relation to backlogs and improving quality of granted patents are detailed in paragraphs 41 to 48 of the report of the fourth session of the PCT Working Group, reproduced in Annex IV to this Circular.
7. Annex I to this Circular sets out proposals for modifications to the PCT International Search and Preliminary Examination Guidelines to indicate that observations on significant and pertinent issues relating to the clarity of the claims, the description and the drawings, and to the question of whether the claims are fully supported by the description (PCT Rule 66.2(a)(v)) should always be included in the written opinion and the international preliminary examination report. Other issues concerning the content of the opinion and report covered by Circular C. PCT 1295 will be the subject of further consultations and/or working documents to be prepared by the International Bureau.

Proposed Modifications to the International Search and Preliminary Examination Guidelines

8. As can be seen from the summary of the responses to Circular C. PCT 1295 in relation to quality and appropriate content of the written opinion and international preliminary examination reports set out in Annex III, there is a clear desire for the inclusion in every written opinion and international preliminary examination report of observations on at least significant and pertinent issues of clarity and support. This idea also received support at the Meeting of International Authorities (see Annex II), and from the majority of delegations that took the floor on this matter during the discussions at the PCT Working Group (see Annex IV).
9. In order to increase the usefulness of written opinions and international preliminary examination reports to designated/elected Offices and users, Annex I to this Circular sets out a proposal to modify the International Search and Preliminary Examination Guidelines in order to provide further guidance to International Authorities on the inclusion of observations on clarity and support. The proposed modifications aim to clarify that International Authorities should provide more comprehensive information on these matters in the written opinion or international preliminary examination report where the examiner considers that there are significant and pertinent clarity and/or support issues relevant to further processing of the international application, notably in the national phase of the PCT procedure before designated/elected Offices.
10. With regard to the question as to whether or not to include observations on the issue of clarity and support separately from considerations of novelty, inventive step and industrial applicability, the proposed modifications to the Guidelines clarify that due account should be given to the significance and pertinence of such objections in the further processing of the application. In particular, where a positive assessment of novelty, inventive step and industrial applicability is made in respect of all claims, an adequate analysis of clarity and support should be made by the International Authority. In such cases, the examiner should either make any relevant observations on lack of clarity and support, or include a positive statement that he has considered those criteria and that the requirements for clarity and support appear to be satisfied.

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11. Account should nevertheless be given to other amendments that may be necessary to the claims, for example, to overcome any negative statement with regard to novelty, inventive step (non-obviousness) and/or industrial applicability. Objections with regard to issues of clarity and support therefore need not be included where amendments will have to be made in order to overcome other objections where the likely result from such amendments is that the clarity and support issues will no longer be relevant to the further processing of the application.
12. Since situations will exist where it will not be appropriate to raise observations on clarity and support or make a positive statement that these requirements appear to be satisfied, the inclusion of a "Yes/No" check box to assess clarity and support in the written opinion and international preliminary examination report (that will not always require completion) is not proposed at this stage.
13. The International Bureau invites comments on the proposed modifications to the PCT International Search and Preliminary Examination Guidelines, to be sent to Mr. Claus Matthes, Director, PCT Business Development Division (e-mail: claus.matthes@wipo.int; fax: +41-22-338 7150) by January 29, 2012.
14. In general, any response received in reply to this Circular included in any subsequent report on the responses to this Circular will be presented only in an anonymous fashion; individual responses from Offices will not be attributed without the specific prior permission of the relevant Office or organization.
15. The issues raised in this Circular will also be discussed at the nineteenth session of the Meeting of International Authorities under the PCT, to take place in Canberra from February 8 to 10, 2012. Comments received prior to the above deadline will be reported to the Meeting of International Authorities so that they can be taken into account in the quality related discussions of that Meeting.

Yours sincerely,

James Pooley
Deputy Director General

Enclosures: Annex I – Proposed Modifications to the PCT International Search and Preliminary Examination Guidelines
 Annex II – Extract from Report of the Eighteenth Session of the Meeting of International Authorities under the PCT (paragraphs 22 to 25 of document PCT/MIA/18/16)
 Annex III – Summary of Responses to Circular C. PCT 1295 in Relation to Quality and Appropriate Content of Reports by International Authorities (paragraphs 12 to 14 of document PCT/WG/4/3)
 Annex IV – Extract from Report of the Fourth Session of the PCT Working Group (paragraphs 41 to 48 of document PCT/WG/4/17)

ANNEX I TO CIRCULAR C. PCT 1326

PCT INTERNATIONAL SEARCH AND PRELIMINARY EXAMINATION GUIDELINES
PROPOSED MODIFICATIONS

Clarity or Support

Rule 66.2(a)

17.31 Where the description, the claims, or the drawings are so unclear, or the claims are so inadequately supported by the description that no meaningful opinion can be formed on the questions of novelty, inventive step, or industrial applicability of the claimed invention, then the examination should ~~may~~ be restricted to those claims that are sufficiently clear and supported by the description to enable an opinion or report to be prepared (~~see Box No. III, 4th and 5th check boxes~~). In such a case, the examiner marks the appropriate check box in Box No. III (the 4th and/or the 5th check boxes) and includes observations below the appropriate check box on lack of clarity and/or support to explain the limitation of the examination.

17.32 The issues of clarity and descriptive support of the claims should, as appropriate, may be raised separately from considerations of novelty, inventive step and industrial applicability at Box No. VIII of the opinion or report (see chapter 5 and paragraph 17.48).

