

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

Twenty-First Session
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REVIEW OF THE CRITERIA TO APPOINT NEW INTERNATIONAL AUTHORITIES - STRENGTHENING THE OVERALL QUALITY OF PCT WORK PRODUCTS

Document submitted by the European Patent Office, the Federal Service for Intellectual Property (Rospatent) and the United States Patent and Trademark Office

BACKGROUND

1. The PCT Roadmap as expressed in documents PCT/WG/2/3 and PCT/WG/3/2 included specific recommendations many of which aim at strengthening the quality of PCT work products, especially international search reports, written opinions and international preliminary examination reports which are established by International Authorities. The importance of the quality of PCT work products is indeed widely recognized as essential to the well-functioning of the international patent system for the benefit of Offices, users and society as a whole. In particular, many designated Offices rely on PCT work products when processing international applications thus helping out reducing backlogs and ensuring reasonable pendency time before grant.
2. At the fifth session of the PCT Working Group, during the discussions on document PCT/WG/4/5 dealing with the surge in worldwide patent applications, several delegations raised the question of how to proceed in order to prevent low quality patents from overloading the PCT system and ensure that the system was functioning well, efficiently and continued to receive high quality patent applications (paragraph 56, document PCT/WG/5/22 Rev). These discussions highlighted that the quality of PCT work products was essential for both developed and developing countries.
3. With a view to tackle the challenges referred to in paragraphs 1 and 2, above, and in order to ensure the success of the PCT system in the long run, efforts to achieve the highest levels of quality must be collective (amongst an increasing number of Authorities) and continuous (as

quality standards evolve with the development of technology). For this reason, the Meeting of International Authorities has recently focused its work on ways to ensure more consistency in quality at global level by establishing a Quality Subgroup which reviews quality management systems and assesses proposals to improve overall quality. However, the requirements and procedures for appointment of International Authorities are also relevant since it is eventually the responsibility of each International Authority to establish PCT work products. In that respect, as indicated by the International Bureau in document PCT/WG/6/4, the requirements set in Rules 36 and 63 have never been reviewed since 1970, aside from three minor adjustments.

4. With this in mind, a number of delegations indicated last year at the twenty-fifth session of the PCT Committee for Technical Cooperation and at the forty-third session of the PCT Assembly that there was a need to review the requirements and procedures for appointment of International Authorities. The issue has also been discussed at the twentieth session of the PCT Meeting of International Authorities, held in Munich from February 6 to 8, 2013. At this occasion, a majority of Authorities confirmed the need for a review of both the requirements and procedures set up in 1970 with a view to ensure the overall quality of PCT work products (paragraphs 103 to 108, document PCT/WG/6/3).

5. At the sixth session of the PCT Working Group, the International Bureau prepared a document presenting the historical background of the requirements and procedures for appointment as an International Authority in Articles 16 and 32, and Rules 36 and 63. It also invited the Working Group to comment on the following two questions (paragraph 27, document PCT/WG/6/4):

“a) whether the existing Rules and Guidelines truly reflect what is necessary to provide the high quality of international search and preliminary examination envisaged by the PCT; and

b) whether the implementation of the processes for appointment and extension of appointment of International Authorities are appropriate to the current wishes of the Contracting States, whether in terms of the number, regional and linguistic distribution of Authorities or the level of scrutiny which is considered appropriate of their ability to perform international search and preliminary examination to the necessary standard.”

6. The PCT Working Group confirmed the need for a review of Rules 36 and 63 in order to strengthen and ensure the quality and thus the trust in PCT work products by Offices, users and the public at large. The objective of such a review is to ensure that Offices seeking appointment as International Authorities meet the highest levels of quality expected from PCT work products.

7. The PCT Working Group thus agreed to recommend to the PCT Assembly that the International Bureau should undertake a review of the criteria and procedures for appointment of an Office as an International Searching and Preliminary Examining Authority under the PCT and make proposals for necessary changes if appropriate, in coordination where appropriate with the Meeting of International Authorities, for discussion by the Working Group at its next session. At its forty-fourth session, the PCT Assembly endorsed this recommendation and gave mandate for the International Bureau to undertake the review.

8. The International Bureau thus drafted a paper reviewing the current criteria and procedures for appointment of International Authorities (document PCT/MIA/21/3). That document is, in general, much welcome. The present document aims at contributing to the review by providing further proposals and comments regarding the update and the implementation of the criteria under Rules 36 and 63.

ASSESSMENT OF THE CRITERIA UNDER RULES 36 AND 63

9. As suggested by the PCT Working Group, a review of the procedures for the appointment of International Authorities is needed in order to ensure that each request for appointment is assessed with respect to the established requirements in a fair and transparent manner. So far the advice of the Committee on Technical Cooperation (PCT/CTC) has in practice been regarded as a formality whereas Article 16(3)(e) makes it clear that, prior to taking a decision for appointment of an International Authority, the PCT Assembly should be properly advised on all relevant elements. The decision may be political but the requirements are technical in nature.

