

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

Twenty-Fourth Session
Reykjavík, February 8 to 10, 2017

PROMOTING LINKAGE BETWEEN THE INTERNATIONAL PHASE AND THE NATIONAL PHASE

Document prepared by the Japan Patent Office

BACKGROUND

1. Since the sixth session of the PCT Working Group that was held in May 2013, the Japan Patent Office (JPO) has been working to advance the concept of “promoting linkage between the international phase and the national phase”. In this regard, via the e-forum of the PCT Working Group, the JPO has invited other IP Offices to provide comments on useful measures and ideas for making linkage possible. At the twenty-first, twenty-second and twenty-third sessions of PCT/MIA held in 2014, 2015 and 2016 respectively, the JPO reported on the information provided by Offices, and received several comments from them.

2. The JPO would like to express our gratitude to the International Bureau for setting up the e-forum; and to numerous Offices for providing their comments, such as the Austrian Patent Office (AT), Australian Patent Office (AU), Canadian Intellectual Property Office (CA), State Intellectual Property Office of the People’s Republic of China (CN), European Patent Office (EP), Israel Patent Office (IL), Indian Patent Office (IN), Korean Intellectual Property Office (KR), Intellectual Property Office (Philippines) (PH), National Institute of Industrial Property (Portugal) (PT), Federal Service for Intellectual Property (Russian Federation) (RU), and United States Patent and Trademark Office (US).

DISCUSSION AT THE TWENTY-THIRD SESSION OF PCT/MIA

3. The JPO highlighted two measures, namely (a-2) “In citing patent documents written in languages other than English, indicate the corresponding part of the patent family documents written in English, if a patent family document in the English language exists” and (b-4)

“Conduct searches also on subject matter that is not considered patentable under one’s own national laws” at the twenty-third session of the Meeting. With regard to the former measure (a-2), the JPO wished for incorporation as soon as possible in the International Search and Preliminary Examination Guidelines (ISPE Guidelines), as had been supported at the twenty-second session of the Meeting in 2015 (see paragraph 33 of document PCT/MIA/23/14).

4. Authorities which took the floor on the matter welcomed the initiative taken by the JPO to collect input and feedback from other Authorities on possible measures to further strengthen the linkage between the international and the national phase of the PCT procedure. Several Authorities noted, however, existing limitations under national laws which prevented the implementation of some of the proposed measures. One Authority expressed concern about adding excessive extra workload to the international phase examiner (see paragraph 34 of document PCT/MIA/23/14).

5. The Meeting agreed that the JPO should work together with the International Bureau to consider the comments received on the measures, with a view to consolidating the measures and taking forward a selection which had received broad support from Authorities (see paragraph 37 of document PCT/MIA/23/14).

PROPOSAL

6. A summary of the information uploaded on the e-forum and the comments from International Authorities is provided in Annex to this document.

7. The JPO proposes concrete modifications of the ISPE Guidelines regarding the measures which had received broad support from Authorities. Furthermore, the JPO proposes modifications to clarify the ISPE Guidelines because it is preferable that the Guidelines are clear for the linkage between the international and national phase.

I. (A-2) IN CITING PATENT DOCUMENTS WRITTEN IN LANGUAGES OTHER THAN ENGLISH, INDICATE THE CORRESPONDING PART OF THE PATENT FAMILY DOCUMENTS WRITTEN IN ENGLISH, IF A PATENT FAMILY DOCUMENT IN THE ENGLISH LANGUAGE EXISTS

8. This (a-2) measure received broad support from Authorities at the twenty-second session of the Meeting in 2015. The JPO was urged to improve the proposal to incorporate the measure in the ISPE Guidelines. After that, the proposed modifications of paragraph 15.69 and 16.82 of the ISPE Guidelines were discussed and finalized as below at the Quality Subgroup (QSG) e-forum. The JPO wishes for incorporation of the modifications as soon as possible in the ISPE Guidelines.

Chapter 15

The International Search

Evaluating the Prior Art

Selection of Citations and Identifying Most Relevant Portions

15.67-15.68 [No change]

Rule 43.5(~~eb~~) to (e); Section 507(g)

15.69 To avoid increasing costs unnecessarily, the examiner should not cite more documents than ~~is~~ are necessary, and therefore when there are several documents of equal relevance, the international search report should not normally cite more than one of them.

