

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

**Twenty-Fifth Session
Madrid, February 21 to 23, 2018**

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 which was held in May 2013, the Japan Patent Office (JPO) has made efforts to advance the concept of "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 advancement of linkage. At the twenty-first to twenty-fourth session of the Meeting held in 2014 to 2017, there had been discussions based on the information from each Authority.

PROGRESS AT AND AFTER THE TWENTY-FOURTH SESSION OF THE MEETING

2. At the twenty-fourth session of the Meeting held on February 8 to 10, 2017 the JPO proposed the modification of the PCT International Search and Preliminary Examination Guidelines (the ISPE Guidelines) (document PCT/MIA/24/11). The Meeting agreed that the Japan Patent Office should work together with the International Bureau to incorporate the proposed modification into the ISPE Guidelines. The Meeting confirmed that either Box C or the patent family Annex of Form PCT/ISA/210 could be used for indicating relevant parts of patent family members (see paragraph 38 of PCT/MIA/24/15).

3. At the same time, PCT Circular C. PCT 1498 was issued on February 10, 2017 and proposed the modification of the ISPE Guidelines. According to that, the ISPE Guidelines were modified in July 2017. However, this modification of the ISPE Guidelines did not fully reflect the argument at the twenty-fourth session of the Meeting.

PROPOSAL

4. Considering the status described above, the JPO proposes the additional modification of the ISPE Guidelines.

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

5. As stated above, the ISPE Guidelines were modified in July 2017, and the description "Where the cited document is a patent document in a language other than English and another member of the same patent family is available in English, the examiner should preferably also indicate the corresponding part or passage of the English member of the patent family." was added to paragraph 15.69 and paragraph 16.64 of the Guidelines.

6. However, it is not shown in the ISPE Guidelines that the Box C or the patent family annex can be used to indicate the corresponding part or passage of the English member of the patent family.

7. Therefore the JPO proposes the following modification below. The proposal is simple and is to add the same description as paragraph 16.64 of the Guidelines to paragraph 16.82 of the Guidelines which mentions patent family annex. The points revised in July 2017 are indicated by yellow highlighter.

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(b) to (e); Section 507(g)

15.69 To avoid increasing costs unnecessarily, the examiner should not cite more documents than **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 a patent document in a language other than English and another member of the same patent family is available in English, the examiner should preferably also indicate the corresponding part or passage of the English member of the patent family.

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](#)). [Where the cited document is a patent document in a language other than English and another member of the same patent family is available in English, the examiner should preferably also indicate the corresponding part or passage of the English member of the patent family.](#) 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.

Chapter 17

Content of Written Opinions and the International Preliminary Examination Report

Content of the Opinion or Report

Box No. V: Reasoned Statement Under Rule 66.2(a)(ii) with Regard to Novelty, Inventive Step or Industrial Applicability; Citations and Explanations Supporting Such Statement

17.42 [No change]

[*Rules 43.5\(e\), 70.7\(b\); Section 604*](#)

17.43 Explanations should clearly indicate, with reference to the cited documents, the reasons supporting the conclusions that any of the said criteria is or is not satisfied. If only certain passages of the cited documents are relevant or particularly relevant, the examiner should identify these, for example, by indicating the page, column or the lines where such passages appear. **In the case of a patent document in a language other than English, the**

examiner should preferably also indicate the corresponding part or passage of the English member of the patent family if such a member is available.

17.44 [No change]

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

8. At the twenty-fourth session of the Meeting, Authorities supported the measure (b-4) "Conduct searches also on subject matter that is not considered patentable under one's own national laws" (see paragraph 34 of PCT/MIA/24/15).

9. "Agreement between the Japan Patent Office and the International Bureau of the World Intellectual Property Organization in relation to the functioning of the Japan Patent Office as an International Searching Authority and International Preliminary Examining Authority under the Patent Cooperation Treaty" which took effect in January 2018 includes the measure. In other words, regarding the subject matter set forth in Rule 39.1 or 67.1 which, under Article 4 of the Agreement, is not excluded from search or examination, the agreement provides that "any subject matter which is searched or examined under the patent grant procedure in accordance with the provisions of Japanese Patent Act; and methods for treatment of the human body by surgery or therapy, as well as diagnostic methods."

10. The following is the modification itself which was proposed by the JPO at the twenty-fourth session of the Meeting. The substantive argument on the following modification was already confirmed at the twenty-fourth session of the Meeting.

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]

III. CLARIFICATION OF THE ISPE GUIDELINES

11. Paragraph 17.50 of the ISPE Guidelines revised on July 1, 2017 provides that "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." This statement in paragraph 2.03 might cause 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.

