

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

Thirtieth Session
Geneva, November 1 to 3, 2023

PROPOSAL TO PROMOTE THE IMPROVEMENT OF PCT INTERNATIONAL SEARCH REPORTS AND WRITTEN OPINIONS

Document prepared by the China National Intellectual Property Administration

SUMMARY

1. In contributing to the improvement of the quality of PCT international search reports and written opinions, the China National Intellectual Property Administration (CNIPA) makes a further proposal for Promoting the Improvement of the PCT International Search Report (ISR) and Written Opinion (WOSA), including working principles, priorities and next steps. This further proposal is a continuation of work following the Report on the Survey to Promote the Improvement of the International Search Report and the Written Opinion (final version) made available to Quality Subgroup electronic forum on October 19, 2022.

BACKGROUND

2. At the twenty-sixth session of the Meeting of International Authorities in February 2019, the CNIPA proposed to conduct a survey with a view to improving the layout, content and format of the ISR and WOSA, so as to promote the improvement of the quality of ISR and the WOSA (document PCT/MIA/26/11).

3. In 2020, with the support from the International Bureau, the CNIPA issued questionnaires through PCT Circulars (C. PCT 1607 and C. PCT 1608). Twenty International Authorities, as well as 34 designated Offices and user organizations, participated in the survey. The CNIPA led compiling the statistics on the results of the survey, summarized 29 comments and drafted the survey report.

4. At the twenty-ninth session of the Meeting of International Authorities in June 2022, the Authorities gave their views on the survey report and priority items. The Authorities provided further comments on prioritized items via the Quality Subgroup electronic forum after the session. As of the timeline mentioned in document PCT/MIA/29/7, no further feedback on priority items had been received from the Authorities.

PROPOSAL

5. On the basis of the recommendations in the final survey report and the feedback from the Authorities at the twenty-ninth session of the Meeting of International Authorities (see paragraphs 34 to 38 in the Summary by the Chair of the session, document PCT/MIA/29/10) and all the comments on the Quality Subgroup electronic forum, the CNIPA proposes two working principles and four priority items below.

WORKING PRINCIPLES

6. The CNIPA recommends that the identification of priority items be guided by the following two principles:

Principle 1: Prioritize issues on which there is a high degree of consensus among the International Authorities.

Principle 2: Prioritize issues where improvements can be achieved by amending the PCT International Search and Preliminary Examination Guidelines.

7. It should be noted that some of recommendations in the survey report regarding the modifications to the layout, content and format of the forms involved the adaptation of IT systems and data structures. Considering the cost and difficulty of implementation, the CNIPA proposes that changes to the relevant content are not prioritized for the time being. Specifically, the following two recommendations are also supported by a larger number of Authorities: (i) Merging PCT/ISA/210 and PCT/ISA/237 into one form (corresponding to the Report 1.1.1); and (ii) Replacing facsimile number with e-mail address (corresponding to the Report 2.1.2). However, as it involves a modification of the form, it will not be included in the current priority items.

LIST OF PRIORITY ITEMS

8. Based on the above working principles, the following priority items are recommended:

(a) Clarify the requirements and differences for the completion of Box VII and VIII of PCT/ISA/237 and add templates in the PCT International Search and Preliminary Examination Guidelines paragraph 17.49 (corresponding to the Report 2.3.1).

(b) Clarify the treatment of non-patent literature in languages other than English in the PCT International Search and Preliminary Examination Guidelines paragraph 16.78B (corresponding to the Report 2.3.2).

(c) Clarify the filling requirement of evidence from the Internet and the filling position in the PCT International Search and Preliminary Examination Guidelines paragraph 16.78 (corresponding to the Report 2.3.3).

(d) Clarify the relationship between Box IV "Lack of unity of intention" and Box III "Non-establishment of opinion with regard to novelty, inventive step and industrial applicability" of PCT/ISA/237 in the PCT International Search and Preliminary Examination Guidelines paragraph 17.38 (corresponding to the Report 2.3.5).

NEXT STEP

9. In order to promote the improvement of the quality of PCT work products, as well as to enhance the efficiency of completing and utilizing the PCT/ISA/210 and PCT/ISA/237 Forms, the CNIPA will continue to propose the revisions of the PCT International Search and Preliminary Examination Guidelines for the four priority items and post them on the Quality Subgroup electronic forum to invite comments from International Authorities.

10. The Meeting is invited to comment on:

(i) the working principles and priority items set out in paragraphs 6 to 8, above; and

(ii) the next step set out in paragraph 9, above.

[Annex follows]

SUMMARY OF OTHER PROPOSED AMENDMENTS IN THE SURVEY REPORT

RECOMMENDATIONS FOR OPTIMIZING THE FORMS' LAYOUT AND CONTENT

1. With regard to Box 1. "Basis of the report" on the first sheet of PCT/ISA/210, to indicate the specific language in case when "the international application in the language in which it was filed" is marked.
2. With regard to Authority information on second sheet of PCT/ISA/210 and the first sheet of PCT/ISA/237, to replace "Facsimile No." with "Facsimile No. (and/or) E-mail".
3. With regard to "A. Classification of Subject Matter" on second sheet of PCT/ISA/210, to add CPC classification symbols.
4. With regard to Box IV "Lack of unity of invention" on the cover sheet of PCT/ISA/237, to modify the title "Lack of unity of invention" to "Unity of invention".
5. To provide references or hyperlinks to the relevant PCT articles and rules in all boxes.
6. With regard to "6. With regard to the drawings" on the first sheet of PCT/ISA/210, to modify options a and b to cover all scenarios.
7. With regard to "B. Fields Searched", to merge the following three boxes and to add the checkbox of indicating whether the search strategy is attached.
8. With regard to Box II "Priority" on the cover sheet of PCT/ISA/237, to modify the option setting to cover all scenarios. The current options do not cover scenarios such as partial validity of priority, validity of certain priority when multiple priorities are requested, etc.
9. With regard to Box V "Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement", to optimize the layout and content in the following three areas: (i) to split the box into three subsections of Novelty, Inventive step and Industrial applicability; (ii) to list citations instead of "Citations and explanations"; and (iii) to integrate with Box IV.
10. To identify AI search in PCT/ISA/210.
11. With regard to Box VI "Certain documents cited" of PCT/ISA/237, to identify "P" document when a periodical article or any other relevant written document other than patent published between the priority date and filing of the international application.
12. To identify image or chemical formula section in PCT/ISA/237.
13. To identify whether the informal comments submitted have been taken into account when drafting the written opinion in PCT/ISA/237.
14. To connect the main box and the supplementary box.
15. To expand the blank space for filling, including the title of the application and the abstract on the first sheet of PCT/ISA/210, Boxes II and III, and Box A "Classification of Subject Matter" in PCT/ISA/210, and Box V in PCT/ISA/237.
16. To harmonize the arrangement of duplicate boxes in two forms: (i) to delete duplicated boxes in two forms; and (ii) to show the same or relative content from two forms in the corresponding sequence. For example, the information of the ISA and authorized officer should be displayed on the front page of each form.
17. To merge PCT/ISA/210 and PCT/ISA/237 into one form.

RECOMMENDATIONS FOR THE FORMAT OF PCT/ISA/210 AND PCT/ISA/237

1. The XML format is recognized as a user-friendly tool for processing, analyzing and deriving information.

[End of Annex and of document]