When more than one member of the same patent family is present in a search file, the examiner, in selecting from these documents for citation, should pay regard to language

convenience, and preferably cite (or at least note) documents in the language of the international application. Also, due regard should be paid to the possible need of the designated Offices to translate cited documents. Therefore, the examiner should, whenever possible, identify precisely the part or passage of a cited document which is relevant by, for example, indicating also the page and paragraph or lines where the relevant passage appears. Where the cited document is in a language other than English and at least one family member of the cited document is available in English, it is desirable for the examiner to additionally mention at least that family member and indicate the part or passage of the family member corresponding to the relevant part or passage of the cited document.

15.70-15.72 [No change]

Chapter 16

International Search Report

Filling Out the International Search Report (Form PCT/ISA/210)

Citation of the Documents

16.78-16.81 [No change]

[Rule 43.5\(b\); Section 507\(g\)](#)

16.82 The search report is published with the specification and distributed worldwide. To enable any reader in any country to consider the citation in the most convenient document/language, the known family members of each citation are normally listed in the patent family annex sheet of the international search report ([see paragraph 15.69](#)). The box on the second sheet of Form PCT/ISA/210 entitled “See patent family annex” is checked if a family member listing is included with the report. Where INPADOC is used to check the family member, it should be noted that:

- (a) INPADOC does not provide family listings for documents published prior to 1968;
- (b) If INPADOC indicates there are no family members for a cited document then indicate this by entering the word “NONE” where the family members would appear. This indicates to the applicant that a search for family members has been carried out and there was a nil result; and
- (c) If INPADOC indicates that none of the citations has a family member the “See patent family annex” box should still be checked and the practice indicated in the paragraph (b) above should be followed for all citations.

II. (B-4) CONDUCT SEARCHES ALSO ON SUBJECT MATTER THAT IS NOT CONSIDERED PATENTABLE UNDER ONE'S OWN NATIONAL LAWS

9. This (b-4) measure was proposed under the recognition that it is usual for the Authority not to search or examine the subject matter which is not considered patentable under the national law of the Office. The JPO understands that this measure received broad support from Authorities with the view to the benefits not only for applicants but also the Contracting States at the twenty-third session of the Meeting.

10. As pointed out at the twenty-third session of the Meeting, there might be limitations under national laws which prevented the implementation of some of the proposed measures. Also, it should not add excessive extra workload to the international phase examiner (see paragraph 4, above). Therefore, the JPO proposes modifications of paragraph 9.02 of the ISPE Guidelines as below on conducting searches also on subject matter that is not considered patentable under one's own national laws, using the term "it is desirable" as is the case in (a-2) measure.

Chapter 9

Exclusions from, and Limitations of, International Search and International Preliminary Examination

Excluded Subject Matter

Articles 17(2)(a)(i), 34(4)(a)(i); Rules 39, 67

9.02 Rule 39 specifies certain subject matter which an International Searching Authority is not required to search. Rule 67 sets out an identical list of subject matter, on which an International Preliminary Examining Authority is not required to perform an international preliminary examination (and also, in accordance with Rule 43bis.1(b), for which the International Searching Authority is not required to establish a written opinion concerning novelty, inventive step and industrial applicability). While the subject matter in these Rules may be excluded from search or examination, there is no requirement that it be excluded.

Depending on the policy of the Authority, such subject matter ~~may be~~ is desirably searched or examined. Epecially, it is desirable to search or examine such subject matter wherever practicable, even if the subject matter is not considered patentable under the national/regional law of the Office acting as the Authority. Any such subject matter which a particular Authority is prepared to search or examine is set forth in an Annex to the Agreement between that Authority and the International Bureau. Accordingly, the subject matter excluded from the international search or international preliminary examination may vary between the various Authorities.