10. For this reason, the proposal that the CTC be confirmed as an expert body and thus convened at a date other than that of the PCT Assembly, contained in document PCT/MIA/21/3 (paragraph 42), is fully supported. In practice the CTC could be convened back-to-back with the PCT Working Group in order to ensure a proper technical assessment of the applicable requirements for appointment. It is recalled that all PCT member States sit in the CTC. The Office seeking appointment would present its case and an exchange of views could take place at expert level. In order to ensure an in-depth assessment, it is suggested that the Meeting of International Authorities (MIA) be consulted ahead of the PCT Working Group (option (a), paragraph 44, document PCT/MIA/21/3). Indeed, the feedback received by already appointed International Authorities would be much relevant for the CTC in view of their experience in the field. Possibly, an onsite review by suitably qualified Officers made available by a pool of International Authorities would be adding a quality step into the process (option (b), paragraph 44, document PCT/MIA/21/3). A report by such independent experts would indeed carry more weight to the application, but this could be left at the option of the candidate Authority as a supplement measure to the consultation of the MIA.

11. Finally, the time frame for appointment should be reviewed as well. To date, an Office seeking appointment may submit its request only a couple of months ahead of the PCT Assembly, leaving no time for delegations to properly study the file. In the future, it is suggested to implement a yearly process, with Offices submitting their request for appointment by the end of the previous year at the latest so that it could be appropriately examined by the MIA in January/February and discussed by the CTC in May/June before appointment by the PCT Assembly in September.

ACCESS TO THE PCT MINIMUM DOCUMENTATION (RULES 36.1(II) AND 63.1(II))

12. The current requirement under Rules 36.1(ii) and 63.1(ii) should be clarified so as to ensure that an Office seeking appointment had access to the entire PCT minimum documentation at the time it submitted its request for appointment. As mentioned in document PCT/MIA/21/3 (paragraph 32), this should include in practice the need for examiners to have full access to and the necessary skills to use the search tools relevant to their field of technology effectively. An Office should not be appointed on the basis of a commitment to comply with this requirement after appointment but prior to the start of operations as an Authority. This would ensure that Authorities seeking appointment are ready to commence work promptly after appointment. Rules 36 and 63 should therefore be amended to clearly reflect this assumption.

QUALITY MANAGEMENT SYSTEMS (RULES 36.1(IV) AND 63.1(IV))

13. An Office seeking appointment should be required to demonstrate to have had experience with a national quality management system similar to that under Chapter 21 of the PCT International Search and Preliminary Examination Guidelines. In particular, any Office seeking appointment should be required to have a quality management system complying with Chapter 21 of the Guidelines already in place two years ahead of its request for appointment, rather than only at the time of appointment as suggested in document PCT/MIA/21/3 (paragraph 34). The aim is to ensure that Offices seeking appointment show sufficient experience in carrying out high quality search and examinations. Rules 36 and 63 should therefore be amended to clearly reflect this assumption.

MINIMUM NUMBER OF EXAMINERS (RULES 36.1(I) AND 64.1(I))

14. The current criteria for appointment of new International Authorities includes the requirement that the Office seeking appointment has at least 100 full time employees with sufficient technical qualifications to carry out a search (Rules 36.1(i) and 64.1(i)). The threshold of 100 examiners was appropriate in 1978 in order to guarantee minimum standards of expertise and quality of work at a time when the documentation was many times smaller than it is now and the workload was much lower. However, this requirement has remained static for four decades and has not been adapted to the trends in documentation and workload. In particular, the complexity of the documentation, as well as the technology embodied by that documentation has continued to grow and develop over the last four decades. With a view to maintaining the desired levels of quality of work performed in the international phase, it is questioned whether the minimum number of 100 examiners is still adequate and whether it should not be increased.

15. On the other hand, new tools, in particular IT tools, have been developed during this period and have improved the efficiency of patent offices, helping them to master the growing workflow of patent applications. This is why at that stage there is no concrete proposal to change this criteria but it is suggested to have an exchange of views about a possible evolution of this criteria, taken alone or in combination with other criteria. The explanations and proposals made in document PCT/MIA/21/3 (paragraphs 15 to 29) are, in that sense, going in the right direction towards a further refinement of this criterion.

CONCLUSION

16. As a result of the changes proposed in this document, it is believed that the assessment of each Office seeking appointment would be better monitored at a technical level to support the strengthening of the PCT system. Appointed Authorities will be stronger and gain in efficiency and quality for the benefit of their users, other Offices and the public at large. The proposed procedural changes listed in paragraphs 9 to 11 do not need a Rule change but rather a change of practice so it could therefore be quickly implemented as suggested in document PCT/MIA/21/3 (paragraph 56). The other proposed changes listed in paragraphs 12 to 14 may require a limited modification of Rules 36 and 63 which could also be quickly and easily implemented; however this could be done in a separate exercise as suggested in document PCT/MIA/21/3 (paragraph 56).

17. *The Meeting is invited to note the comments in this document.*

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