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**INTERNATIONAL PATENT COOPERATION UNION
(PCT UNION)**

WORKING GROUP ON REFORM OF THE PATENT COOPERATION TREATY (PCT)

Third Session
Geneva, November 18 to 22, 2002

REFORM OF THE PCT:
PROPOSAL BY THE UNITED KINGDOM

Document prepared by the International Bureau

1. At its thirty-first (18th extraordinary) session held in Geneva from September 23 to October 1, 2002, the Assembly of the PCT Union agreed that the proposal by the United Kingdom for development of a common quality framework (document PCT/A/31/8) should be referred to the Working Group on Reform of the PCT for further discussion (see document PCT/A/31/10, paragraph 65).

2. On November 5, 2002, the International Bureau received a further proposal submitted by the United Kingdom for a programme for sustained quality and efficiency. The said proposal is annexed to this document.

3. The Working Group is invited to consider the proposal contained in the Annex to this document.

[Annex follows]

ANNEX

A PROGRAMME FOR SUSTAINED QUALITY AND EFFICIENCY

INTRODUCTION

1. At the meeting of the Committee on Reform of the PCT in July this year the United Kingdom delegation recommended the establishment of a common quality framework for the PCT international phase and a system for monitoring results. There was general support for the proposal and the Committee agreed that it should be put on the agenda for the PCT Assembly in September. The Assembly duly considered the proposal and agreed that a quality framework for the international phase be incorporated into the PCT reform programme and that the matter should be discussed at the next session of the Working Group on Reform of the PCT.

BACKGROUND

2. The general thrust of recent PCT reform has been to improve overall efficiency by strengthening the International Phase. If ISA/IPEAs were to work to agreed quality standards for search and examination, which are recognised by all Offices, it should increase the confidence among national Offices to accept the results of the work done in the international phase and refrain from repeating such work in the national phase. Removing thisinefficient duplication of effort should go a considerable way to reducing workloads, delays and costs and help eliminate the continuing backlog problems facing many Offices. Moreover, if international search and examination reports are produced to a consistently high quality, those national Offices which do not have examining capabilities will be able to depend on the results to underpin their granting process and allow them to focus on work which is necessary for meeting the requirements of their national laws. Such quality standards would also increase the confidence of users in the results that they receive, regardless of the Authority chosen or allocated.

3. The discipline of a robust and effective quality framework under which ISA/IPEAs would work to standards recognised by all Offices and subject to objective validation should not only benefit national and regional Offices but also applicants and the public in general by ensuring they receive search and examination reports within the prescribed timescale and to a consistently high standard. Providing a framework in which Offices cooperate in the development of a quality system and monitor its performance will facilitate the sharing of best and new practice. This would also promote continual improvement and encourage ISA/IPEAs to adopt the most efficient practices to ensure that the amount of work they put into searching and examining applications is appropriate, that is, that it is fit for purpose and not unduly excessive.

4. Put simply, a quality framework should be viewed as not only complementing and building on the progress being made in improving and streamlining the PCT but as an essential and integral part of a strengthened international phase which fits the emerging WIPO agenda for the development of the international patent system.

OUTLINE PROPOSALS

5. The following elaborates on the United Kingdom’s proposals by outlining the key component of an effective quality framework. If this broad outline is adopted, consideration

will need to be given as to how best to implement such a framework, for example by expanding the minimum requirements prescribed in rules 36 and 63 of the Regulations under the PCT; or the Guidelines for ISAs and IPEAs; or by creating separate guidelines.

International search and examination standard

6. The establishment of common quality standards for search and examination does not require all Contracting States to accept the same view of patentability or assume that complete harmonisation of substantive law is necessary. The following are proposed as baseline quality criteria for international search and examination standards. More detailed explanation is given in the appendix to this paper.

(a) *Search standards* - should set out the requirements which an ISA should endeavour to meet. The following, which expand on the minimum requirements prescribed in PCT rule 36, could form the basis of such requirements.

(i) The adoption of an appropriate search strategy.

(ii) The effective implementation of such a strategy.

(iii) The identification and selection of relevant documents.

(iv) The clear recording and reporting of the results and necessary information.

(v) The appropriate handling of plurality of invention.

(vi) The revision and publication of an abstract which provides an effective search tool.

(b) *Examination standards* - should set out the requirements an IPEA should aim to meet in assessment of novelty, inventiveness, disclosure, unity and support. The following, which expands on the minimum requirements prescribed in PCT rule 63, could be adopted as the basis for such requirements.

(i) The raising of appropriate objections.

(ii) The clear communication of objections with appropriate explanation.

(iii) The appropriate defence or retraction of objections.

Quality management system

7. An effective quality framework for the international phase should not only include quality standards for search and examination but also an overarching quality management system to ensure that cases are administered efficiently. The following illustrates the kind of basic requirements which could be included in such a system.

(i) The adoption of efficient, streamlined practices and procedures for handling search and examination requests and performing related functions such as data-entry and classification.

(ii) The application of effective control mechanisms for ensuring that search and examination reports are issued within the prescribed timescales.

(iii) The establishment of adequate resources and infrastructure to support the search and examination process.

