

Patent Cooperation Treaty (PCT) Working Group

Fifth Session
Geneva, May 29 to June 1, 2012

MEETING OF INTERNATIONAL AUTHORITIES UNDER THE PCT: REPORT ON THE NINETEENTH SESSION

Document prepared by the International Bureau

1. This document sets out the results of the nineteenth session of the Meeting of International Authorities under the Patent Cooperation Treaty (PCT), held in Canberra from February 8 to 10, 2012, as summarized in the Summary by the Chair. The full report of the Meeting will be made available, once it will have been adopted by correspondence, on WIPO's website¹.

2. *The Working Group is invited to note the results of the nineteenth session of the Meeting of International Authorities under the PCT, as set out in the Summary by the Chair (document PCT/MIA/19/13) reproduced in the Annex of this document.*

[Annex follows]

¹ See http://www.wipo.int/meetings/en/details.jsp?meeting_id=24745

MEETING OF INTERNATIONAL AUTHORITIES
UNDER THE PATENT COOPERATION TREATY (PCT)

NINETEENTH SESSION, CANBERRA, FEBRUARY 8 TO 10, 2012

SUMMARY PREPARED BY THE CHAIR

(noted by the Meeting; reproduced from document PCT/MIA/19/13)

INTRODUCTION

1. The Meeting of International Authorities under the PCT (“the Meeting”) held its nineteenth session in Canberra from February 8 to 10, 2012.
2. The following International Searching and Preliminary Examining Authorities were represented at the session: the Austrian Patent Office, the Brazilian National Institute of Industrial Property, the Canadian Intellectual Property Office, the Egyptian Patent Office, the European Patent Office, the Federal Service for Intellectual Property of the Russian Federation, IP Australia, the Israel Patent Office, the Japan Patent Office, the Korean Intellectual Property Office, the National Board of Patents and Registration of Finland, the Nordic Patent Institute, the Spanish Patent and Trademark Office, the State Intellectual Property Office of the People’s Republic of China, the Swedish Patent and Registration Office, and the United States Patent and Trademark Office.

ITEM 1: OPENING OF THE SESSION

3. Ruth Bell, elder of the Ngunnawal people, offered a traditional welcome to country to the participants.
4. Fatima Beattie, Deputy Director General of IP Australia welcomed the participants and chaired the session, except for items 10 to 12, which were chaired by Greg Powell, Supervising Examiner, IP Australia. James Pooley, Deputy Director General of the World Intellectual Property Organization welcomed participants on behalf of the Director General.

ITEM 2: ADOPTION OF THE AGENDA

5. The Meeting adopted the agenda as set out in document PCT/MIA/19/1 Rev., subject to:
 - (a) the addition of document PCT/MIA/19/7 Add. under item 7 and document PCT/MIA/19/8 Add. under item 8;
 - (b) deciding that the Chair should present a summary of the session under item 13 and that the report would be adopted by correspondence.

ITEM 3: PCT STATISTICS

6. The Meeting noted a presentation by the International Bureau on the most recent PCT statistics¹.

ITEM 4: QUALITY

(A) REPORT FROM THE QUALITY SUBGROUP

7. The Meeting:

- (a) noted with approval the Summary by the Chair of the Meeting's Quality Subgroup set out in the Annex to this document;
- (b) approved the continuation of the Subgroup's mandate, highlighting the particular importance of the quality-related work set out in paragraphs 7 to 20, below;
- (c) agreed that the annual reports submitted by the International Authorities should be made publicly available on WIPO's website; and
- (d) agreed that the International Bureau should submit a report to the PCT Assembly on the work undertaken in relation to the quality framework, including a reference to the annual reports, an aggregate report to be drafted by the Quality Subgroup, and annexes comprising the report from the Quality Subgroup as set out in the Annex to this document and relevant sections of this summary or the report of the session.

(B) TRILATERAL COLLABORATIVE STUDY ON METRICS

8. The Meeting noted a presentation by the European Patent Office on the "Collaborative Study on Metrics"¹ carried out by the Trilateral Offices (the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office).

(C) PPH/PCT INFORMATION UPDATE; PPH METRICS

9. The Meeting noted a presentation by the European Patent Office on the current status, latest developments and future plans with regard to the PPH (Patent Prosecution Highway) and PCT/PPH arrangements the European Patent Office has in place with various other Offices, including information on the results of a preliminary analysis carried out in respect of the applications which have been processed under the PPH arrangements to date¹.

(D) EPO MANUAL OF BEST PRACTICE (QUALITY PROCEDURES BEFORE THE EPO)

10. The Meeting noted a presentation by the European Patent Office on its new "Handbook of Quality Procedures Before the EPO"¹.