9.03-9.04 [No change]

11. It is noted that (b-4) measure has already introduced to the JPO's PCT procedure. Even though, under Japanese laws, methods for treatment of the human by surgery or therapy, as well as diagnostic methods, cannot be patented, the JPO does not exclude such subject matter from international searches and preliminary examinations (see "Introduction of 'Handbook of PCT International Search and Preliminary Examination in the Japan Patent Office'", available on the WIPO website at http://www.wipo.int/meetings/en/doc_details.jsp?doc_id=327176).

III. CLARIFICATION OF THE ISPE GUIDELINES

12. Paragraph 17.50 of the ISPE Guidelines revised in October 2015 states “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 to the effect in Box No. VIII of the written opinion and/or examination report.” However, paragraph 2.03 explains a secondary objective of the written opinion as “to identify whether there appear to be any defects in the form or contents of the international application, for example with regard to the clarity of the claims, the description, and the drawings, or whether the claims are fully supported by the description.” The statement of paragraph 2.03 might give a misunderstanding that the observations should always be made when there are issues as to the clarity or the support requirements regardless of whether the issues are “significant and pertinent” or not.

13. Considering paragraph 17.49 in contrast with 17.50 of the ISPE Guidelines, corresponding to Rule 66.2(a)(iii) and (v) of the PCT Regulations respectively, it is apparent that “defects in the form or contents” means formal defects, for example, failure to comply with one or more of the requirements specified in Rules 5 to 11, not substantive defects as to the clarity or the support requirements. Therefore, it is considered to be inappropriate to state “clarity of the claims, the description, and the drawings, or whether the claims are fully supported by the description” as the example of “defects in the form or contents” in paragraph 2.03.

14. The JPO proposes modifications of paragraph 2.03 of the ISPE Guidelines as below. The purpose of the modification is (i) to resolve a misunderstanding that all issues as to the clarity or the support requirements should be identified regardless of whether the issues are “significant and pertinent” or not, and (ii) to amend the statement of “clarity of the claims, the description, and the drawings, or whether the claims are fully supported by the description” as the example of “defects in the form or contents”.

Chapter 2

Overview of the International Search Stage

Objectives

2.01-2.02 [No change]

Rule 43bis

2.03 At the same time as establishing the international search report, the search examiner establishes a written opinion. The written opinion has the primary objective of formulating a preliminary and non-binding opinion on the questions of whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious) and to be industrially applicable. A secondary objective is to identify whether there appear to be any defects in the form or contents of the international application, ~~for example with regard to the clarity of the claims, the description, and the drawings, or whether the claims are fully supported by description~~ (for example, failure to comply with one or more of the requirements specified in Rules 5 to 11), or any 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.

2.04 [No change]

15. The Meeting is invited to consider the proposed modifications of ISPE Guidelines in paragraphs 10 and 144 above, and whether any of the measures and ideas referred to in the Annex to this document can be stipulated in the Regulations under the PCT or the ISPE Guidelines.

[Annex follows]

SUMMARIES OF COMMENTS AND PROPOSALS POSTED ON THE E-FORUM

ISA MEASURES

Existing practices

(a-1) Taking into account earlier search (Rule 41): Each IP office has its unique rules.

- (i) Even if examination on the earlier application has not yet begun, searches are conducted before the ISR is established (JP).
- (ii) Amount of fees reimbursed: fixed amounts: (CA, IL, JP); amounts based on extent of usage: (RU).
- (iii) Amount of fees reimbursed is based on the subject-matter claimed: Fees are reimbursed when the subject matter is the same (EP); fees are reimbursed when unity exists among the claims of the earlier application and the IA (JP).

Comments at PCT/MIA

- There is a need to clarify the method to specify the earlier application.
- There is no benefit to include this measure since hardly any applications would require it, since there are so few applications when the length of time from when they are filed to when the ISRs are established is short.
- We are against making this mandatory, since we are basically performing this same procedure already.
- Rule 41.1 should be broadly applied.

(a-2) In citing patent documents written in languages other than English, indicate the corresponding part of the patent family documents written in English, if a patent family document in the English language exists (JP).

Comments at PCT/MIA

- Although this may be beneficial, it creates more work. No need to make it mandatory.
- The patent family information by OPD is sufficient.
- At the twenty-second session, PCT/MIA agreed to advance the modification of the PCT International Search and Preliminary Examination Guidelines, in order that this measure be implemented based on the support by a number of Authorities. The JPO was urged to improve the proposal to implement the measure in the ISPE Guidelines.