(iv) The appointment of adequate numbers of competent staff to support examiners in coping with demand.

(v) The use of appropriate control mechanisms to ensure that backlogs are effectively managed and kept to a minimum.

(vi) The establishment of an effective training scheme for staff to ensure that they acquire the necessary experience and skills.

(vii) The maintenance of effective communication channels so that enquiries are dealt with promptly and that appropriate dialogue is possible between applicants and examiners.

(viii) The application of effective monitoring procedures for measuring customer satisfaction and perception and for ensuring that their needs and expectations are met.

Validation mechanism

8. The framework, once established, provides grounds for confidence in the quality of search and examination. That confidence requires regular validation if it is to remain high. Validation should involve an objective and transparent review mechanism for ensuring that the quality standards are being applied in a consistent and effective manner. This is essential if national Offices, applicants and the public in general are to have confidence in the system and if duplication of effort in the national and regional phase is to be avoided. The review could be undertaken on a regular basis by a panel using sampling techniques. The general results could then be made public, and any suggestions for improvement also publicised. The results specific to any particular ISA/IPEA would not be made public but could be fed back, as appropriate, to individual ISA/IPEAs for their views. Such feedback would also serve to identify opportunities for improvement and the adoption of best practice.

DEVELOPING THE DETAILS

9. The above suggested outline could form the basic structure of a quality framework which the Working Group could develop into a detailed framework for consideration and approval by the Committee on Reform of the PCT with a view to it being submitted for adoption by the PCT Assembly. That Group is not restricted to the IAs as producers. This broader involvement is essential if all are to have confidence that the quality framework which emerges is sufficiently robust to meet the objectives of ensuring that the results of the work undertaken in the international phase are of a consistently high standard and do not necessitate duplication in the national phase.

RECOMMENDATION

10. The Working Group is invited to:

(a) adopt the above outline proposals for a quality framework;

(b) use the outline to develop a detailed framework comprising appropriate quality standards and an effective, independent review mechanism and consider establishing a separate group to undertake this task; and

(c) consider how best to implement such a framework, for example by adding to the requirements prescribed in PCT rules 36 and 63; incorporating in the Guidelines for ISAs and IPEAs; or by establishing separate guidelines.

[Appendix follows]

APPENDIX

DETAILS OF SUGGESTED QUALITY CRITERIA FOR SEARCH AND EXAMINATION

PATENT SEARCHES

1. Adoption of an appropriate search strategy which:

(i) identifies the inventive concept(s) underlying the claims;

(ii) uses a search statement of a breadth to generate documents relevant to both the novelty and inventive step of the main inventive concept;

(iii) uses a search field and search techniques appropriate to the search statement, with priority given to those fields where the probability is highest of finding relevant documents;

(iv) is varied or truncated if many documents are found; and

(v) pays regard to the amount of searching that is reasonable and practicable.

2. Effective implementation of the strategy to ensure that all relevant documents lying in the path of the search are picked out for assessment.

3. Identification and selection of relevant documents for the search report, which may be on the basis that:

(i) the applicant should get an overview of the prior art, while avoiding undue repetition of disclosure; and

(ii) no particularly significant document is omitted.

4. Clear recording and reporting of the results and information in the search report which, in addition to identifying field of search, claims searched and relevant documents, could include:

(i) accurate categorisation of the documents;

(ii) identification of the claims impugned, to the extent reasonable for that case;

(iii) identification of relevant passages in the documents, where helpful and practicable; and

(iv) an explanation of any restriction or truncation of the search, selection of documents, or any assumption or interpretation used in the search.

5. Appropriate handling of plurality of invention to ensure that:

(i) clearly-distinct inventive concepts have been detected and reported;

(ii) the search has been directed to the first inventive concept; and

(iii) if plurality only appears after the search is completed, the applicant is warned of a possible future objection.

6. Revision and publication of an abstract which provide an effective search tool which:

(i) conveys the inventive concept in the opening sentence(s);

(ii) mentions significant technical features of all inventive concepts;

(iii) distinguishes between essential and preferred features;

(iv) makes best use of the selected drawing; and

(v) has an appropriate title.

PATENT EXAMINATION

7. Raising of appropriate objections embracing:

(i) prioritisation; so that only important objections are raised which have a bearing on the validity of the eventual patent (patentability, clarity of scope of protection, adequate disclosure), or on plurality of invention and reflect the need for examination reports to be fit for the purpose of placing the application in a grantable state with minimum time and effort;

(ii) accuracy; so that appropriate objections are not overlooked and unfounded and wrong objections are not made; and

(iii) coverage; so that all prima facie objections are raised as soon as possible.

8. Clear communication of objections with appropriate explanation which:

(i) uses straightforward language;

(ii) identifies the objections;

(iii) explains the shortcomings that have given rise to the objections;

(iv) suggests amendments that the examiner would consider acceptable for the applicant to adopt at his own choice.

9. Appropriate defence or retraction of objections taking into account the fact that:

(i) the objection must elicit either amendment or argument;

(ii) that simple denial of an objection is not sufficient reason for it to be dropped; and

(iii) the acceptability of an amended specification as a whole should be considered, not just the amendment itself.

[End of Appendix and of document]