(E) RECOMMENDATIONS ENDORSED BY THE WORKING GROUP RELATED TO QUALITY

11. Discussions were based on document PCT/MIA/19/2.

Clarity and Support

12. The Meeting expressed general support for the proposed modifications of the provisions in the International Search and Preliminary Examination Guidelines which gave guidance to Authorities on the inclusion of observations on clarity and support, as set out in Circular C. PCT 1326. Some Authorities noted that they already provide comments in relation to clarity and support.

13. The International Bureau informed the Meeting that a further revised version of the proposed modifications, taking into account the responses received in reply to the Circular and the comments made at the Meeting, would be included in the Circular which it intended to issue

within the next 2 months to consult on a broader package of modifications to the Guidelines aimed at incorporating all changes agreed since the last substantial update of the Guidelines in 2004.

Scope of Search

14. See the discussions on document PCT/MIA/19/5 in paragraphs 25 and 26, below.

Explanations of Cited Documents

15. The Meeting noted the suggestions by Offices with regard to the issue of explanations of cited documents received in response to Circular C. PCT 1295, as set out in document PCT/MIA/19/2. With regard to the issue of a possible revision of WIPO Standard ST.14, see paragraphs 39 and 40, below.

Standardized Clauses

16. The Meeting noted with approval the discussions and the way forward agreed by the Quality Subgroup as set out in the Summary by the Chair of its session, annexed to this summary.

Access to Written Opinions

17. Several Authorities expressed their general support for the proposal to further consider an amendment of the PCT Regulations aimed at making the written opinion by the International Searching Authority available prior to the present 30 months deadline, stressing the need to consult with users to obtain their views on such a change. One Authority stated that it preferred the current situation to remain as is.

Second Written Opinion by the IPEA

18. Several Authorities stated that, already today, it was their practice to issue a second written opinion where the applicant had attempted to overcome any deficiencies found to exist in the international application by way of argument or amendment but where the Authority still considered the application to be deficient. All of those Authorities expressed the view, however, that such additional opportunity for dialogue should not be made mandatory in all cases but rather remain optional for Authorities so as to give sufficient flexibility. Some Authorities reiterated their opinion that they considered the streamlining of Chapter II procedures to be one of the main achievements of the PCT reform process which should not be undone.

Incentives to Encourage High Quality Applications and Early Corrections of Defects

19. The Meeting noted the suggestions by Offices with regard to the issue of incentives to encourage high quality applications and early corrections of defects received in response to Circular C. PCT 1295, as set out in document PCT/MIA/19/2.

(F) FURTHER QUALITY-RELATED WORK

20. The Meeting agreed:

- (a) as recommended by the Quality Subgroup, to proceed with the study proposed by the European Patent Office on a set of characteristics of international search reports established by International Authorities, noting that the resources available to the European Patent Office in 2012 would allow that Office to carry out that study only in

respect of search report data from a maximum of two Authorities (in addition to the Authorities belonging to the IP5 group of Offices, which were already the subject of an equivalent ongoing study); the Meeting invited Authorities interested in participating in this study in 2012 and beyond to notify the European Patent Office accordingly;

(b) to request the Quality Subgroup to develop the concept of a pilot project under which Offices willing to participate would analyze the usefulness for the national phase of international search reports, based on a set of quality metrics to be developed by the Subgroup; one possibility might be to identify international search reports containing only "A" citations, where the case entered the national phase without any amendments to the claims and where the national search report contained "X" and/or "Y" citations.

ITEM 5: FUTURE DEVELOPMENT OF THE PCT

(A) RECOMMENDATIONS ENDORSED BY THE WORKING GROUP RELATING TO THE SETTING UP OF A THIRD PARTY OBSERVATIONS SYSTEM AND OF A QUALITY FEEDBACK SYSTEM

21. Discussions were based on document PCT/MIA/19/3.

22. The Meeting noted with approval that the third party observation system was expected to begin operation on July 1, 2012. Some Authorities expressed concern about the proposed quality feedback system, but this would nevertheless be able to commence operation within a similar timescale.

(B) COLLABORATIVE SEARCH AND EXAMINATION PILOT PROJECT – INTERMEDIARY REPORT OF PILOT PHASE 2

23. Discussions were based on document PCT/MIA/19/4.

24. The Meeting noted an intermediate report by the European Patent Office on phase 2 of the Collaborative Search and Examination Pilot Project carried out jointly by the European Patent Office, the Korean Intellectual Property Office and the United States Patent and Trademark Office.