Current Situation

- **The proposed modification was discussed and finalized at the Quality Subgroup e-forum.**

(a-3) Obtain search information from the office of earlier examination (EP); or from other ROs (AU).

Comments at PCT/MIA

- Already implemented with regard to national applications.

(a-4) Utilize international-type search results for provisional applications, before the complete PCT applications are filed (CA).

(a-5) Provide the International Bureau and applicants search strategies, along with ISA & WOSA (IL).

Proposals

(b-1) Prepare WO/ISAs and such reports using expressions that can be easily translated into English.

Comments at PCT/MIA

- Discussion about the Standard Clauses is sufficient.
- We cannot agree, since some information might be omitted as a result of simplifying descriptions.

(b-2) Detailed and clear description of reasoning in WO/ISA (EP).

(b-3) Clearly identify the scope of the search (in order to enable other IP offices to establish search strategies) (CA).

Comments at PCT/MIA

- This proposal seems to closely relate to measure (a-5).

Current Situation

- This issue has been discussed in the agenda “Better Understanding of Work of other Offices” at the Quality Subgroup Meeting.

(b-4) Conduct searches also on subject matter that is not considered patentable under one’s own national laws (CA, IL).

Comments at PCT/MIA

- Not only applicants but also the Contracting States may benefit from this.
- Additional databases are needed to conduct searches on subject matter that is excluded from patentability under national laws.

Current Situation

- The JPO proposes the modification of the ISPE Guidelines at the twenty-fourth session of PCT/MIA.

(b-5) Timely establish search reports of such quality that the ISA itself will fully rely on that search when the PCT application enters the national phase (IL).

(b-6) Obtain search and classification information (KR) from other IP offices (RU).

- *Note: New Rule 23bis.2 that will take effect from July 1, 2017 introduces “Transmittal of Documents Relating to Earlier Search or Classification for the Purposes of Rule 41.2”.*

NATIONAL OFFICE MEASURES

Existing measures

(c-1) Reduce fees for the national phase if Chapter II was carried out by the same office in the national phase (AU, EP).

Comments at PCT/MIA

- We are already doing this (Same response by multiple IP offices).
- We have concerns/hesitations about adopting this measure.
- Fees are reduced at the national phase for applications determined to be patentable at the international phase. On the other hand, reducing fees based on Chapter II is inappropriate, since it would encourage users to utilize Chapter II for a different purpose from the original one.

(c-2) Assign the same examiners to conduct both the national and international phase examinations, to the maximum extent possible (AU, EP, IL, JP).

Comments at PCT/MIA

- We are already are doing this (Same response by multiple IP offices).
- We are against making this mandatory, since it is not always possible.
- If the same examiners do both phases, they will not conduct additional searches at the national phase, except for top-up searches.

(c-3) The IP office carrying out the national phase examination limits national phase searches to documentation from specific countries such as one's own country, or in languages such as one's own, even when international phase work products by other IP offices are available (RU).

Comments at PCT/MIA

- This is interesting, in terms of reducing duplicate work. Some examiners already do this at their own discretion.
- I have concerns about making rules on search methods, including the scope of additional searches.

(c-4) Fees are reduced for applications when ISRs have been already issued. (CA, RU) The fees are further reduced if the ISR was issued by the same office as DO/EO (JP).

(c-5) Publish search reports in one's native language for all national phase applications, utilizing the International Search Report (AT).

(c-6) Utilize PCT-PPH (CA, IL).

Comments at PCT/MIA

- We support utilizing PCT-PPH (Same response by multiple IP offices)
- PCT-PPH is highly effective in encouraging applicants to overcome the reasons of refusals during the international phase prosecution.

- By increasing the number of offices participating in the PCT-PPH or by integrating the PPH and PCT systems, applicants will be encouraged to use Chapter II and amend claims as necessary at the international phase so as to make those claims patentable before entry into the national phase.

Current Situation

- This issue has been discussed at various forums including PCT/MIA.