12. Considering paragraphs 17.49 and 17.50 of the ISPE Guidelines which correspond to Rule 66.2(a)(iii) and (v) of Regulations under the PCT respectively, it is apparent that "defects in the form or contents" mean 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.

13. The JPO proposed, at the twenty-fourth session of the Meeting, the modification of paragraph 2.03 of the ISPE Guidelines as shown below (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."

14. At the twenty-fourth session of the Meeting, some Authorities supported the measure to clarify the International Search and Preliminary Examination Guidelines in paragraph 2.03. However, one Authority stated that the present wording in this paragraph had existed before the International Search Guidelines and International Preliminary Examination Guidelines had been merged, and had been part of the overview of international search. This Authority suggested modifying this paragraph to add the word "observation" before "significant and pertinent issues", and add this term to the glossary to clarify the matter (see paragraphs 34 and 35 of PCT/MIA/24/15).

15. The JPO considers that the modification shown below which was supported by some Authorities at the twenty-fourth session is sufficiently clear while the modification which was proposed by one Authority might seem to make the meaning of the sentence a little vague. Therefore, the JPO would like to propose the modification shown below again and hopes that every Authority supports it.

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]

IV. OTHER PROPOSALS

16. For reference, the items, which are discussed at the PCT-MIA or the e-forum and are not related to the additional modification described above, are shown in the Annex of this document.

17. It should be noted that item (a-6), which is to clarify the determination on claims including functional expressions by fully specifying the point determined to have novelty and inventive step and has been tried by the JPO as an ISA since September 2017 when establishing a written opinion, has been added to the Annex of this document.

18. In some jurisdictions, non-technical features which do not contribute to the technical characters of the invention are not taken into account when assessing inventive step or if an examiner concludes that a functional limitation is an inherent characteristic of the prior art, the examiner will state the conclusion and the burden then shifts to the applicant to establish that the prior art does not possess the characteristic relied on. While at the JPO, if there is an expression specifying the product by its function in a claim, examiners interpret the claim as all products including such function and compare the claimed invention and the prior art when assessing novelty and inventive step.

19. For example, if an examiner does not describe that "the control unit which calculates X" is neither disclosed nor obvious but describe that the feature of the control unit to "calculate X" is neither disclosed nor obvious, the examiner can highlight that the claimed invention is determined to have novelty and inventive step due to the functional expression. Although, as stated above, practices vary by jurisdiction the JPO believes that by devising the description of a written opinion, examiners can correctly communicate the determination criteria and the intention to the applicant and the examiners in other offices.

20. *The Meeting is invited to consider the proposed modification of the ISPE Guidelines in paragraphs 7, 10 and 15 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 in including this measure since hardly any applications would require it, since there are so few applications where the length of time from the time they are filed to the time 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

- **At the twenty-fifth session, Authorities will discuss on the additional modification of the ISPE Guidelines.**

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

Comment 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).

(a-6) Clarify the determination on claims which include functional expressions by fully specifying the point determined to have novelty and inventive step when establishing a written opinion. For example, not describe that “the control unit which calculates X” is neither disclosed nor obvious but describe that the feature of the control unit to “calculate X” is neither disclosed nor obvious to highlight that the claimed invention is determined to have novelty and inventive step due to the functional expression (JP).

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).

Comment 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 proposed the modification of the ISPE Guidelines at the twenty-fourth session of PCT/MIA. The issue will be discussed at the twenty-fifth session.

(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 took effect from July 1, 2017 introduced "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 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 (also see paragraph 38 of PCT/MIA/24/15).

Proposals

(d-1) In view of the fact that the patent family information described in the 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).

Comment 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).

Comment at PCT/MIA

- IP Australia updated the Meeting on the 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. As a result of this invitation, the number of applications where amendments or comments had been made by the applicant before national examination had doubled (see paragraph 37 of PCT/MIA/24/15).

(d-4) Develop a feedback system from designated office to ISA/IPEA on how the prior art cited in the 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.
- The Canadian Intellectual Property Office reported on its experience of developing a feedback process through its collaboration in the Vancouver Group of Offices. One challenge was the volume of cases with ISA/CA and DO/GB. But, more importantly, the time lag between the international search and national phase examination sometimes resulted in the designated Office giving feedback on issues that had already been resolved by the International Searching Authority. The International Bureau reminded the Subgroup of the requirement for Offices to provide information about national phase entries from July 1, 2017. It also suggested that problems and experiences of other Offices could be discussed on the Subgroup electronic forum (see paragraphs 21 and 22 of Annex II of PCT/MIA/24/15).

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).

Comment 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).

Comment 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 PCT/MIA/23/14).

[End of Annex and of document]