(C) SEARCH STRATEGY INFORMATION IN THE PCT

25. Discussions were based on document PCT/MIA/19/5.

26. The Meeting agreed that those Authorities which were willing should begin to provide their search strategies to the International Bureau in whatever form they might be available and that the International Bureau should make them available on PATENTSCOPE. The International Bureau should also publish any explanation provided by International Authorities of the contents of their search strategy and how best to understand and use it.

(D) ANY OTHER ISSUES

27. The European Patent Office agreed that it would, once sufficient experience had been gained, provide a report on its recently introduced procedure to require applicants entering the regional phase to address any outstanding issues in the international preliminary report on patentability.

ITEM 6: REVIEW OF SUPPLEMENTARY INTERNATIONAL SEARCH

28. Discussions were based on document PCT/MIA/19/6.

29. The Meeting noted a preliminary oral report by the International Bureau on the responses by Authorities, Offices and users of the supplementary international search system received in reply to Circular C. PCT 1329 and exchanged views on the likely causes for the disappointingly low uptake by applicants.

ITEM 7: PCT MINIMUM DOCUMENTATION – DEFINITION AND EXTENT OF PATENT LITERATURE

30. Discussions were based on documents PCT/MIA/19/7 and 7 Add.

31. The Meeting agreed that the International Bureau should issue a Circular inviting International Authorities to nominate representatives for a task force to consider the technical issues set out in the document. Further consideration might also be required for other matters, such as effective classification of the documentation concerned.

ITEM 8: PCT SEQUENCE LISTING STANDARD

32. Discussions were based on documents PCT/MIA/19/8 and 8 Add.

33. The Meeting noted a progress report by the European Patent Office (in its role as the leader of the corresponding Task Force of WIPO's Committee on WIPO Standards (CWS)) on the development of a WIPO standard for the presentation of sequence listings in XML format and exchanged views on the remaining outstanding issues, in particular, as to the appropriate mechanism to ensure a smooth transition for current WIPO Standard ST.25 (and the equivalent PCT sequence listing standard) to the new XML standard.

34. The Meeting agreed that:

(a) it would be preferable if the CWS Task Force, before concluding its work on the development of the new XML standard, would also look into the issue of whether it will be possible for any tool to be developed which would allow for the easy and complete conversion of sequence listings filed in one format (ST.25 or XML) into the other;

(b) based on the conclusions reached by the Task Force on the issue of the feasibility of developing a conversion tool, the appropriate PCT bodies should commence a discussion on the most appropriate mechanism for transition from ST.25 to the new XML standard.

ITEM 9: COLOR DRAWINGS IN INTERNATIONAL APPLICATIONS

35. Discussions were based on document PCT/MIA/19/9.

36. The Meeting:

(a) noted a summary of responses to Circular C. PCT 1317 which had been received by the International Bureau;

(b) affirmed the importance of work to allow the use of color drawings in the PCT system, while recognizing the time, cost and legal issues which would be involved; and

(c) noted that a proposal would need to balance the convenience to applicants of a system where color drawings could be used in all Offices during both the international and national phases against the time which would be involved in overcoming all of the legal and technical barriers to achieve this.

ITEM 10: PCT ONLINE SERVICES (ePCT)

37. Discussions were based on document PCT/MIA/19/10 and a demonstration of the current ePCT applicant portal by the International Bureau.

38. The Meeting welcomed the information on the current state of work and recognized the importance of such developments to communications with and between Offices as well as between the applicant and International Bureau. The International Bureau invited International Authorities to engage in an ongoing discussion with the International Bureau to determine ways to make the overall system more effective for applicants and Offices alike. For International Authorities, the International Bureau was particularly interested in the machine interfaces and data which should be communicated to make the most effective use of each others' local systems.

ITEM 11: REVISION OF WIPO STANDARD ST.14

39. Discussions were based on document PCT/MIA/19/11.

40. While some International Authorities expressed certain reservations, the Meeting recommended that the International Bureau should propose the creation of a task force under the Committee on WIPO Standards to consider revision of WIPO Standard ST.14. The draft mandate of such a task force should extend to all matters within the scope of ST.14, including the definition of citation categories and the recommended presentation of non-patent literature.

ITEM 12: FUTURE WORK

41. The Meeting noted that the next session was expected to be convened in February or March 2013, probably immediately following a meeting of the Quality Subgroup. In the absence of alternative proposals from an International Authority, the meeting would be held in Geneva.

ITEM 13: SUMMARY BY THE CHAIR

42. The Meeting noted this Summary by the Chair.

ITEM 14: CLOSING OF THE SESSION

43. The Meeting closed February 9, 2012.

[The Annex to document PCT/MIA/19/13, containing the list of participants, is not reproduced here]

[End of Annex and of document]

¹ The presentations are available on WIPO's website at http://www.wipo.int/meetings/en/details.jsp?meeting_code=pct/mia/19