Proposals

(d-1) In view of the fact that the patent family information described in ISRs is not necessarily complete, create a system that adds to patent family information in documents cited in the ISRs, when the national phase is begun (JP).

Comments at PCT/MIA

- This proposal would be quite useful.

(d-2) Designated offices can require applicants to submit Chapter II reports in certain cases, such as when issues that have been pointed out in the international phase have not been resolved for all claims (BR).

(d-3) Make it mandatory to respond to negative opinions presented in the international phase, when entering the national phase. Apply sanctions against any cases of non-response (UK/US joint proposal). Mandatory only if national and international phases are conducted by the same IP office (EP etc. PCT/WG/6/24 paragraphs 95 to 101).

Comments at PCT/MIA

- IP Australia informed that it had started a trial, under which the applicant entering the national phase was invited to take into account the written opinion or international search and preliminary examination report before starting national examination by making amendments and/or providing comments on the opinion or report. This trial would run at least until the end of 2016 (see paragraph 36 of document PCT/MIA/23/14).

(d-4) Develop a feedback system from designated office to ISA/IPEA on how the prior art cited in ISRs are used in the national phase and the examination results in the national phase (JP, RU).

Comments at PCT/MIA

- The proposal could create a burden on the DOs, and some IP offices cannot do this because of their national laws. Examiner's written opinion on the IPER would be sufficient.

HOW WORK PRODUCTS IN THE INTERNATIONAL PHASE AND SEARCH RESULTS BY OTHER OFFICES ARE USED.

Existing practices

(e-1) Enable access to not only previous searches but also to prior examination reports and claim sets (CA).

Comments at PCT/MIA

- Preferably IB should provide an IT system that enables offices to submit their search results along with relevant claims and examination results.
- We support this idea, whose direction is the same as that of the global dossier, OPD, WIPO-CASE.

(e-2) Perform top up searches and expand classification for search subjects and like (AU).

(e-3) Suggest to those, whose earlier applications have already been filed in other countries and been granted patent rights, to conform the claims to the allowed claims in order to obtain a direct allowance (PH). An applicant is entitled by law to request that an application be allowed on the basis of a foreign patent with claims identical to those granted in the foreign country (Israel Patent Law Section 17 (c)) (IL).

(e-4) Provide automatic electronic access to documents cited by other offices for patent family applications (EP).

(e-5) Provide tool for finding similar applications from the same applicant and the prior art cited in such applications (EP).

(e-6) Examiners have to give due diligence to examination results by other IP offices, not just in the FA phase but throughout entire examination process, to ensure that foreign examination results considered are up to date (AU).

(e-7) Review applicability or relevance of decisions on search result, novelty, invention, requirement of description, and like made by other offices in light of their own laws and regulations (AU).

(e-8) Check the claims that were searched by the other office to see if the claims under examination are similar enough to rely on the results of earlier searches (AU).

(e-9) Review a previous search in conjunction with the corresponding examination report to fully understand the previous search (CA).

(e-10) In your own office, put to use information on appropriate classification and relative documents obtained from the results of other offices (PT).

WAY OF PROVIDING SEARCH AND EXAMINATION INFORMATION

Existing practices

(f-1) Search information containing a full history of the International Search including a listing of databases consulted (including the IPC categories where relevant), the steps undertaken in the search, the specific terms keyed into the search engines, any chemical structures or gene sequences if relevant, the documents viewed, and the examiners who conducted the search (AU).

(f-2) Electronically publish search strategy information (AU).

Proposals

(g-1) Require each IP office to submit search and examination results to WIPO, which will be the sole and central source of reference (e.g. WIPO-CASE) (AU, CA, IL).

Comments at PCT/MIA

- Global Dossier is intended to be linked to WIPO-CASE, thus it may help in achieving the objective.

(g-2) Indicate clearly the relevance of citations, novelty or inventive steps of claims, using category of documents or summary tables (AU).

(g-3) Document sharing among offices, as well as sharing best practices, contributes to improving the quality of patents (PT).

Comments at PCT/MIA

- The JPO and EPO informed that they have published their own PCT Guidelines at the twenty-third session of PCT/MIA (see paragraph 35 of document PCT/MIA/23/14).

[End of Annex and of document]