17.33 These matters should not be raised in an international preliminary examination report unless they have already been raised in a written opinion.

Box No. VIII: Certain Observations on the International Application

Rule 70.12

17.48 If, in the opinion of the examiner, there are significant and pertinent issues as to the clarity of the claims, the description and the drawings, or the question whether the claims are fully supported by the description, observations should be made ~~as to the clarity of the claims, the description and the drawings, or the question whether the claims are fully supported by the description, the examiner includes these observations to this effect in Box No. VIII of the written opinion and/or examination report, and also indicates the reasons therefor.~~ In such a case, the examiner should list the numbers of any relevant claims and indicate the reasons for lack of clarity and/or support. In deciding whether or not to include any observations on these matters, due account should be given to the significance and relevance of the observations in any further processing of the application during the national phase before designated/elected Offices. In particular, the examiner should take into consideration other amendments that may be necessary to the claims, for example, to overcome any negative statement with regard to novelty, inventive step (non-obviousness) and/or industrial applicability. Observations with regard to issues of clarity and support therefore need not be included when it is highly likely that amendments will have to be made in order to overcome other objections that could be raised in the national phase and these amendments would also resolve the clarity and support issues. On the other hand, where an opinion or a report includes a positive statement with regard to novelty, inventive step (non-obviousness) and industrial applicability in respect of all claims, the opinion or report should raise any significant and pertinent matters concerning clarity and support. Moreover, where no such matters arise, the opinion or report should include the following statement in Box No. VIII: "The claims appear to satisfy the requirements for clarity and are fully supported by the description and thus do not call for any observations under Rule 66.2(a)(v)" (see also paragraphs 5.31 to 5.58 and 17.09).

[Annexes II to IV to Circular C.PCT 1326 are not reproduced here]

[Annex II follows]

ANNEX II

STANDARDIZED CLAUSES IN PCT INTERNATIONAL SEARCH
AND PRELIMINARY EXAMINATION REPORTS
(reproduced from Circular C. PCT 1328)

C. PCT 1328

December 13, 2011

Madam,
Sir,

Standardized Clauses in PCT International Search and Preliminary Examination Reports

This Circular is addressed to your Office in its capacity as an International Searching and Preliminary Examining Authority under the Patent Cooperation Treaty (PCT).

The Meeting of International Authorities under the PCT (PCT/MIA), at its eighteenth session, held in Moscow from March 15 to 17, 2011, discussed a proposal from the Canadian Patent Office concerning the introduction of standardized paragraphs in international search reports, written opinions and international preliminary examination reports (document PCT/MIA/18/8).

The discussions of the proposal from the Canadian Intellectual Property Office are summarized in paragraphs 59 to 62 of the report of the session (document PCT/MIA/18/16). Paragraph 62 sets out the follow-up to the proposal agreed by the Meeting:

“62. The Meeting agreed that the International Bureau should consult with all Authorities, by way of a Circular, with a view to further refining the proposal before consulting on such further refined proposal more broadly with other Offices and users of the system. The Meeting further agreed that the Circular should invite Authorities to submit existing standardized clauses to the International Bureau so as to enable the International Bureau to establish whether there was sufficient common ground for moving forward with the proposal. In this context, the International Bureau offered to explore the possibility of arranging for the translation into English of those existing standardized clauses already in use by Authorities which were not in that language.”

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In accordance with the follow-up agreed by the Meeting, this Circular is being sent to invite your Authority to submit to the International Bureau information on any standardized clauses which it uses to complete international search reports, written opinions and international preliminary examination reports. This should include any standardized paragraphs used by your Authority to complete the free text areas on forms PCT/ISA/210 (International Search Report), PCT/ISA/237 (Written Opinion of the International Searching Authority), PCT/IPEA/408 (Written Opinion of the International Preliminary Examining Authority) and PCT/IPEA/409 (International Preliminary Report on Patentability), along with any information on the format followed by examiners in your Authority when ordering these clauses in the free text box of the relevant form. Your Authority is also welcome to supply any other information potentially relevant to establishing new standardized paragraphs for use in international search and preliminary examination reports, such as similar clauses used in examination reports of national patent applications.

If the standardized clauses used by your Authority to complete international search reports, written opinions and international preliminary examination reports are only in a language other than English, your Authority should submit the text in its original language(s), accompanied by a translation into English, if available. Where a translation into English is not available, some labeling should be included on each clause for identification purposes, for example, by making reference to the relevant legal provision in the PCT.

As indicated in the Meeting, the International Bureau will explore the possibility of arranging for translation into English of any clauses submitted which are not in English and are not already accompanied by a translation. Any such translation will, however, depend on the volume of text requiring translation, and the availability of resources for translation from the relevant source languages.

Responses to this Circular should preferably be uploaded as attachments on the PCT/MIA quality subgroup electronic forum. They may alternatively be sent to Mr. Claus Matthes, Director, PCT Business Development Division (e-mail: claus.matthes@wipo.int; fax: +41-22-338 7150) by January 16, 2012. Any pertinent issues arising from responses received by this date will also be able to be reported to the nineteenth session of the Meeting of International Authorities under the PCT, to take place in Canberra from February 8 to 10, 2012 and taken into account in the quality-related discussions at the session.

Yours sincerely,

James Pooley
Deputy Director General

[End of Annex II and of document]